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 EXCLUDE

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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
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1024.	Matco Tools, Hyper-Step Drill Bits brochure published in 2018
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1051.	Excerpt from Fisher Deposition Transcript, dated November 28, 2023

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.64(c), the Federal Rules of Evidence and the Scheduling Order (as amended) (Paper 50), Petitioner Viking Drill & Tool ("Petitioner") moves to exclude the following evidence submitted by Patent Owner Hongjia Wang ("Patent Owner"): (1) paragraphs 37 to 55 of Exhibit 2036; (2) paragraphs 33 to 34, 36 of Exhibit 2036, (4) paragraphs 142 to 148 of Exhibit 2034, (5) Exhibits 2094 to 2097, and (6) Exhibits 2047, 2055 to 2061. Petitioner has timely objected to all of these exhibits on sufficiently particularized grounds (*see* Paper 33).

II. PARAGRAPHS 37 to 55 OF EXHIBIT 2036 ARE INADMISSIBLE UNDER FRE 801, 802, 805, AND 403

Exhibit 2036 (Corrected Declaration of David Fisher executed on October 30, 2023) contains statements made outside the course of this proceeding that Patent Owner relies upon for their truth, and it is therefore hearsay. The rule against hearsay applies to IPRs. 37 C.F.R. § 42.62(a). Because none of the exceptions or exemptions to rule against hearsay applies here, those statements are inadmissible.

Patent Owner relies on portions of Exhibit 2036 (and Exhibits cited therein) to state that the Hyper-Step drill bits have received industry praise. *See* Paper 28, pp. 55-56. Paragraphs 37 to 55 of Exhibit 2036 contain out-of-court statements, by third parties, which are being offered by the Patent Owner for their truth. They

therefore constitute inadmissible hearsay under FRE 801 and 802. In fact, these paragraphs are the classic hearsay-within-hearsay, making Exhibit 2036 additionally inadmissible under FRE 805. No exceptions to the rule against hearsay are applicable to the statements contained in paragraphs 37 to 55 of Exhibit 2036.

In these paragraphs, Mr. Fisher cites Exhibits 2011, 2012, 2013, 2049, 2014, 2050 (expunged from the record January 10, 2024), 2015, 2051, 2016, 2052, 2017, 2053 (expunged from the record January 10, 2024), 2018, 2054 (expunged from the record January 10, 2024), 2019, 2020, 2021, 2022. *See* Exhibit 2036, ¶¶ 40-55. Each of these exhibits are pages from third party websites containing statements by other third parties. *See*, *e.g.*, Exhibits 2013, 2049 (Tool Showcase: Matco Cobalt Hyper-Step Drill Bits from TechShop Garage). With respect to each of the aforementioned exhibits, Mr. Fisher then quotes statements made by the third party. *See*, *e.g.*, Exhibit 2036, ¶ 40 ("In the YouTube video in question, the user notes: 'Now take a look at the patented Hyper-Step tip design. These drill bits act like a step drill, spreading the job of cutting across multiple levels, which keeps the drill bit cooler, resulting in less wear and maybe best of all, there's no more need for a pilot hole. The Matco exclusive Hyper-Step tip design cuts 45% faster and stays sharp 4 times longer.'"). Patent Owner did not submit any testimony from any author/publisher of reviews posted on the third-party websites in this proceeding. Therefore, these statements constitute inadmissible hearsay under FRE

802. No exceptions to the rule against hearsay are applicable to any quoted statement in paragraphs 37 to 55 of Exhibit 2036. Further, the reliance on, and citation to Exhibits 2011, 2012 2013, 2049, 2014, 2015, 2051, 2016, 2052, 2017, 2018, 2019, 2020, 2021, 2022 in Exhibit 2036 is not simply hearsay; it is hearsay-within-hearsay, as it relies on statements posted to third-party websites by unknown third parties. These are therefore inadmissible under FRE 805.

Mr. Fisher testified that he did not know the authors of any videos or reviews he was relying upon, he had not spoken to any such author prior to or during preparation of his declaration, nor did he verify statements made by the authors. *See*, *e.g.*, Exhibit 1051, 81:1-86:11. Mr. Fisher therefore lacks firsthand personal knowledge and cannot lay the proper foundation to confirm the identification, authenticity, and chain of custody of these third-party statements. Therefore, paragraphs 37 to 55 of Exhibit 2036 are also inadmissible under FRE 403 as being unfairly prejudicial and subject to improper speculation by Mr. Fisher.

Accordingly, paragraphs 37 to 55 of Exhibit 2036 relied upon by Patent Owner should be excluded.

III. PARAGRAPHS 33 TO 34, 36 OF EXHIBIT 2036 ARE INADMISSIBLE UNDER FRE 801, 802, 805, 401 AND 403

Patent Owner relies on portions of Exhibit 2036 (and Exhibits cited therein) to allege that other companies copied the Easy-Boost drill bit design. *See* Paper 28,

pp. 54-55. Paragraphs 33 to 34, 36 of Exhibit 2036 contain out-of-court statements, by third parties, which are being offered by the Patent Owner for their truth. They therefore constitute inadmissible hearsay under FRE 801 and 802. In fact, these paragraphs are also hearsay-within-hearsay, making Exhibit 2036 additionally inadmissible under FRE 805. No exceptions to the rule against hearsay are applicable to the statements contained in paragraphs 33 to 34, 37 of Exhibit 2036.

In paragraphs 33 to 34, Mr. Fisher cites Exhibits 2028 and 2029. *See* Exhibit 2036, ¶¶ 33-34. Each of these exhibits are pages from third party websites containing statements by other third parties. *See*, *e.g.*, Exhibit 2028 (Steel Vision Tool's website). With respect to each of the aforementioned exhibits, Mr. Fisher then quotes statements made by the third party. *See*, *e.g.*, Exhibit 2036, ¶ 40. Patent Owner did not submit any testimony from these third parties in this proceeding. *See Asetek Danmark v. CoolIT Sys*., IPR2020-00825, Paper 50, 46 (Oct. 12, 2021) ("Having failed to [seek the witness's testimony in the IPR] Petitioner cannot now argue that it could not have obtained [it] in this proceeding through reasonable efforts."). Therefore, these statements constitute inadmissible hearsay under FRE 802. No exceptions to the rule against hearsay are applicable to any quoted statement in paragraphs 33 to 34 of Exhibit 2036. Further, the reliance on, and citation to, Exhibits 2028 and 209 in Exhibit 2036 is hearsay-within-hearsay which is inadmissible under FRE 805.

Additionally, Mr. Fisher lacks firsthand personal knowledge and cannot lay the proper foundation to confirm the identification, authenticity, and chain of custody of these third party products and websites. Moreover, the Steel Vision and VIM products are not relevant to these proceedings. Therefore, paragraphs 33 to 34 of Exhibit 2036 are also inadmissible under FRE 401 and 403 as being not relevant, unfairly prejudicial and subject to improper speculation by Mr. Fisher.

Further, for the same reasons as stated above paragraphs 36 of Exhibit 2036 is also inadmissible under FRE 801, 802, 401 and 403 as being evidence that is inadmissible hearsay, irrelevant, unfairly prejudicial and subject to improper speculation by Mr. Fisher.

Accordingly, paragraphs 33, 34 and 36 of Exhibit 2036 relied upon by Patent Owner should be excluded.

IV. PARAGRAPHS 142 TO 148 OF EXHIBIT 2034 AND EXHIBITS 2094 to 2097 ARE INADMISSIBLE UNDER FRE 801, 802, 805, 401 AND 403

Patent Owner relies on portions of Exhibit 2034 (Corrected and Supplemental Declaration of Dr. William J. Endres) and Exhibits 2094 to 2097 to allege that the Steel Vision Tools Stepped Tip drill bits and the VIM HSSC29 drill bits embody the claims of the ’583 Patent. *See* Paper 28, p. 46, p. 54. Specifically, Patent Owner relied on paragraphs 142 to 148 of Exhibit 2036 in support of this assertion. *See id*. at 54. But Dr. Endres did not evaluate Steel Vision Tools

Stepped Tip or VIM HSSC29 himself. Instead, Dr. Endres merely testified that he evaluated "the 'third-party copying' patent claims charts." *See* Exhibit 2034, ¶ 142. Similarly, for each of Exhibits 2094 to 2097, Dr. Endres states that he was submitting "a 'third-party copying' patent claims chart that I closely evaluated and agree with…" to opine that Steel Vision Tools Stepped Tip drill bits and the VIM HSSC29 drill bits embody the claims of the '583 Patent. *See* Exhibit 2034, ¶¶ 143-148. Dr. Endres therefore lacks firsthand personal knowledge and cannot lay the proper foundation to establish that the drill bits shown in those charts constitute Steel Vision Tools Stepped Tip drill bits and the VIM HSSC29 drill bits, as alleged in the charts. He also lacks firsthand personal knowledge and cannot lay the proper foundation to confirm the identification and authenticity of the "third-party copying" patent claims charts. Moreover, Patent Owner did not submit any testimony from these third parties in this proceeding. Nor did counsel for Patent Owner submit a declaration in this proceeding attesting to the veracity of Exhibits 2094 to 2097. *Compare* Exhibits 2001, 2037 *with* 37 C.F.R. §§ 42.53, 42.2.

As such, Exhibits 2094 to 2097 contain out-of-court statements, authored by unknown persons, which are being offered by the Patent Owner for their truth. They therefore constitute inadmissible hearsay under FRE 801 and 802. No exceptions to the rule against hearsay are applicable to the statements contained in paragraphs Exhibits 2094 to 2097. And, paragraphs 142 to 148 of Exhibit 2036

constitute hearsay-within-hearsay, making Exhibit 2036 additionally inadmissible under FRE 805. Further, paragraphs 142 to 148 of Exhibit 2036 and Exhibits 2094 to 2097 are also inadmissible under FRE 401 and 403 as being not relevant, unfairly prejudicial and subject to improper speculation by Dr. Endres.

Accordingly, paragraphs 142 to 148 of Exhibit 2036 and Exhibits 2094 to 2097 relied upon by Patent Owner should be excluded.

V. EXHIBIT 2047, 2055 TO 2061 ARE INADMISSIBLE UNDER FRE 801, 802, 805, 401 AND 403

Patent Owner relies on and cites to Exhibits 2047, 2055 to 2061 as allegedly providing evidence of copying and long-felt but unmet need. *See* Paper 28, p. 50, pp. 58-59. Patent Owner characterizes Exhibits 2055 to 2061 as allegedly showing "Kimball's strong desire to copy Mr. Wang's invention." *See id*. at p. 59. Patent Owner's allegations are based on out-of-court statements in Exhibits 2047, 2055 to 2061, which are being offered by the Patent Owner for their truth.

Patent Owner specifically quotes statements made by Kimball Midwest, and relies on them for their alleged truth. *See*, *e.g.*, Paper 28, p. 50 (citing Exhibit 2055); *id*., p. 51 (citing Exhibit 2059). Patent Owner did not submit any testimony from Kimball Midwest in this proceeding. Therefore, these statements constitute inadmissible hearsay under FRE 802. *See CaptionCall, L.L.C. v. Ultratec, Inc*., IPR2015-00637, Paper 98, 13 (Sept. 7, 2016) (excluding testimony that "a teardown 'has happened' … [which] is not an admission against interest about

copying, and is itself hearsay."). No exceptions to the rule against hearsay are applicable to any quoted statements in Exhibits 2047, 2055 to 2061.

For these same reasons, the statements in Exhibits 2047, 2055 to 2061 are not relevant to these proceedings, are unfairly prejudicial and subject to improper speculation by Patent Owner. Moreover, Mr. Taylor Fulk could not verify the veracity of the statements contained in these Exhibits. *See* Exhibit 2119, 32:1-4, 37:2-6; 40:4-8; 42:9-11. Therefore, Exhibits 2047, 2055 to 2061 are also inadmissible under FRE 401 and 403.

Accordingly, Exhibits 2047, 2055 to 2061 relied upon by Patent Owner should be excluded.

VI. CONCLUSION

Based on the foregoing, Petitioner requests that the Board exclude (1) paragraphs 37 to 55 of Exhibit 2036; (2) paragraphs 33 to 34, 37 of Exhibit 2036, (4) paragraphs 142 to 148 of Exhibit 2034, (5) Exhibits 2094 to 2097, and (6) Exhibits 2047, 2055 to 2061.

Respectfully submitted,

Date: March 21, 2024

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CERTIFICATE OF SERVICE

I certify that on March 21, 2024, I caused a true and correct copy of the foregoing **Petitioner's Motion to Exclude** to be served via electronic mail on the following:

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