
From: Trials <Trials@USPTO.GOV>
Sent: Thursday, March 21, 2024 6:16 AM
To: Kelly Cunningham <kcunningham@ecjlaw.com>; Trials <Trials@USPTO.GOV>
Cc: Derek Vandenburg <DVandenburg@carlsoncaspers.com>; Saukshmya Trichi <STrichi@carlsoncaspers.com>; Iain A McIntyre <IMcIntyre@carlsoncaspers.com>; Mitch Williams <mwilliams@carlsoncaspers.com>; Katherine Chen <KChen@carlsoncaspers.com>; Aaron McGushion <aaron@mcgushion.com>; Tsteigen-v-Vikinglitgroup <Tsteigen-v-Vikinglitgroup@ecjlaw.com>
Subject: RE: Viking Drill & Tool v. Wang - IPR2023-00473 and IPR2023-00474

Counsel,

The panel appreciates that the parties have worked together to resolve this issue. The panel authorizes Patent Owner to file a motion to expunge the original sur-reply (both versions). At the same time, the Patent Owner may file its substitute sur-reply (both versions). In the motion to expunge, the Patent Owner will note that the Board authorized the motion and simultaneous filing of the substitute papers. In the event the panel deems a call necessary after reviewing the filings, it will reach out to the parties. Accordingly, the panel believes no call is required at this time.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Kelly Cunningham <kcunningham@ecjlaw.com>
Sent: Wednesday, March 20, 2024 4:21 PM
To: Trials <Trials@USPTO.GOV>
Cc: Derek Vandenburg <DVandenburg@carlsoncaspers.com>; Saukshmya Trichi <STrichi@carlsoncaspers.com>; Iain A McIntyre <IMcIntyre@carlsoncaspers.com>; Mitch Williams <mwilliams@carlsoncaspers.com>; Katherine Chen <KChen@carlsoncaspers.com>; Aaron McGushion <aaron@mcgushion.com>; Tsteigen-v-Vikinglitgroup <Tsteigen-v-Vikinglitgroup@ecjlaw.com>
Subject: RE: Viking Drill & Tool v. Wang - IPR2023-00473 and IPR2023-00474

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Dear Board:

I represent the Patent Owner, Hongjia Wang, in the above-captioned IPRs. Petitioner, Viking Drill & Tool, Inc., objected to certain portions of Mr. Wang's sur-reply in IPR2023-00474 as raising new arguments. Although Mr. Wang disagrees with this argument, he and Viking have conferred and have reached a compromise. The parties therefore request a conference call with the Board to discuss a stipulated motion to expunge the original sur-reply (both sealed and public versions) and to grant Patent Owner leave to file an amended sur-reply (again, both sealed and public versions).

The parties are available for a conference call to discuss the motion from 1:00 to 5:00 pm (Eastern) this coming Friday, March 22, as well as, from 1:00 to 3:00 pm (Eastern) on Monday, March 25.

Petitioner's lead counsel is copied on this communication.

Sincerely,
Kelly W. Cunningham

Kelly Cunningham

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Patent, Trademark, and Copyright Disputes and Appeals throughout the U.S.;
Counsel Clients on Intellectual Property Strategies; Registered U.S. Patent Attorney;
Draft and Prosecute Patent, Trademark, and Copyright Applications throughout the World

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From: Elliot Chen <echen@ecjlaw.com>

Sent: Monday, March 18, 2024 7:49 PM

To: Saukshmya Trichi <STrichi@carlsoncaspers.com>; Derek Vandenburg <DVandenburg@carlsoncaspers.com>; Viking_CCVL <Viking_CCVL@carlsoncaspers.com>; Kelly Cunningham <kcunningham@ecjlaw.com>

Cc: Tsteigen-v-Vikinglitgroup <Tsteigen-v-Vikinglitgroup@ecjlaw.com>; Aaron McGushion <aaron@mcgushion.com>

Subject: RE: Viking Drill & Tool v. Wang - IPR2023-00473 and IPR2023-00474

Hi Derek and Saukshmya,

Thank you for taking the time to meet and confer with us last Friday. As discussed during the call, we disagree that the portions of the Sur-Reply that you cited constitute improper new argument. Patent Owner contends that the cited portions of Patent Owner's Surreply properly respond to new arguments raised in Petitioner's Reply (i.e., the argument that Zhou "incorporates step drill features on a twist drill") and comment on cross-examination testimony given by Petitioner's expert, Dr. Schmid, that is inconsistent with this argument; this is expressly permitted by the Trial Practice Guide. CTPG at 73-74; see also, e.g., *Stride Rite Children's Grp., LLC v. Shoes by Firebug LLC*, No. IPR2017-01809, 2019 WL 236242, at *10 (P.T.A.B. Jan. 16, 2019) (Paper 64) (denying motion to strike portions of sur-reply, reasoning that "even

assuming that Sections II.C and II.D do not respond to arguments made in reply briefs, they do ‘point to cross-examination testimony’ and, therefore, are not beyond the scope of a proper sur-reply”). During the meet and confer, Kelly requested that you provide any caselaw in support of your position, which you have not done.

Nonetheless, in the interest of compromise, Kelly asked me to send you the proposed edits to page 5, line 3 to page 8, line 4 of Patent Owner’s Surreply in IPR2023-00474 (as Kelly is currently on vacation). Please let us know if the proposed edits below would resolve your motion to strike. The below also corrects two errors in the Sur-Reply, at page 6, line 17, and at page 8, line 6.

Furthermore, Viking claims that “Zhou already incorporates step drill features on a twist drill.” (Paper 45, at p. 1). This is not true. Viking’s own expert witness, Professor Steven Schmid, testified in his deposition that Zhou disclosed a twist drill configuration with a top blade followed by just one cutting tip, provided the feed rate is below a given threshold, such as when the workpiece is hardened steel:

[REDACTED]

(Ex. 2118, at pp. 121:22-122:11).

That is, Professor Schmid noted that, if the feed rate is below a set rate, then the sunken edges 2 and 3 do not form cutting tips ~~—because the sunken edges are not cutting edges at all.~~ (*Id.*).

This means that, contrary to Viking’s Reply (Paper 45, at p. 1), Zhou is nothing like a step drill; it does not “incorporate step drill features on a twist drill.”

~~Indeed, it is so different from step drill that no cutting edges are “immediately adjacent” to one another. Rather, Zhou depicts and describes only one cutting edge on either side of the top blade and, even if Zhou’s concept were extrapolated to larger drill diameters having multiple cutting edges under a similar principle of operation, the cutting edges would be separated from each other by non-cutting edges, provided the axial cutting rate is within certain bounds. (Ex. 2118, pp. 108:6 111:20, 111:23-112:10, and 116:21-117:5).~~ In his deposition, Viking’s own expert witness acknowledged that at a given feed rate, only protruding edges 1 and 4 would perform cutting, and sunken edges 2 and 3 would perform no cutting:

[REDACTED]

[REDACTED]
(Ex. 2118, at pp. 116:21-117:5, previously noting that, “[REDACTED]

” *Id.*, at 109:14-25).

~~That is, Zhou disclosed a twist drill configuration that contains a top blade 5, a protruding edge 1 and a sunken edge 3 on one side of the top blade 5, and a protruding edge 4 and a sunken edge 2 on one side of the top blade. Common feed rate recommendations for drills of the diameters specifically noted in Zhou are about twice the height differences Zhou described, which are defined by Zhou according to each different diameter described:~~

- ~~• 0.25mm for a 30mm diameter drill (Ex. 1007, ¶[0024]);~~
- ~~• 0.15mm for a 15mm diameter drill (*Id.*, ¶[0026]); and~~
- ~~• 0.05mm for a 4mm diameter drill (*Id.*, ¶[0028]).~~

~~Only protruding edges 1 and 4 contain “swarf separating grooves” 6 and 7 but each sunken edge does not. This is further indication that, by design, and by intended use, sunken edges 2 and 2 are not cutting edges as they too would otherwise possess “swarf separating grooves.” (*Id.* at ¶ [0024]; Ex. 2118, at 111:23-112:10).~~

Thus, Zhou does not include the claim elements in the manner in which they are arranged in the ‘583 Patent’s claims. It thus cannot **anticipate** invalidate any claims of the ‘583 Patent.

Elliot Chen

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From: Saukshmya Trichi <STrichi@carlsoncaspers.com>

Sent: Thursday, March 14, 2024 1:00 PM

To: Elliot Chen <echen@ecjlaw.com>; Derek Vandenburg <DVandenburg@carlsoncaspers.com>; Viking_CCVL <Viking_CCVL@carlsoncaspers.com>; Kelly Cunningham <kcunningham@ecjlaw.com>

Cc: Tsteigen-v-Vikinglitgroup <Tsteigen-v-Vikinglitgroup@ecjlaw.com>; Aaron McGushion <aaron@mcgushion.com>

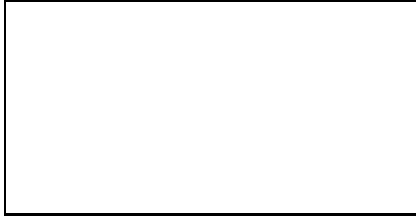
Subject: RE: Viking Drill & Tool v. Wang - IPR2023-00473 and IPR2023-00474

Please use the following dial-in for the meet and confer tomorrow at 4 p.m. Central –

Dial in: 888-861-1255

Pin: 558521

Regards,
Saukshmya



Saukshmya Trichi
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From: Elliot Chen <echen@ecjlaw.com>

Sent: Thursday, March 14, 2024 2:11 PM

To: Derek Vandenburg <DVandenburg@carlsoncaspers.com>; Viking_CCVL <Viking_CCVL@carlsoncaspers.com>; Kelly Cunningham <kcunningham@ecjlaw.com>

Cc: Tsteigen-v-Vikinglitgroup <Tsteigen-v-Vikinglitgroup@ecjlaw.com>; Aaron McGushion <aaron@mcgushion.com>

Subject: RE: Viking Drill & Tool v. Wang - IPR2023-00473 and IPR2023-00474

We are available between 2 and 3:30 pm Pacific tomorrow to meet and confer.

Elliot Chen

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From: Derek Vandenburg <DVandenburg@carlsoncaspers.com>

Sent: Thursday, March 14, 2024 10:03 AM

To: Elliot Chen <echen@ecjlaw.com>; Viking_CCVL <Viking_CCVL@carlsoncaspers.com>; Kelly Cunningham <kcunningham@ecjlaw.com>

Cc: Tsteigen-v-Vikinglitgroup <Tsteigen-v-Vikinglitgroup@ecjlaw.com>; Aaron McGushion <aaron@mcgushion.com>

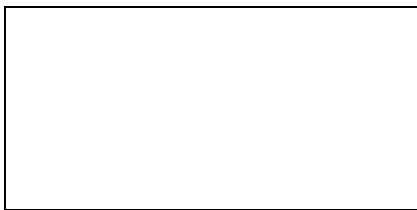
Subject: Viking Drill & Tool v. Wang - IPR2023-00473 and IPR2023-00474

Kelly:

Petitioner intends to move to strike page 5, line 3 to page 8, line 4 of Patent Owner's surreply in IPR2023-00474. That portion of Patent Owner's surreply improperly contain new arguments not contained in Patent Owner's response, including new assertions of claim limitations allegedly not taught by the Zhou reference.

Please let us know if you oppose the motion to strike. Assuming you do, please also let us know your availability today or tomorrow to meet and confer, as well as your availability on March 18 and 19 for a pre-motion hearing with the Board.

Regards,
Derek



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