

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PELOTON INTERACTIVE, INC.,

Petitioner,

v.

NEC CORPORATION,

Patent Owner.

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Case No. IPR2023-01239

Patent 8,752,101

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**PATENT OWNER'S RESPONSE TO PETITIONER'S  
MOTION TO CORRECT THE PETITION**

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Petitioner<sup>1</sup> seeks to correct certain deficiencies in its Petition. Petitioner's proposed corrections would "replace U.S. Patent 5,867,230 to Wang et al. ... with U.S. Patent No. 7,606,928 to Wang et al." and make corrections to the Petition and expert declaration to address this substitution. Paper No. 11 at 1 ("Mot."). Petitioner's proposed corrections go far beyond mere "clerical or typographical" mistakes correctable under Rule 104(c).

Petitioner is attempting to substantively alter the evidence—and the Grounds—in the Petition by submitting an *entirely new* reference not previously of record. Petitioner's reliance on *Syntroleum Corp. v. Neste Oil Oyj*, Mot. at 3, is misplaced. In *Syntroleum*, the Board allowed Petitioner to substitute what was substantively the same reference where the only difference was which published version was submitted. *See Syntroleum*, IPR2013-00178, Paper No. 21 (PTAB July 22, 2013). The facts at issue here are instead closely analogous to—and in fact more egregious than—*Ivantis, Inc. v. Glaukos Corp.*, which necessitates that Petitioner's motion be denied. *Compare* IPR2018-01180, Paper No. 14 at 9 (PTAB Dec. 6, 2018) (denying motion to correct where "[d]uring preparation of the Petition for filing, the incorrect version of the reference ... was inadvertently stored on the network share drive used by an associate and a paralegal, and was mistakenly

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<sup>1</sup> Petitioner's Motion is incorrectly signed as "Counsel for Patent Owner."

referenced during cite checking and proofing of the Petition.”) *with* EX1039 at ¶4-5 (“...I sent a folder directory of the references and documents cited in the Petition to support staff ...Unfortunately, I inadvertently only included ’230 Wang in that directory....”). *See also* *Varian Med. Sys., Inc. v. Best Med. Int’l, Inc.*, IPR2020-00075, Paper No. 13 at 6-7 (PTAB May 1, 2020) (denying similar motion where incorrect document was filed in place of petition).

### **I. PETITIONER’S MOTION SHOULD BE DENIED**

A petition should “be complete at the time it is filed.” *Axis Comm. AB v. Avigilon Fortress Corp.*, IPR2019-00235, Paper No. 19 at 6 (PTAB June 4, 2019) (denying motion to correct and citing 35 U.S.C. § 312(a)(3); 37 C.F.R. §§ 42.22, 42.104(b)). Petitioners may seek to “correct a clerical or typographical mistake in the petition,” 37 C.F.R. § 42.104(c), but corrections cannot be used to correct a substantive mistake in the Petition. *Axis Comm.*, IPR2019-00235, Paper No. 19 at 7 (“**Rule 104(c) ... does not give petitioner recourse to make substantial alterations to the petition or the evidence supporting the petition . . .**”) (emphasis added).

The Board has recognized several applicable factors, including: (1) the nature of the error, and whether the party requesting relief provides adequate explanation for how the error occurred; (2) the length of time elapsed between learning of the error and bringing the error to the Board’s attention; (3) prejudice to the other party,

if any, by allowing the proposed corrections; and (4) whether the proposed corrections have any impact on the proceeding. *Ivantis*, IPR2018-01180, Paper No. 14 at 9.

**A. The Nature of the Error Weighs Against Petitioner’s Relief**

It is not possible to discern the “correct” reference Petitioner may have intended to cite from the Petition itself. The Petition's exhibit list identifies US5,876,230 (Wang ’230) as EX1016, Pet., p.1; US7,606,928 (Wang ’928) was not submitted as an exhibit and is identified *nowhere* in the Petition. This is not merely a “clerical” error. *See Ivantis*, IPR2018-01180, Paper No. 14 at 14 (“A patent owner should not have to guess what challenges a petitioner intends to make in a petition but did not.”); *see also Parus Holdings, Inc. v. Google LLC*, 70 F4th 1365, 1372 (Fed. Cir. 2023) (“[T]he Board should not be forced to play archaeologist with the record.”) (internal quotations removed).

The declaration of Michael Hopkins, EX1039, lacks critical details. For example, while Mr. Hopkins states that the error occurred because of the use of a placeholder during drafting of the Petition, EX1039, ¶4, Petitioner does not explain how or why the same errors were also included in Petitioner’s expert’s (Dr. Reader’s) declaration, EX1006, or why Dr. Reader, expressly identifies “*Wang*” as “U.S. 5,867,230” in the text of his declaration (*id.*, ¶97 (citing EX1016)) and list of materials considered (*id.*, p.6). *Amkor Tech., Inc. v. Tessera, Inc.*, IPR2013-00242,

Paper No. 32 at 4 (PTAB Aug. 29, 2013) (“We conclude that [declarant’s] analysis is subject to the same types of inconsistencies that are found in the Petition, and does not support that the errors in the Petition were simply clerical or typographical.”). Petitioner also fails to address whether Dr. Reader was aware of these “errors,” or whether he had considered both Wang’230 and Wang’928, at the time he affixed his signature. EX1006, p.1; *cf. id.* ¶3. This alone should result in denial of Petitioner’s motion. *See Nitro Fluids, LLC v. Cameron International Corp.*, IPR2019-00852, Paper No. 20 at 5 (PTAB Nov. 19, 2019) (relying on Petitioner’s failure to “submit any statement from [expert witness that] his declaration is erroneous” as a fact supporting denial of motion to correct).

Allowing Petitioner to introduce “corrections” into Dr. Reader’s declaration, without a signed statement from Dr. Reader pursuant to 18 U.S.C. § 1001, is in contravention of the Board’s Rules. *See* 37 C.F.R. § 42.53 (uncompelled direct testimony must be submitted in the form of an affidavit); 37 C.F.R. § 1.68 (requiring signed statement pursuant to 18 U.S.C. § 1001).

Petitioner also fails to address Petitioner’s lead counsel’s role in the error. *See* TPG at 11 (“T[]he role of back-up counsel is to conduct business with the Office on behalf of lead counsel when lead counsel is not available.”). Though Petitioner’s lead counsel has changed since filing of the Petition, no statement is given from Petitioner’s lead counsel at the time: Mr. Daniel Yannuzi, who signed the Petition

and has not withdrawn as counsel. Petitioner offers no explanation of Mr. Yannuzzi's role, including for example whether he participated in any way in drafting the Petition, his level of oversight over Mr. Hopkins' work, or whether he even reviewed the Petition before affixing his signature. Rather, Petitioner chose to place the blame on a more junior lawyer. Since Mr. Yannuzzi's signature appears on the Petition, he is ultimately responsible, yet has provided no explanation for the error. *See* 37 C.F.R. § 11.101; *Conmed Corp. v. Bonutti Skeletal Innov. LLC*, IPR2013-00624, Paper No. 18 at 8 (PTAB Feb. 21, 2014) (“[T]he responsibilities of Petitioner’s counsel include reviewing documents uploaded during this proceeding...”); *see also* 37 C.F.R. §§ 11.103, 11.501.

**B. Patent Owner Would be Unduly Prejudiced by the Correction**

Petitioner's argument is undercut by Petitioner's own delay in waiting until one day before the one-year statutory deadline for filing the Petition. Petitioner offers no explanation of how the error was discovered, EX1039, ¶6, or identify the gap between discovery of the error and notification to Patent Owner. *Id.* (merely the error was discovered “shortly” after August 9). Petitioner attempts to dismiss the prejudice to Patent Owner, noting the Board “already” extended the deadline for submission of Patent Owner's Preliminary Response (“POPR”), and because Patent Owner was “provided” with the correct reference on August 21. This was approximately three weeks after submission of Petition, covering almost a full third

of Patent Owner's statutorily guaranteed three-month period for submission of the POPR. *See* 37 C.F.R. § 42.107.

Moreover, Patent Owner is prejudiced because Petitioner's proposed relief would circumvent the twelve-month statutory deadline Congress established for filing an IPR set by the AIA. *See* 35 U.S.C. § 315(b). Indeed, that deadline was extended from 6 months, which was the original deadline in the version of the AIA that passed the Senate in March 2011. *See* S. 23, 112<sup>th</sup> Cong. § 5(a), § 315(b)(2011); Joe Matal, A Guide to the Legislative History of the AIA: Part II of II, Fed. Cir. Bar J., Vol 21, No. 4, 539 at 611.<sup>2</sup> Thus, Congress already carefully considered and balanced (1) the petitioners' interest in allowing time to sufficiently develop their invalidity case before filing an IPR petition, and (2) the Patent Owners' interest in promptly receiving any petition that might disrupt the speedy progress of the district court litigation. By making substantive changes to the petition well after the twelve-month deadline, petitioner effectively disrupts this balance, providing itself an extension of time to file a petition in compliance with the AIA and Board's Rules. Petitioner's purported mistake in petition preparation is a problem of its own making, which could have been avoided had Petitioner moved more deliberately in its petition filing. Patent Owner would therefore be prejudiced by the requested

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<sup>2</sup>[https://www.uspto.gov/sites/default/files/aia\\_implementation/guide\\_to\\_aia\\_part\\_2.pdf](https://www.uspto.gov/sites/default/files/aia_implementation/guide_to_aia_part_2.pdf).

relief, which would deprive Patent Owner of the benefit of the statutory right Congress gave in the AIA.

**C. The Proposed Corrections Will Have an Impact on the Proceedings**

The Petition as filed contains a fatal issue—failure to include a reference sought to be relied upon for Ground 2. The lack of a reference necessary for Ground 2 will necessarily impact at least’s the Board’s discretionary decision to institute. Relatedly, the proposed corrections will completely alter the substantive content of Patent Owner’s POPR—namely, whether or not Patent Owner needs to address the correct “Wang” reference, or not. This will have a significant impact on the total word count, and structure of the Patent Owner’s required briefing, with only a short time prior to submission.

**II. CONCLUSION**

Petitioner’s Motion to Correct should be denied.

Date: November 7, 2023

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(a), this is to certify that I caused to be served a true and correct copy of the foregoing PATENT OWNER'S RESPONSE TO PETITIONER'S MOTION TO CORRECT THE PETITION via the PTAB's E2E system and sent via email as detailed below.

Date of service: November 7, 2023

Documents served: PATENT OWNER'S RESPONSE TO PETITIONER'S MOTION TO CORRECT THE PETITION

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