

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
EXCLUDE**

Viking Drill & Tool's Petition Filing Date: January 17, 2023

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Patent Owner Hongjia Wang (“Mr. Wang”) opposes Petitioner Viking Drill & Tool, Inc.’s (“Viking”) Motion to Exclude (Paper 61, the “Motion”). The Board should deny Viking’s request to exclude: (1) paragraphs 37 to 55 of Exhibit 2036; (2) paragraphs 33 to 34, 37 of Exhibit 2036; (3) paragraphs 142 to 148 of Exhibit 2034 and Exhibits 2094 to 2097; and (4) Exhibits 2047 and 2055–2061. At best, Viking’s arguments go to the weight that the aforementioned documents should be accorded and not whether they should be excluded.

I. PARAGRAPHS 37 TO 55 OF EXHIBIT 2036

Viking moves to exclude Paragraphs 37 to 55 of David Fisher’s Declaration (Ex. 2036) under Federal Rule of Evidence 801, 802, 805, and 403. None apply.

The cited portions of Mr. Fisher’s declaration include his discussion of documents evidencing industry praise,¹ i.e., customer reviews on Matco’s website (Ex. 2011), *TechShop Magazine* (Exs. 2012, 2013, and 2049), YouTube videos exhibiting or discussing the drill bit’s performance (Exs. 2014, 2050, 2015, 2051, 2016, 2052, 2017, 2053, 2018, and 2054), and user discussions on tech forums, namely, *The Garage Gazette*, *The Hobby Mechanist*, and *The Garage Journal* (Exs. 2019, 2020, 2021, and 2022).

¹ Wang does not oppose Viking’s Motion, as to paragraphs 43, 49, and 51 of Mr. Fisher’s declaration, which have already been stricken. Paper 41.

As an initial matter, Viking’s hearsay objection makes no sense. In reality, paragraphs 37–55 of Mr. Fisher’s declaration are, by definition, not hearsay. Fed. R. Evid. 801(c)(1) (hearsays consists of statements “(1) the declarant does **not** make while testifying at the current trial or hearing”) (emph. added). Rather, Mr. Fisher’s declaration comprises Mr. Fisher’s sworn testimony given while testifying in this proceeding, that is subject to cross-examination. *See, e.g., Actifio, Inc. v. Delphix Corp.*, No. IPR2015-00016, Paper 69 at 104 (P.T.A.B. Apr. 13, 2016) (rejecting motion to exclude declaration statements as hearsay); Ex. 1051 (cross-examination of Mr. Fisher).

In reality, Viking’s hearsay objections are nothing more than a belated attempt to exclude Exhibits 2011–2022 and Exhibits 2049, 2051, and 2052. Wang submitted Exhibits 2011–2022 and Mr. Fisher’s testimony concerning them as part of its Preliminary Response to the Petition, *see* Paper 9, Ex. 2002, ¶¶ 10–22, and Viking failed to timely object to either the Exhibits or the testimony. *See generally* Paper 35. Paragraphs 37–55 of Exhibit 2046 simply highlight relevant portions of these previously submitted exhibits. As a result, Wang was never given the opportunity to correct these objections through service of supplemental evidence. 37 CFR § 42.64(b)(1) (“Any objection to evidence submitted during a preliminary proceeding must be filed within ten business days of the institution of the trial. Once a trial has been instituted, any objection must be filed within five business days of service of

evidence to which the objection is directed. The objection must identify the grounds for the objection with sufficient particularity to allow correction in the form of supplemental evidence”). Viking’s attempt to circumvent Section 42.64(b) should be denied.

Moreover, even if the Board were to consider Viking’s arguments, the statements in Fisher’s declaration are not hearsay, because they are not being offered for the truth of the matter asserted. Fed. R. Evid. 801(c)(2). As Viking admits, the cited statements are being offered to demonstrate industry praise. (Paper 61 at 1). But, “[l]audatory statements by third parties regarding an invention are relevant to the question of obviousness. ... [such statements] are not offered for the truth of the matters asserted in them, but to show that the statements were made.” *Asetek Danmark A/S v. CMI USA, Inc.*, 2014 WL 12644295, at *2 (N.D. Cal. Nov. 19, 2014). Because the existence of the statements themselves is relevant, courts and the PTAB routinely admit such evidence over a hearsay objection. *See, e.g., id.* (collecting cases); *Cisco Systems, Inc. v. Centripetal Networks, Inc.*, IPR2018-01437, Paper 40 at 32 (PTAB Jan. 23, 2020) (rejecting hearsay objections to exhibits “cited only as evidence of industry praise; their relevance lies in that they include statements from the industry allegedly praising Centripetal’s invention, not in whether that praise is true or accurate”).

Finally, there is simply no merit to Viking's relevance objection under Fed. R. Evid. 403. The paragraphs in question contain statements by industry players and consumers about the performance of a drill bit that embodies and is co-extensive with the claimed invention. (Paper 30 at 35–36). As such, the statements are relevant and demonstrate industry praise of the invention. At most, Viking's arguments based on unasserted evidentiary grounds go to the weight of the evidence, and provide no basis for exclusion.

II. PARAGRAPHS 33, 34, AND 36 OF EXHIBIT 2036

Viking also moves to exclude Paragraphs 33, 34, and 36 of David Fisher's Declaration (Ex. 2036) under Federal Rule of Evidence 801, 802, 805, 401, and 403. The cited portions of Mr. Fisher's declaration discuss the advertisements for the infringing drill bits on the websites of Steel Vision (Ex. 2028) and VIM (Ex. 2029), as well as Mr. Fisher's investigation of the Guehring website.

Viking's arguments are misguided. Mr. Fisher's statements in his sworn declaration are not themselves hearsay. Fed. R. Evid. 801(c)(1); *Actifio, Inc. v. Delphix Corp.*, No. IPR2015-00016, Paper 69 at 104 (P.T.A.B. Apr. 13, 2016). This is particularly apparent in the case of Paragraph 36, in which Mr. Fisher describes his investigation of the Guerhing website—and not any individual statements themselves.

Notably, Viking does not move to exclude Exhibits 2028 and 2029 as containing inadmissible hearsay. Nor can it, as Wang submitted Exhibits 2028 and 2029 with its Preliminary Response and Viking never served objections to this evidence. 37 CFR § 42.64(b). As with Paragraphs 37–55, Viking is making a belated and impermissible attempt to exclude Exhibits 2028 and 2029 as inadmissible hearsay, which Wang was never given the opportunity to correct.

These paragraphs (Paragraphs 33, 34, and 36) are used to demonstrate copying by others and industry praise. That is, they contain statements by industry players about the performance of a drill bit that embodies and is co-extensive with the claimed invention. (Paper 30 at 33–34; Paper 65 at 19–20). As such, the statements do not constitute hearsay under Fed. R. Evid. 801(c)(2) for the same reasons discussed above. *See, e.g., Asetek Danmark A/S v. CMI USA, Inc.*, 2014 WL 12644295, at *2 (N.D. Cal. Nov. 19, 2014) (collecting cases); *Cisco Systems, Inc. v. Centripetal Networks, Inc.*, IPR2018-01437, Paper 40 at 32 (PTAB Jan. 23, 2020). The statements are relevant for the fact that they were made.

Viking fails to meaningfully articulate its relevance objections under Fed. R. Civ. P. 401 and 403. As explained, the statements are being offered to show copying, industry praise, and industry acquiescence—each of which is relevant to the obviousness inquiry. Wang has offered evidence that the Steel Vision and VIM products embody the patent and are co-extensive with it. (Ex. 2034 ¶¶ 142–148, 151,

154, 161; Exs. 2094–2097). Thus, statements about the Steel Vision and VIM products are relevant. *See Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579 (Fed. Cir. 1997).

III. PARAGRAPHS 142 TO 148 OF EXHIBIT 2034 AND EXHIBITS 2094 TO 2097 ARE ADMISSIBLE

Viking moves to exclude Paragraphs 142–148 of William Endres declaration (Ex. 2034) along with Exhibits 2094–2097 under Federal Rule of Evidence 801, 802, 805, 401, and 403. Viking’s objections are inapplicable, and moreover, Viking’s motion is improper.

Exhibits 2094–2097 are claim charts mapping the Steel Vision and VIM drill bits to the claims of the ‘583 Patent. The cited portions of Endres’ declaration discuss his analysis of the Steel Vision and VIM drill bits, and establish that these products also embody the ‘583 patent’s claims and are co-extensive with them.

Viking’s primary objection here is that “Exhibits 2094 to 2097 contain out-of-court statements.” (Paper 61 at 6). For this reason, Viking argues that “paragraphs 142 to 148 of Exhibit 2036 (sic) constitute hearsay-within-hearsay, making Exhibit 2036 (sic) additionally inadmissible.” *Id.* at 6-7.

The problem with Viking’s argument is that: ***Viking never objected to Exhibits 2094–2097 on hearsay grounds.*** Paper 35 at 13; 37 CFR § 42.64(b). Viking raised only boilerplate relevance objections, which were obviously inapplicable to the exhibits cited, given that the exhibits in question were cited (and discussed) in

the Patent Owner Response and in Endres' declaration as showing the embodiment of each of the limitations and elements of the asserted patent claims.

2074-2097	FRE 401, 402, 403: This exhibit is not relevant. To the extent this document is relevant, its probative value is outweighed by the danger of causing unfair prejudice, confusing the issues, causing undue delay, wasting time, or needlessly presenting cumulative evidence, and therefore the document is inadmissible under Rule 403. This document is not cited in the Patent Owner's Response or any expert declaration.
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For Viking to raise hearsay objections now based on the supposed failure of counsel to submit a declaration attesting to the veracity of Exhibits 2094–2097 is improper. (Paper 61 at 6). Had Viking timely notified Wang of this objection, Wang readily could have submitted such a declaration, or supplemented the Endres Declaration, as is Wang's right under 37 CFR § 42.64(b)(2). Viking's argument also makes no sense; Exhibits 2094–2097 are claim charts prepared at Endres' direction, not out-of-court statements.

In any case, even if Viking had properly raised its hearsay objection (it did not) and Exhibits 2094–2097 constituted hearsay (they do not), as an expert witness, Endres is expressly permitted to base his opinion on evidence that might otherwise be hearsay (which Exhibits 2094–2097 are not). Fed. R. Evid. 703; *Ebay Inc. v. Glob. Equity Mgmt. (Sa) Pty. Ltd.*, No. IPR2016-01829, Paper 60 at 8 (P.T.A.B. Apr. 18, 2018). Professor Endres testified as to the import of Exhibits 2094–2097, and Viking

subsequently deposed Professor Endres, cross-examining him regarding his testimony.

Nor do Viking's relevance objections fare any better. The Exhibits and Paragraphs of Endres' Declaration are relevant because they establish that the products sold by third-party competitors VIM and Steel Vision embody the claims of the '583 patent and are co-extensive with them. Thus, the documents demonstrate copying by third parties, which is evidence of non-obviousness.

IV. EXHIBITS 2047 AND 2055–2061

Finally, Viking moves to exclude Exhibits 2047 and 2055–2061 on the basis of Fed. R. Evid. 801, 802, 805, 401, and 403. (Paper 61 at 7). None apply.

These exhibits consist of: (1) an email exchange between Kimball Midwest and Astro (Ex. 2047); (2) email exchanges between Kimball Midwest and Viking, produced by Viking in the litigation (Ex. 2055, 2056, and 2057); (3) a product catalog from Kimball Midwest (Ex. 2058); (4) a testing document produced by Kimball Midwest (Ex. 2059); and (5) internal Kimball Midwest documents describing the Ultra Step products (Exs. 2060 and 2061).

As an initial matter, Viking fails to meaningfully differentiate between its analysis of the various documents that it seeks to exclude, making sweeping generalizations that simply do not apply.

Wang cites to Exhibit 2047 to demonstrate copying by others. Specifically, this exhibit is offered to reinforce Mr. Fisher’s first-hand testimony that he was approached by Kimball Midwest about manufacturing a line of drill bits for them, in line with the Hyper-Step drill bits. (Ex. 2036 ¶¶ 25–26; Paper 30 at 30–31). The document is relevant to show that certain conversations took place—not for the truth of the assertions.

Likewise, Exhibits 2055–2057, 2059, 2060, and 2061 are used to demonstrate copying, long-felt unmet need, and most importantly, *industry praise*. The documents contain contemporaneous statements by Kimball and Viking concerning their real-time observations, impressions of, and reactions to Mr. Wang’s patented drill bits. As discussed above, such statements are relevant in-and-of-themselves. *See, e.g., Asetek Danmark A/S*, 2014 WL 12644295, at *2 (collecting cases); *Cisco Systems, Inc.*, IPR2018-01437, Paper 40 at 32. Notably, though Viking appears to seek the exclusion of these documents in their entirety, Exhibits 2055–2057 include statements made by Viking, which are not hearsay. Fed. R. Evid. 801(d)(2). To this end, Viking misrepresents Fulk’s testimony. (Paper 61 at 8). All that he testified was that he was not personally included in the conversations. Ex. 2119, 32:1-4, 37:2-6, 40:4-8, 42:9-11. Mr. Roussin was included in said conversations, and he confirmed the veracity of the statements. Ex. 2071 at 91:13-22.

Furthermore, on their face, several hearsay exceptions apply, including present-sense impression, then-existing impression, and records of regularly conducted activities (*e.g.*, Ex. 2055 [“They very much intrigue me, as I have never seen anything like them”]; Ex. 2059 [observations of testing]). Fed. R. Evid. 803(1), (3), (6).

Finally, Wang relies upon Exhibit 2058—Kimball’s catalog—to show that Kimball Midwest advertised the patented features of the ‘583 Patent in its marketing of its accused products and the comparative pricing of the patented products. (Paper 30 at 34; Paper 65 at 24–25). Exhibit 2058 constitutes a commercial publication, a well-established hearsay exception. Fed. R. Evid. 803(17).

Thus, Exhibits 2047 and 2055–2061 are highly relevant and are either not hearsay or, on their face, fall within well-established hearsay exceptions.

V. CONCLUSION

For the foregoing reasons, Wang requests that the Board deny Viking’s Motion to Exclude in its entirety.

Dated: March 26, 2024

Respectfully submitted,

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CERTIFICATION OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4) and 42.205(b) and the agreement of the parties, the undersigned certifies that on March 26, 2024, a true and correct copy of the **PATENT OWNER'S MOTION TO SEAL UNDER 37 C.F.R. § 42.54** was served by electronic mail upon the following:

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