

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PELOTON INTERACTIVE, INC.,
Petitioner,

v.

NEC CORPORATION,
Patent Owner.

Case IPR2023-01239
U.S. Patent No. 8,752,101

**PETITIONER'S MOTION TO CORRECT PETITION
UNDER 37 C.F.R. § 42.104(c)**

EXHIBIT LIST

EXHIBIT NO.	DESCRIPTION
1001	U.S. Patent No. 8,752,101 B2 (“the ’101 patent”)
1002	File History of U.S. Patent No. 8,752,101 B2 (U.S. Application No. 13/508,025) (“’101 FH”)
1003	Lee, Chiang, and Zhang, <i>Scalable Rate Control For MPEG-4 Video</i> , IEEE Transactions on Circuits and Systems for Video Technology, Vol. 10, No. 6, pp. 878 – 894, September 2000
1004	U.S. Publication No. US 2006/0143678 A1 (“Chou”)
1005	File History of corresponding European Patent No. 2498492
1006 ¹	SEALED Dr. Clifford Reader Declaration (“Reader Declaration”)
1007	International Publication No. WO 2006/108435 (“Kampmann”)
1008	Japanese Unexamined Patent Application Publication No. 2005-191786
1009	Japanese Unexamined Patent Application Publication No. 2007-13705
1010	U.S. Patent No. 8,909,809 (the ’809 patent”)
1011	Japanese Unexamined Patent Application Publication No. 2004-172830
1012	Certified English Translation of Japanese Unexamined Patent Application Publication No. 2004-172830
1013	Certified English Translation of Japanese Unexamined Patent Application Publication No. 2005-191786
1014	Certified English Translation of Japanese Unexamined Patent Application Publication No. 2007-13705
1015	Kozamernik, <i>Webcasting - The Broadcasters’ Perspective</i> , EBU Technical Review, March 2000 (“Kozamernik”)
1016	U.S. Patent No. 5,867,230 (“Wang”)
1017	U.S. Patent No. US 6,637,031 B1 (“Chou ’031”)
1018	Cen, Pu, and Walpole, <i>Flow And Congestion Control for Internet Streaming Applications</i> , Multimedia Computing and Networking 1998

¹ A redacted, public version of the Reader Declaration is provided as Ex. 1037.

1019	Lu, <i>Signal Processing for Internet Video Streaming: A Review</i> , Proceedings of SPIE, Volume 3947, p. 246-259, January 2000 (“Lu”)
1020	Haskell, Puri, and Netravali, Digital Video: An Introduction to MPEG-2, chapter 8, pp. 156-182 (“Haskell”)
1021	ITU H.262 (07/95)
1022	Ebrahimi, MPEG-4 natural video coding – An overview, Signal Processing: Image Communication, V.15 Iss. 4-5, Jan. 2000, pp. 365-385 (“Ebrahimi”)
1023	ITU H.261 (03/93)
1024	ITU H.222.0 (07/95)
1025	Rui, An Overview of MPEG-2, The 1997 Digital Video Test Symposium
1026	Huang, Chou, Klemets, Optimal Coding Rate Control for Scalable Streaming Media (“Huang”)
1027	U.S. Publication No. US 2004/0128396 A1 (“Patrick”)
1028	U.S. Patent No. US 7,711,841 B2 (“Desphande”)
1029	van Beek and Demircin, Delay-Constrained Rate Adaptation for Robust Video Transmission Over Home Networks, IEEE International Conference, V.2, (“van Beek”)
1030	U.S. Patent No. 5,822,524 (“Chen”)
1031	SEALED NEC’s Infringement Contentions served in NEC Corp. v. Peloton Interactive, Inc., No. 1:22-cv-00987-CFC (U.S. District Court, District of Delaware, filed July 28, 2022)
1032	Reader C., “Intraframe and Interframe Adaptive Transform Coding”, SPIE Vol. 66, 1975
1033	Reader C, "MPEG4: Coding for Content, Interactivity, and Universal Accessibility", Optical Engineering, Vol. 35, No. 1, pp. 104-108, Jan 1996
1034	“MPEG Video Compression Standard”, Edited by J. L. Mitchell et al, Chapter 16, “MPEG Patents”, pp.357-362
1035	Proposal and Consideration of Buffer Size, NTT, KDD, NEC, Fujitsu, CCITT SG IV Working Party XV/1 Specialist Group on coding for Visual Telephony, Document #287, January 1988
1036	Scheduling Order filed on March 20, 2023 in NEC Corp. v. Peloton Interactive, Inc., No. 1:22-cv-00987-CFC (U.S. District Court, District of Delaware, filed July 28, 2022)
1037	REDACTED PUBLIC version of Reader Declaration
1038	[Reserved]

1039	Michael Hopkins Declaration (“Hopkins Declaration”)
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Petitioner Peloton Interactive, Inc. (“Peloton”) respectfully submits this motion under 37 C.F.R. § 42.104(c) to correct certain clerical errors in the Petition and the declaration by Dr. Clifford Reader (Ex. 1006 (sealed version) and Ex. 1037 (public version)) (“Reader Declaration”). Specifically, Peloton seeks to replace U.S. Patent No. 5,867,230 to Wang et al. (“Wang ’230”) with U.S. Patent No. 7,606,928 to Wang et al. (“Wang ’928”) as Ex. 1016 and to renumber Wang ’230 as Ex. 1038. Peloton also seeks to correct the Petition and the Reader Declaration as shown in Exhibit A to the declaration by Michael Hopkins (Ex. 1039) (“Hopkins Declaration”) so that they refer to the correct exhibits throughout. Peloton does not seek to make any substantive corrections to either the Petition or the Reader Declaration. The Patent Trial and Appeal Board (Board) granted Peloton leave to file this motion no later than October 31, 2023. Paper 10.

1. Background

As explained in the Hopkins Declaration, the Petition and the Reader Declaration refer to Wang ’230 instead of Wang ’928 throughout instead of referring to both references as appropriate, due to an inadvertent clerical error of not including Wang ’928 in the relevant directory of the references and documents cited in the Petition. Ex. 1039 ¶ 5. Wang ’928 should have been filed as Ex. 1016, but Wang ’230 was filed as Ex. 1016 instead. Shortly after the Petition was accorded a filing date,

Peloton became aware of the clerical mistake and promptly notified counsel for NEC and provided a copy of Wang '928. *Id.* ¶ 6.

Wang '928 is used in Ground 2 of the Petition as disclosing limitation [1d] of claim 1 of the challenged U.S. Patent No. 8,752,101 (the "'101 patent"). See Pet. at 61-65; *see also* Ex. 1039 ¶ 3. Wang '230 is used solely as background art describing streaming media content. Ex. 1039 ¶ 3. The Petition and Reader Declaration both correctly quote and cite to pertinent portions of Wang '928, and those quotations and citations do not need to be changed. Therefore, no substantive changes are required for either the Petition or the Reader Declaration.

**2. The Petition And The Declaration Are Correctable Under
37 C.F.R. § 42.104(c)**

The Board should permit Peloton to fix its clerical error in filing Ex. 1016, and the related minor clerical errors in the Petition and the Reader Declaration. 37 C.F.R. § 42.104(c) provides: "A motion may be filed that seeks to correct a clerical or typographical mistake in the petition. The grant of such a motion does not change the filing date of the petition." This "rule is remedial in nature and is therefore entitled to a liberal interpretation." *ABB Inc. v. ROY-G-BIV Corp.*, IPR2013-00063, Paper 21, at 7 (Jan. 16, 2013). Further, it "is not limited to correcting errors in previously-filed documents, but is broad enough to encompass clerical errors in uploading the documents." *Id.* at 8.

The petitioner in *ABB* filed the wrong petition and exhibits due to a similar clerical error. *See id.* at 4. The patent owner there, like Patent Owner here, argued that “the uploading of incorrect documents is not a ‘clerical or typographical’ mistake that can be corrected under the rule,” but *ABB* held to the contrary. *Id.* at 9. The petitioner in *ABB* served the correct documents on the patent owner on the filing date, unlike Peloton, but that distinction relates only to prejudice, addressed below, not to whether the error is a clerical error that can be corrected under the rule.

That distinction is made clear by *Syntroleum Corp. v. Neste Oil Oyj*, IPR2013-00178, Paper 21 (July 22, 2013). *Syntroleum* held that the inadvertent submission of an incorrect exhibit (“EP ’531 B1” instead of “EP ’531 A2”) could be corrected, even though the petitioner did not notice the error until the patent owner filed its preliminary response. *Id.* at 4-5. The petitioner therefore did not serve the correct exhibit until after the preliminary response was filed. Unlike Patent Owner here, the patent owner in *Syntroleum* did not allege prejudice. As explained below, however, Patent Owner here has suffered no cognizable prejudice.

This case is different from *Ivantis, Inc. v. Glaukos Corp.*, IPR2018-01147, Paper 14 (Dec. 6, 2018), on which Patent Owner relies. The petitioner in *Ivantis* cited, quoted, and filed “Grieshaber B2” instead of “Grieshaber A1.” *Id.* at 5-6. Unlike here, the *Ivantis* petitioner requested substantive changes to the petition that “would involve a significant modification to the record,” including changes to

citations in the petition and the accompanying declaration. *Id.* at 9. *Ivantis* held that such changes “involve[d] a matter of law and [were] not clerical.” *Id.* In contrast, all of the citations and quotations in the Petition and Reader Declaration are to the Wang ’928 reference, and they are all correct. Thus, the Petition and Reader Declaration require only minor, non-substantive changes. *See* EX3001. The errors Peloton seeks to correct are therefore correctable under the rule.

3. Patent Owner Would Suffer No Prejudice From The Proposed Correction

Patent Owner would not suffer prejudice from the proposed corrections. Patent Owner alleges prejudice from an impending due date for its Preliminary Response, but the Board has already extended that deadline, eliminating any such prejudice. Paper 10 at 3. Even absent that extension, Patent Owner’s claim to prejudice rings hollow. Peloton provided the Wang ’928 reference to Patent Owner on August 21, 2023,² more than two months ago, and promptly after Peloton discovered the error. Ex. 1039 ¶ 6. Patent Owner also has been aware of Peloton’s desire to correct the record, and the way in which Peloton seeks to correct the record, since that date.

² Patent Owner indicated that it had independently found the Wang ’928 reference before that date.

Patent Owner's reliance on *Ivantis* fares no better with respect to prejudice. The petitioner in *Ivantis*, unlike Peloton, did not recognize the error before the preliminary response was filed. *Ivantis* held: "Patent Owner, in formulating its Preliminary Response, should be able to rely on the Petition and accompanying exhibits as being correct." IPR2018-01147, Paper 14, at 11. Here, Patent Owner will have the benefit of the Board's ruling and know the content of the Petition and accompanying exhibits prior to submitting its Preliminary Response, and, notably, it has known Peloton's position since August 21.

The motion to correct the Petition and the Reader Declaration should be granted.

Date: October 31, 2023

Respectfully submitted,

By /Scott C. Weidenfeller/
Scott C. Weidenfeller
Registration No.: 54,531
Anupam Sharma
Registration No.: 55,609
Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that the foregoing Petitioner's Motion to Correct Petition under 37 C.F.R. § 42.104(c) was served by electronic mail today on the following counsel of record for Patent Owner:

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And with courtesy copy to:

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SHEPPARD, MULLIN, RICHTER & HAMPTON

Date: October 31, 2023

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