

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIKING DRILL & TOOL, INC.
Petitioner

v.

HONGJIA WANG
Patent Owner

IPR2023-00474

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

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

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Patent Owner Hongjia Wang (“Patent Owner” or “Mr. Wang”) hereby respectfully submits this opposition to Petitioner Viking Drill & Tool, Inc.’s (“Petitioner” or “Viking”) Motion to Strike (“Motion”).

I. Background Facts

Patent Owner Hongjia Wang filed his response to Viking’s petition (“original response to petition”) and all associated papers just minutes after 9:00 pm on October 31, 2023 PDT (Pacific Daylight Saving Time). (Ex. 2116). That time is, of course, midnight in the Eastern Time Zone, and counsel for Mr. Wang attempted, earnestly and in good faith, to file all papers before that time. (Ex. 2112, ¶ 8). Although the filing began before midnight, it could not be completed until 38 minutes afterwards. Patent Owner’s counsel apologizes to the Board and to Petitioner’s counsel for the small delay. (Ex. 2112, ¶ 8).

For other reasons, the Board expunged Patent Owner’s filings and ordered him to re-file his papers in compliance with the PTAB Rules. Most notably, Mr. Wang was required to remove the paragraphs from the declarations of his expert witness, Professor William J. Endres, Ph.D., that relate only to his response to Viking’s other petition for IPR (Case No. 2023IPR-00473).

Patent Owner filed his “corrected” response papers on November 7, 2023. His “corrected” response to petition is virtually identical to his original November 1, 2023 response to petition. The only changes to the text of the response were made

to adjust the paragraph numbering in light of the corrected and supplemental declaration of Professor Endres. (Ex. 2112, ¶ 9). For the purposes of this Opposition, it is helpful to treat Professor Endres' corrected and supplemental declaration as having three categories of statements:

Category A: the statements that were contained in Professor Endres' original declaration and directly corroborate certain arguments in Mr. Wang's original response to petition;

Category B: the new paragraphs in Professor Endres' corrected and supplemental declaration that were not a part of his original declaration, yet they only corroborate arguments that were already contained in Mr. Wang's original response to petition; and

Category C: the new paragraphs were not in Professor Endres' initial declaration and they raise issues that go beyond the arguments in Mr. Wang's original response to petition.

(Ex. 2112, ¶ 10 and 2115).

For weeks leading up to the October 31, 2023 extended filing deadline, Mr. Wang's counsel and Professor Endres had been working on his declaration, and the language in that declaration became the backbone of the original response to petition. (Ex. 2112, ¶ 4). As the filing deadline drew near, however, Mr. Wang's

counsel finalized some additional arguments for overcoming the last of Viking's purported grounds for rejection. They delivered the complete draft declaration with those arguments to Professor Endres for his final review and signature. (Ex. 2112, ¶ 5).

To counsel's surprise, Professor Endres disagreed with some of the additional arguments and indicated he lacked enough time to distinguish between the remaining paragraphs of his declaration by the deadline. (Ex. 2112, ¶ 6). In an effort to meet the deadline while ensuring the filed declaration fully represented Professor Endres' views, Mr. Wang's counsel decided to remove the paragraphs with which Professor Endres disagreed as well as those he lacked sufficient time to review and obtain Professor Endres' signature on what remained. Counsel then filed that signed declaration. (Ex. 2112, ¶ 7).

Counsel served these papers on Viking the very next morning, November 1, 2023, by 10:24 am PDT. (Ex. 2107 and 2108). Mr. Wang's counsel also contacted Viking's counsel to assure them that Mr. Wang would serve on them the expanded declaration with Professor Endres' additional paragraphs as soon as possible. (Ex. 2112, ¶ 11).

By the time Professor Endres had finalized the additional paragraphs and signed his expanded declaration, the Board had ordered Mr. Wang to re-submit all his papers, including removing from Professor Endres' declaration any statements

that pertain only to Viking's other petition, IPR2023-00473. (Ex. 2112, ¶ 12). Since Mr. Wang's counsel wished to provide Viking's counsel with Professor Endres' expanded declaration as soon as possible, they served the completed "combined" declaration on Viking's counsel on November 4, 2023. (Ex. 2109).

Mr. Wang did not file this "combined" declaration with the Board, however, since it would not comply with the Board's order. Instead, his counsel began separating Professor Endres' combined declaration into two "corrected and supplemental" declarations, along with preparing all the other corrected responsive documents for filing. (Ex. 2112, ¶ 14). They then filed and served the corrected response papers on November 7, 2023 in compliance with the PTAB Rules and the Court's Order. (Ex. 2112, ¶ 15). There are no substantive differences between Professor Endres' combined declaration served on Viking on November 4, 2023, and his two "corrected and supplemental" declarations filed and served on November 7, 2023. (Ex. 2112, ¶ 9).

Viking emphasizes that Mr. Wang had requested two extensions of time, but Viking failed to note that the first extension request was made solely because Viking said its expert witness could not sit for deposition until September 26, 2023, citing "certain academic commitments." (Ex. 2110). This date would have been one week after Mr. Wang's deadline to schedule a conference with the Board had Mr. Wang

decided to seek amendments to his patent claims and only one week before the then-existing Due Date 1 to file his formal response to petition. (*See*, Paper No. 14).

This delay was not caused by Mr. Wang, who on August 17, 2023, had emailed Viking to request Professor Steven Schmid's availability during the weeks of September 4 or September 11, 2023. (Ex. 2111).

Mr. Wang requested the second extension because his own expert witness, Professor Endres, happened to be unavailable the weeks of October 9 and October 16 due to his academic commitments, namely, his annual review of each of his graduate students. (Ex. 2112, ¶ 18). Mr. Wang's counsel did not know of this commitment when they had requested the first extension of time. (Ex. 2112, ¶ 19).

Also, Mr. Wang's counsel underestimated how difficult it would be to respond to 28,000 words of petition -- seven separate grounds spread over two petitions. (Ex. 2112, ¶ 20; and Paper 1, at p. 97; and IPR2023-00473, Paper 1, at p. 101). Again, Mr. Wang's counsel apologizes to the Board and to Viking for the minor delay in filing and serving Mr. Wang's formal responses and for the additional four days it took to complete and serve the combined declaration of Mr. Wang's expert witness. (Ex. 2112, ¶ 8).

II. Legal Standard

A. Striking a Portion of a Party's Brief Should Rarely Be Granted

The Board’s Trial Practice Guide provides that “In most cases, the Board is capable of identifying new issues or belatedly presented evidence when weighing the evidence at the close of trial, and disregarding any new issues or belatedly presented evidence that exceeds the proper scope of reply or sur-reply. As such, *striking the entirety or a portion of a party’s brief is an exceptional remedy that the Board expects will be granted rarely*. In some cases, however, whether an issue is new or evidence is belatedly presented may be beyond dispute, or the prejudice to a party of waiting until the close of the evidence to determine whether new issues or belatedly presented evidence has been presented may be so great, that the facts may merit considering a motion to strike.” Trial Practice Guide, at pp. 80-81 (emph. added); *see also, e.g., Intex Recreation Corp. v. Team Worldwide Corp.*, IPR2018-00859, Paper 69 at 5-6 (PTAB April 12, 2019) (denying motion to strike and noting that motions to strike are rarely granted).

For a late action to 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.”

B. Good Cause Exists for the Late-Filing of Professor Endres’

Declarations

In the present case, Mr. Wang’s “corrected” response to petition is essentially identical to his original response to petition. Mr. Wang’s corrected response does not

contain any late-submitted argument, and it cites only to those paragraphs in Professor Endres' corrected and supplemental declaration that corroborate arguments that were already contained in Mr. Wang's original response to petition.

It is only Professor Endres' corrected and supplemental declaration that, as mentioned above, contains a number of statements that go beyond the arguments in Mr. Wang's original response to petition (referred to herein as the Category C paragraphs).

These Category C paragraphs come from Professor Endres' further analysis and evaluation of the prior art references as he was finalizing his "combined" declaration on November 2 or 3, 2023. That is, they are technically late by four days since they were served on Petitioner for the first time on November 4, 2023 (or seven days late since there were filed with the Board on November 7, 2023).

In hindsight, Patent Owner regrets that he did not request permission from the Board at that time to address this new Category C information or amend his response to the petition in the interest of justice so that he could be assured that the newly discovered information would be considered by the Board for a ruling on the merits of Petitioner's 2023IPR-00473 petition. Mr. Wang now intends to seek such permission from the Board shortly after he files the present opposition to Petitioner's motion to strike. In any event, good cause exists to excuse the late-filed information.

Specifically, Patent Owner's showing of good cause for his delay in filing and serving Professor Endres' original declaration includes that the filing delay was just minutes, and that his counsel attempted, in good faith, to file his response papers before the deadline, but the filings proved bulky and slow to file, and the P-TACTS system appeared to stall at times. (Ex. 2113, ¶4). Patent Owner was also surprised that Professor Endres needed more time than he had to work through the remaining paragraphs of a declaration on which he and counsel had been working for weeks.

Mr. Wang can also show good cause for the four-day delay in serving the additional Category B paragraphs in Professor Endres' combined declaration. This good cause includes that Professor Endres' evaluation of his combined declaration was very detailed and slow and that the statements in Category B merely corroborate statements Mr. Wang already made in his original response to petition.

Similarly, Mr. Wang can show good cause for why he delayed for four days to serve the additional Category C paragraphs in Professor Endres' combined declaration. Beyond the Professor's detailed and slow evaluation, good cause is established by the fact that his 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 is not frozen in time but rather continues to grow, and it was at the very moment of Patent Owner's Due Date 1, unfortunately, that his analysis of Zhou took this leap.

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. Only upon considering the implied axial driving speed for Zhou did Professor Endres hit upon exactly why Zhou attempted to patent this drill bit configuration.

Patent Owner's showing of good cause why he did not file Professor Endres' combined declaration when he served it on Viking on November 4, is that the Board was clear that the paragraphs could not be combined, but rather, only the paragraphs relevant to the 2023IPR-00473 petition should be in Professor Endres' corrected declaration in support of the Patent Owner's response to that petition.

That is, on November 4, 2023, Mr. Wang served the combined declaration on Viking, but chose not to file it at that time because Mr. Wang 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, (Ex. 2112, ¶ 14), 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. 2112, ¶ 23; and Ex. 1037, p. 3).

Ultimately, Mr. Wang filed and served the late paragraphs of Professor Endres' corrected and supplemental declaration within one week of Professor Endres' original declaration and well before Viking deposed Professor Endres. (Exhibit 2034). Petitioner therefore had ample time to fully cross-examine Professor Endres regarding the newly submitted paragraphs of his declaration, which Petitioner did. Professor Endres testified at length during his deposition regarding his combined declaration and his ultimate corrected and supplemental declaration. (Ex. 2112, ¶ 24); see, 37 C.F.R. § 42.53(d)(5)(ii). Thus, Petitioner has not been prejudiced in any way, let alone suffer a prejudice so great that would justify striking the evidence altogether.

If Professor Endres had not been so meticulous, and instead had signed his declaration, he could have distanced himself from the questionable secondary opinions with which he disagreed when confronted with them in detail at his deposition. If this had occurred, this motion would have been moot. This did not occur, however, because Professor Endres caught these disagreeable paragraphs during his close review before signing off on the original declaration. (Ex. 2112, ¶ 6).

Petitioner has not cited to a single case that would justify striking evidence in similar circumstances, where the supplementation is filed and served well in advance of the witness's deposition and well in advance of the Petitioner's reply deadline, let alone anything that could possibly justify striking timely submitted arguments, such as found in Patent Owner's Response.

III. Mr. Wang's Exhibits 2050, 2053, and 2054

Mr. Wang's Exhibits 2050, 2053, and 2054 are videos that demonstrate industry praise and recognition of Mr. Wang's patented drill bit innovation, even citing to the specific claimed tip configuration as the cause for the unexpectedly improved performance and function of his drill bits. (Ex. 2113, ¶ 3).

The problem in filing these exhibits was that these videos are large, roughly 50 megabytes, 344 megabytes, and 150 megabytes, respectively. (Ex. 2113, ¶ 3). When Mr. Wang's counsel attempt to file those exhibits with is original response, the P-TACTS system would not accept them. (Ex. 2113, ¶ 3). Mr. Wang learned just this morning from the PTAB AIA Trials department how to formally submit these videos so that the Board can inspect them at part of the Board's review of the records of these proceedings. (Ex. 2113, ¶ 3). Based on this new understanding, Patent Owner is in the process of formally submitting these videos, presumably in multiple parts, 25 megabytes or less per part, and intends to do so shortly. Mr. Wang has already served these videos in whole on Petitioner.

IV. Viking's Authorities Do Not Support Viking's Motion

Viking first cited, *Samsung Electronics America, Inc. v. Kannuu PTY Ltd.*, IPR2020-00738, Paper No. 100 (PTAB Redacted Version July 22, 2022) to support its motion to strike, but, in *Kannuu PTY*, the motion to strike was the patent owner's own motion to strike, (*Id.* at pp. 9-10), and it was based on the patent owner's claims that the Petitioner had withheld documents during discovery that made patent owner's showing of secondary considerations more difficult. (*Id.*, p. 11). The Board acknowledged that the patent owner's showing was made more difficult and that the Petition could have been more forthcoming in producing internal documents. (*Id.*, p. 12). As a result, the Board granted the patent owner's motion to strike, citing discovery abuses, such as the fact that the Petition had produce one of the challenged documents only one day before the key deposition, in Korean, and without any English translation until one month after the deposition. (*Id.*, p. 13). By contrast, Mr. Wang has committed no discovery abuses in this proceeding.

Moreover, at no time in *Kannuu PTY* was any substantive portion of the patent owner's formal response to petition at risk by the motion. In fact, the patent owner in *Kannuu PTY* had asked the Board for an adverse judgment, but the Board determined that the patent owner "ha[d] not been so prejudiced by Petitioner's failure ... to warrant any sort of adverse judgment against Petitioner." (*Id.*, p. 12). This is precisely what Viking is seeking in the present motion to strike entire portions

of Mr. Wang's expert witness opinion testimony and any response arguments that are based on this opinion testimony without any showing of prejudice comparable to the prejudice acknowledged in the *Kannuu PTY* proceeding.

Second, Viking cited, *Stahls' Inc. v. Jodi A. Schwendimann*, IPR2020-00633, Paper No. 34 (PTAB Redacted Version June 23, 2021), but, in *Stahls'*, the Petitioner had moved to strike the patent owner's sur-reply for containing new evidence and argument based on that new evidence. (*Id.* at pp. 5-6). The Board granted Petitioner's motion on the grounds that a sur-reply cannot be accompanied by new evidence, citing its Consolidated Trial Practice Guide, at pp. 73–74. This is considerably different and distinguishable from the facts in Viking's motion. Most importantly, in the present proceedings, Viking obtained 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 then had 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. (Ex. 2112, ¶ 3).

Lastly, Viking cited, *Pain Teq, LLC v. Orthocision, Inc.*, IPR 2022-00335, Paper No. 27 (PTAB March 6, 2023), but in *Pain Teq*, the patent owner had accompanied its a reply in support of its motion for amend its patent claims with an

Appendix that, according to the Board, effectively included arguments, which was not permitted under the PTAB Rules and which exceeded the page limit. *Id.* at p. 6. This is very different from what Viking is seeking in its present motion to strike, which instead is based on the time the disputed paragraphs of the Endres declaration were filed and served.

V. Conclusion

Based on the foregoing, therefore, Mr. Wang requests that the Board deny Viking's motion to strike.

Dated: January 3, 2024

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. §§ 42.24(a)(1)(i), 42.24(b)(1), and 42.24(d), the undersigned certifies that, according to the “Word Count” tool in Microsoft Word, which was used to prepare this paper, the number of words in this **PATENT OWNER’S OPPOSITION TO VIKING DRILL & TOOL’S MOTION TO STRIKE** is 3,098.

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CERTIFICATE OF SERVICE UNDER 37 CFR § 42.6(e)

I hereby certify that a true copy of the foregoing **PATENT OWNER'S
OPPOSITION TO VIKING DRILL & TOOL'S MOTION TO STRIKE** has
been served in its entirety this 3rd day of January 2024, by electronic mail on
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