**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 PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO STRIKE

# DECLARATION OF KELLY W. CUNNINGHAM

I, Kelly W. Cunningham, declare as follows:

1. I am a partner at Ervin, Cohen & Jessup, LLP and patent attorney with patent bar number 43,570 before the USPTO. I am also lead counsel of record for Patent Owner Hongjia Wang on his U.S. patents, patent applications, and patent litigation matters in the U.S. 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. Mr. Wang and Mr. Wang's U.S. patent licensee, Tsteigen, Inc., filed suit against Petitioner Viking Drill & Tool, Inc. in the District Court for the District of Minnesota alleging that Viking has infringed several of Mr. Wang's patents, including U.S. Patent No. 11,007,583 ("the '583 patent"). The case is entitled, *Tsteigen, Inc. and Hongjia Wang v. Viking Drill & Tool, Inc.*, Case No. 0:21-cv-02759. I oversaw the filing of the complaint in this case on December 28, 2021 and have stipulated with Petitioner's counsel to a stay of the case pending the outcome of the present IPR proceeding.

3. Leading up to Due Date 1 in this proceeding, namely, October 31, 2023, I worked earnestly and in good faith to have all papers filed on or before that day.

4. For weeks leading up to the deadline of Due Date 1, Patent Owner's technological expert, Professor William J. Endres, Ph.D. and I worked on several long parts of his declaration in support of Mr. Wang's response to petition, and the language in his declaration became the backbone of the response.

5. As the filing deadline drew near, my team and I finalized some additional arguments for overcoming the last of Viking's purported grounds for rejection and delivered the complete declaration to Professor Endres for his final review and signature.

6. After reviewing some of these arguments, however, Professor Endres reported that he did not agree with some of the additional arguments and did not have enough time to distinguish between the remaining paragraphs of his declaration by the deadline on that day.

7. I , therefore, decided to remove the additional paragraphs Professor Endres could not agree to or could not completely and adequately read through before the deadline, obtained Prof. Endres' signature on what remained, and oversaw the fielding of that signed declaration with our other responsive papers as close to the deadline as possible.

8. As mentioned in my client's brief in opposition to Petitioner's motion to strike, I do sincerely apologize to the Board and to Viking's counsel for filing my client's original response papers after midnight on the night of October 31, 2023. I

know the deadline was October 31, 2023, and I really intended to have all papers filed by the end of that day, and I am sorry that I failed to get this filing completed on that day.

9. When we finalized and filed the corrected response to petition and the corrected and supplemental declaration of our technological expert witness, Professor William J. Endres, Ph.D. of Michigan Technological University, I instructed my team to take the original response and update it to create the corrected response, but *solely* to reflect the new paragraph numbering in the corrected and supplemental declaration of Professor Endres.

10. Submitted with this Declaration as **Exhibit 2115** is a true and correct copy of those paragraphs that are in the November 7, 2023 corrected and supplemental declaration of Professor Endres but not in his original declaration dated October 31, 2023.

11. The next morning, I am informed, and based on that information believe, that my colleague, Elliot Chen, Esq., contacted Viking's counsel to assure them that we intended to serve on them the completed declaration with Professor Endres' corrected paragraphs as soon as possible.

12. By the time Professor Endres had finalized the additional paragraphs and signed his completed declaration, the Board had ordered Mr. Wang

to re-submit all papers, including removing from Professor Endres' declaration any statements that pertain only to Viking's other petition, IPR2023-00473.

13. From October 31, 2023 to November 4, 2023, I definitely wanted to provide Viking's counsel with Professor Endres' completed declaration absolutely as soon as possible which is why I served the completed declaration on Viking's counsel on November 4, 2023.

14. I served but did not file this "combined" declaration with the Board, however, since it would not be compliant with the Board's order, and instead began separating Professor Endres' combined declaration into two "corrected and supplemental" declarations, along with preparing the all the other corrected responsive documents for filing.

15. Once we completed the corrected papers for re-filing, I oversaw the filing and service on November 7, 2023 of the corrected response papers in compliance with the Patent Office Rules and the Court's Order.

16. Mr. Wang's first extension request was solely because Viking had said its expert witness could not sit for deposition until September 26, 2023, citing "certain academic commitments." Submitted with this Declaration as **Exhibits 2110** and **2111** are two true and correct email threads showing our request for this deposition, Viking's response, and ultimately, our agreement to the

deposition date two weeks after our requested range of dates, provided Viking agree to a comparable extension.

17. This delay was not really caused by us since, on August 17, 2023, we had emailed Viking to request Professor Steven Schmid's availability during the weeks of September 4 or September 11, 2023. See, **Exhibits 2110** and **2111.**

18. I requested the second extension because our expert witness, Professor Endres, happened to be unavailable the weeks of October 9 and October 16 on his own academic commitments, namely, his annual review of each of his graduate students.

19. I did not know about this academic commitment when we had requested the first extension of time.

20. I have certainly underestimated multiple times how difficult it would be to respond to 28,000 words of petition – seven separate grounds spread over two petitions. (Paper 1, at p. 97; and IPR2023-00473, Paper 1, at p. 101 show the word counts for each of Petitioner's two petitions).

21. In the present proceedings, I served on Viking Professor Endres' combined declaration just four days after Due Date 1, the combined declaration closely mirrors, mostly word-for-word, the statements made in Mr. Wang's response served four days before, and Viking had, then, seventeen (17) days to evaluate all of Professor Endres' statements (and twenty-one (21) days to evaluate those statements

as earlier contained in Mr. Wang's formal response) before deposing Professor Endres.

22. The delay in serving the additional paragraphs in Professor combined declaration was due to the fact that the declaration had contained some minor, secondary opinions over which he had a different opinion.

23. I served the combined declaration on Viking, but I chose not to file it at that time because I thought it prudent and in good faith to (1) serve on Viking the combined declaration as soon as possible rather than wait to divide it into two declaration as the Board had ordered but not to (2) file the combined declaration until he had divided it into two declarations -- for the two separate responses to petition -- in compliance with the Board's Order (Ex. 1037, p. 3).

24. I attended Viking's deposition of Professor William J. Endres, Ph.D., and I saw Viking's attorney fully cross-examined Professor Endres regarding all of Professor Endres' declarative testimony, including his newly submitted paragraphs.

25. In hindsight, I wish I would have requested the permission of the Board to address the Category C information in Professor Endres' combined declaration and ultimately in his corrected and supplemental declaration (the Category C information being his new opinion testimony that is beyond Patent Owner's original response to the petition IPR2023-00474 petition for IPR. It was newly discovered

information that, in the interest of justice should, in my opinion, be considered by the Board before the Board makes its final decision on the merits in this proceeding. In particular, it pertains to the prior art patents that Petitioner cites as either anticipatory or an obviousness reference. I do plan on seeking such permission from the Board shortly after we file the present opposition to Petitioner's motion to strike.

26. And, I also believe that good cause exists to excuse the late-filed information. One basis for finding good cause is that Professor Endres' new statements are meritorious. Professor Endres' analysis gets to the heart of what the Chinese prior art reference CN203356678U ("Zhou," Exhibit 1007) truly discloses and whether Zhou indeed anticipates or helps as much as Petitioner's expert witness claims it does in rendering obvious any of the challenged patent claims. As an expert witness, Professor Endres' analysis of the prior art continued, and it was at the very moment of Patent Owner's Due Date 1, unfortunately, that his analysis of Zhou took this leap.

27. Indeed, Zhou is very cryptic, disclosing its configuration, but not disclosing why it is so configured or how the configuration leads to any improved performance. Even Petitioner's own technical expert did not appear to appreciate how the drill bit configuration disclosed in Zhou would perform. (Ex. 1004, at pp. 59, 89). It is my understanding and belief, based on information I obtained directly from Professor Endres, it was only upon considering the implied axial driving

speed for Zhou that Professor Endres hit upon exactly why Zhou attempted to patent this drill bit configuration.

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 day, January 3, 2024, at Beverly Hills, California.

*/s/ Kelly W. Cunningham*
Kelly W. Cunningham

**CERTIFICATE OF SERVICE UNDER 37 CFR § 42.6(e)**

I hereby certify that a true copy of the foregoing **DECLARATION OF KELLY W. CUNNINGHAM IN SUPPORT OF PATENT OWNER'S OPPOSITION TO MOTION TO STRIKE** has been served in its entirety this 3rd day of January 2024, by electronic mail on Petitioner's lead counsel, as follows:

J. Derek Vandenburgh (Lead Counsel)
Registration No. 32,179
Carlson, Caspers, Vandenburgh & Lindquist, P.A.
225 South Sixth Street, Suite 4200
Minneapolis, MN 55402
Email: DVandenburgh@carlsoncaspers.com

/Kelly W. Cunningham/
Kelly W. Cunningham
USPTO Reg. No. 43,750
Lead Counsel for the Patent Owner,
Hongjia Wang