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

DECLARATION OF KELLY W. CUNNINGHAM IN SUPPORT OF PATENT OWNER'S RESPONSE TO ORDER TO SHOW CAUSE

Wang Ex. 2117
Viking Drill v. Hongjia Wang
IPR2023-00474

DECLARATION OF KELLY W. CUNNINGHAM

I, Kelly W. Cunningham, declare as follows:

1. I am a partner at Ervin, Cohen & Jessup, LLP and a registered patent attorney, USPTO Bar No. 43,570. Ervin, Cohen & Jessup LLP and I represent Hongjia Wang and his patent licensee, Tsteigen, Inc., regarding their intellectual property matters in the United States, and I am lead counsel of record for Patent Owner Hongjia Wang on his U.S. patents, pending patent application, the pending patent infringement action between Mr. Wang and Viking, and patent challenges, including the present two *inter partes* patent reviews, IPR Nos. IPR2023-00473 and IPR2023-00474.

2. I have personal knowledge of the facts set forth herein. If called as a witness, I could and would competently testify to the matters stated herein.

3. I have been Mr. Wang's lead counsel on all of its current U.S. patents and patent applications, all patent challenges at the USPTO, including the present *inter partes* proceedings, and the underlying patent infringement action.

4. Mr. Wang's former U.S. patent counsel filed the U.S. national stage patent application for Mr. Wang's Twist Drill, U.S. Patent Application Serial No. 15/847,900 ("the Wang '900 Application") based on Mr. Wang's earlier PCT patent application, PCT Patent Application No. PCT/CN2016/073,767. Mr. Wang's former U.S. patent counsel then filed a U.S. continuation-in-part patent

application, in which I substituted as counsel of record and obtained U.S. Patent No. 11,007,583 ("the '583 patent") for Mr. Wang.

5. On December 28, 2021, I prepared and filed on behalf of Mr. Wang and Tsteigen, Inc., a complaint against Petitioner Viking Drill & Tool, Inc. in the District Court for the District of Minnesota alleging that Viking had infringed several of Mr. Wang's patents, including the '583 patent. The case is entitled, *Tsteigen, Inc. and Hongjia Wang v. Viking Drill & Tool, Inc.*, Case No. 0:21-cv-02759, and shortly after the initiation of the present inter partes proceeding, I stipulated with Petitioner's counsel to a stay of the case pending the outcome of this proceeding.

6. I certainly acknowledge the gravity of the Board's findings and have put into place further measures to avoid the potential of any violations moving forward.

7. After I submitted the October 31, 2023 Declaration of Professor Endres, I fully intended to file and serve a Supplemental Endres Declaration as quickly as possible, containing the portions of the Declaration that Wang was unable to get Professor Endres to finalize in time.

8. I interpreted the Board's November 1, 2023 as necessitating that we correct formatting issues with the Responses, the Declarations of William Endres, myself, David Fisher, and Hongjia Wang, and the Motion to Strike. I submitted the formatting corrections and supplemental paragraphs in the same document in order

to get the new paragraphs filed as soon as possible and reduce the prejudice to Petitioner from the late submission.

9. I now certainly recognize that the proper course would have been to file the Corrected Endres Declarations without the additional paragraphs on November 7 and then to separately seek to supplement the Corrected Endres Declarations.

10. It was never my intention to hide the addition of new paragraphs to Endres' Declaration from Petitioner or the Board. I included the words, "and Supplemental" in the title of Professor Endres' Corrected and Supplemental Declaration to make it clear to Petitioner that this declaration included the additional paragraphs not in his original expert witness declaration. In addition, I updated the signature date on the Endres Declaration to reflect that it was substantively different from the originally submitted Declaration. And finally, I included a footnote in the Corrected Declarations of myself, David Fisher, and Hongjia Wang (which were only changed to correct formatting) that: "This Declaration has been revised to correct formatting only. The content and signature date have been preserved" to differentiate these Corrected Declarations from the Corrected and Supplemental Declaration of Professor Endres. It was my intention and (perhaps mistaken) belief that the title, signature date, and omission of footnote would notify reviewing parties that the document was substantively modified after October 31, 2023.

11. In fact, I had just served on Petitioner the "Combined" Endres Declaration just three days earlier for the express purpose of serving on Petitioner the additional paragraphs my expert witness had not been able to sign off on on Due Date 1, October 31, 2023—also with an updated signature date. I certainly was not hiding the new paragraphs and did not have a tactic to sneak the new paragraphs in.

12. I considered the paragraphs in the Corrected and Supplemental Endres Declaration, for the most part, as corroborating the arguments we had already made in our original Patent Owner's Response to Petition.

13. I believed ***prompt*** disclosure of the missing paragraphs would prevent any chance of prejudice to Petitioner, and I would have stipulated to giving Petitioner additional time had Petitioner elected to go that route instead. I realize this approach was wrong, but at the time, it was based in good faith on the belief that we could avoid any undue prejudice.

14. Going forward, I have instructed my team to be sure to serve any Board Submissions on Petitioner ***before*** going about uploading them to P-TACTS. This is because service takes very little time, and uploading papers can be much slower.

15. Also, I had my team compile a detailed pre-filing checklist from the PTAB Rules. I personally reviewed and approved the checklist and have instructed everyone on my team to study it and keep it on hand to ensure that future filings will comply with the Board's Rules.

16. Lastly, I will staff additional members of my law firm on this matter and will have them apply for *pro hac vice* admission in these proceedings should the Board require.

17. I am the only attorney in my law firm that is registered to practice before the USPTO and this Board. If the Board were to preclude me or limit my ability to represent Mr. Wang in this matter, Mr. Wang would be forced to locate and retain new registered patent counsel from another law firm. This process could, of course, take a considerable amount of time, both for the Mr. Wang to identify new counsel and for new counsel to get up to speed on the proceedings in this case.

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 17, 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 RESPONSE TO ORDER TO SHOW CAUSE** 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

/s/ Kelly W. Cunningham

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