

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PELOTON INTERACTIVE, INC.,
Petitioner,

v.

NEC CORPORATION,
Patent Owner.

IPR2023-01239
Patent 8,752,101 B2

Before MICHAEL J. STRAUSS, CHARLES J. BOUDREAU, and
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

STRAUSS, *Administrative Patent Judge*.

ORDER

Granting Motion to Correct Clerical or Typographical Mistakes
37 C.F.R. §§ 42.5, 42.104

I. Background

In an e-mail to the Board dated August 28, 2023 (Ex. 3001), Peloton Interactive, Inc. (“Petitioner”) requested authorization to correct the Petition in the above-identified *inter partes* review proceeding (Paper 2 (“Petition”

or “Pet.”)). According to Petitioner, the Petition and the accompanying Declaration of Clifford Reader, Ph.D. ((“Reader Declaration” or “Reader Dec.”))¹ “incorrectly refer to EX1016 as U.S. Patent No. 5,867,230 to Wang et al. (‘Wang ’230’) instead of U.S. Patent No. 7,606,928 to Wang et al. (‘Wang ’928’) and failed to list Wang ’230 as EX1038.” Ex. 3001. Petitioner further requested authorization to file Wang ’928 as Exhibit 1016 and to make corresponding exhibit designation corrections. *Id.* Petitioner also attached its intended revised versions of these papers to the email. Petitioner seeks correction under 37 C.F.R. § 42.104(c), which provides that “[a] motion may be filed that seeks to correct a clerical or typographical mistake in the petition” and that “[t]he grant of such a motion does not change the filing date of the petition.”

NEC Corporation (“Patent Owner”) responded by e-mail on August 29, 2023 (Ex. 3002), opposing Petitioner’s request and arguing that the alleged mistakes are not clerical or typographical mistakes under 37 C.F.R. § 42.104(c) because they introduce a new prior art reference and substantively alter the asserted grounds after the bar date for the Petition has passed.

On October 24, 2023, Judges Strauss, Boudreau, and Ogden held a conference call with the parties. Scott C. Weidenfeller of Covington & Burling LLP argued for Petitioner, and Eliot D. Williams of Baker Botts LLP argued for Patent Owner. During the call and as set forth in our Order of October 26, 2019 (Paper 10 (“Order” or “Ord.”)), we authorized Petitioner to file a motion seeking the requested relief and we authorized

¹ Non-public and public versions of the Reader Declaration are filed as Exhibits 1006 and 1037, respectively.

Patent Owner to file an opposition to Petitioner's motion. Ord. 3. We also granted an extension of the deadline for Patent Owner to file any preliminary response to the Petition until one week following the Board's decision on the authorized motion to correct. *Id.* We did not authorize any reply.

As authorized by our Order, Petitioner filed a motion (Paper 11 ("Motion" or "Mot.")) to correct typographical errors in the Petition and in the Reader Declaration. Patent Owner filed a Patent Owner's Response to Petitioner's Motion to Correct the Petition (Paper 12 ("Patent Owner's Opposition" or "Opp.")) opposing Petitioner's Motion.

II. Petitioner's Contentions

In its Motion, Petitioner restates the requested corrections to the Petition and Reader Declaration (Mot. 1), submitting in support of its request the declaration of Michael J. Hopkins (Ex. 1039, "Hopkins Dec."), an associate attorney who assisted Petitioner's counsel in preparing and filing the Petition. Hopkins Dec. 1. Petitioner asserts "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." Mot. 1 (citing Hopkins Dec. 5). Petitioner argues the requested corrections are clerical in nature and are permissible under 37 C.F.R. § 42.104(c). *Id.* at 2. According to Petitioner, the present situation is similar to that in *ABB Inc. v. ROY-G-BIV Corp.*, IPR2013-00063, Paper 21 at 7 (Jan. 16, 2013), in which petitioner ABB was permitted to correct a clerical error of uploading an incorrect document. *Id.* at 2–3. Petitioner further cites to *Syntroleum Corp. v. Neste Oil Oyj*,

IPR2013-00178, Paper 21 (July 22, 2013) in support of correction of an inadvertent submission of an incorrect exhibit. *Id.* at 3.

Petitioner distinguishes the requested corrections over those denied entry in *Ivantis, Inc. v. Glaukos Corp.*, IPR2018-01147, Paper 14 (Dec. 6, 2018), arguing “[u]nlike 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 3-4 (*citing Ivantis* at 9). According to Petitioner, “[i]n 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.” *Id.* at 4.

Petitioner further asserts “Patent Owner would not suffer prejudice from the proposed corrections,” arguing the Board has extended the due date for Patent Owner to file its Preliminary Response and Patent Owner has been aware of the error since at least August 21, 2023, when notified by Petitioner and provided with a copy of the Wang ’928 reference. *Id.* Petitioner distinguishes the current situation over that in *Ivantis*, wherein petitioner Ivantis did not recognize or seek to correct the error until after patent owner Glaukos’s preliminary response was filed. *Id.* at 5.

III. Patent Owner’s Contentions

In its Opposition, Patent Owner contends “Petitioner’s proposed corrections go far beyond mere ‘clerical or typographical’ mistakes correctable under Rule 104(c)” by “attempting to substantively alter the evidence—and the Grounds—in the Petition by submitting an entirely new reference not previously of record.” Opp. 1. Patent Owner argues

Petitioner’s reliance on *Syntroleum* is misplaced because, in that case, “the Board allowed Petitioner to substitute what was substantively the same reference where the only difference was which published version was submitted.” *Id.* (citing *Syntroleum*, Paper 21 (Decision on Motion to Correct Petition)). Patent Owner asserts that “[t]he 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.” *Id.*

Patent Owner alleges at least four factors considered by the Board in whether to allow correction all weigh against granting Petitioner’s Motion, 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.

Opp. 2–3 (citing *Ivantis*, Paper 14 at 9 (Decision Denying Institution of *Inter Partes* Review, 35 U.S.C. § 314(a), Denying Motion to Correct the Petition, 37 C.F.R. 42.104(c))).

Addressing factor 1, Patent Owner argues the nature of the error weighs against Petitioner’s requested relief because the Wang ’928 reference, which would be selectively substituted for Wang ’230, “was not submitted as an exhibit[,] is identified *nowhere* in the Petition,” and is not discernable from the Petition itself. Opp. 3. Patent Owner further argues the Petition is insufficient because “[t]he declaration of Michael Hopkins, EX1039, lacks critical details” including “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.* (citing Petition, EX1039, ¶ 97)). According to Patent Owner, the lack of explanation concerning the errors in the Reader Declaration, how Dr. Reader became aware of the errors, and whether both Wang references were considered “alone should result in denial of Petitioner’s motion.” *Id.* at 4 (citing *Nitro Fluids, LLC v. Cameron Int’l Corp.*, IPR2019-00852, Paper 20 at 5 (PTAB Nov. 19, 2019)). Moreover, Patent Owner asserts “[a]llowing 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.” *Id.* (citing 37 C.F.R. §§ 1.68, 42.53).

Patent Owner further argues Petitioner’s Motion is deficient because it “fails to address Petitioner’s lead counsel’s role in the error” and, instead, improperly “places[s all] blame on a more junior lawyer.” Opp. 4 (citing Patent Trial and Appeal Board Consolidated Trial Practice Guide² (TPG) at 11; 37 C.F.R. § 11.101; *Conmed Corp. v. Bonutti Skeletal Innovations LLC*, IPR2013-00624, Paper 18 at 8 (PTAB Feb. 21, 2014)).

Addressing factor 2, Patent Owner contends “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.” Opp. 5. Patent Owner argues Petitioner’s Motion provides insufficient detail about how the error was discovered or about “the gap between discovery of the error and notification to Patent Owner.” *Id.* (citing Motion, Ex. 1039 ¶ 6). Patent Owner alleges a

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

three-week delay in providing the correct reference that covered “almost a full third of Patent Owner’s statutorily guaranteed three-month period for submission of the [patent owner’s preliminary response (POPR)].” *Id.* at 5–6 (citing 37 C.F.R. § 42.107).

Addressing factor 3, Patent Owner asserts it “is prejudiced because Petitioner’s proposed relief would circumvent the twelve-month statutory deadline Congress established for filing an IPR set by the AIA.” Opp. 6 (citing 35 U.S.C. § 315(b)). Patent Owner argues that, “[b]y making substantive changes to the petition well after the twelve-month deadline, petitioner effectively disrupts [Congress’s balancing of Petitioner’s and Patent Owner’s interests], providing itself an extension of time to file a petition in compliance with the AIA and Board’s Rules.” *Id.*

Addressing factor 4, Patent Owner contends the proposed corrections will have an impact on the proceedings as it corrects a fatal issue to include a necessary reference relied upon for Ground 2 and “will necessarily impact at least’s the Board’s discretionary decision to institute.” *Id.* at 7. Patent Owner further argues “the proposed corrections will completely alter the substantive content of [the] POPR—namely, whether or not Patent Owner needs to address the correct ‘Wang’ reference, or not,” and would result in “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.” *Id.* at 7.

IV. Discussion

Based on the evidence before us and under these circumstances, we are persuaded that granting Petitioner’s Motion to correct the Petition is warranted. Although the Petition identifies Exhibit 1016 as “U.S. Patent

No. 5,867,230 (“Wang”),” i.e., Wang ’230, not Wang ’928, the Petition describes Wang as having been filed on March 21, 2003, published September 23, 2004, and issued October 20, 2009, these dates being applicable to Wang ’928, not the erroneously identified Wang ’230. Pet. 10. Moreover, the narrative that follows includes quotations with pinpoint citations (“pin cites”) to language that is found in Wang ’928, not in Wang ’230, and further includes a block diagram referred to as Exhibit 1016’s “FIG 3,” that figure appearing in Wang ’928 rather than Wang ’230. *Id.* at 10–11. Still further, pin cites to *Wang* at pages 62–65 and 69–74 of the Petition refer to and include language found at the identified places in Wang ’928, not in Wang ’230. Thus, the error would have become apparent when a reader failed to find the cited text and figure that were misattributed to Wang ’230 instead of Wang ’928.

Moreover, Patent Owner does not persuade us that “[i]t is not possible to discern the ‘correct’ reference Petitioner may have intended to cite from the Petition itself.”³ Opp. 3. The Petition correctly identifies the surname of the first named inventor as Wang⁴ together with the correct filing,

³ We note in passing that, according to Petitioner, “Patent Owner indicated that it had independently found the Wang ’928 reference before [Petitioner provided the Wang ’928 reference to Patent Owner on August 21, 2023].” Mot. 4 fn. 2.

⁴ We note in passing that some confusion may have in part resulted from the fact that the first-named inventors of the unrelated Wang ’230 (Feng Chi Wang, of Newton, Massachusetts) and Wang ’928 (Ru-Shang Wang, of Coppell, Texas) patents have the same surnames.

publication, and issue dates for Wang '928,⁵ and further includes (i) language quoted from⁶ and (ii) a figure attributed to Wang which only appear in Wang '928. Moreover, the Reader Declaration correctly identifies the full patent number of Wang '928 in the Table of Contents and in the section heading on page 40 of the declaration.

Although we agree it is not appropriate to force one to play archaeologist with and excavate through the record (*id.* citing *Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365, 1372 (Fed. Cir. 2023)), neither is it appropriate to ignore the artifacts that lay visible at one's feet. Here, a simple comparison between the pin-cited material misattributed to Wang '230 in the Petition and corresponding portions of Wang '230 readily reveals the error. The correction of the citation error is achievable by several means including reference to the Reader Declaration, which identified the correct patent number in at least two places, a search of the filing and publication dates of the Wang reference provided in the Petition, or a search of patents

⁵ A search using the USPTO Patent Public Search tool (available at <https://ppubs.uspto.gov/pubwebapp/#Field-Specific-Searches>) for patents having the indicated filing date of March 21, 2003, and publication date of September 23, 2004, using the search string *@fd= "20030321" and @pd= "20091020"* identifies Wang '928 as one of only two patents satisfying the search criteria: US 7603847 B2 of Surnilla et al. and US 7606928 B2 of Wang et al. (i.e., Wang '928).

⁶ For example, a search using the USPTO Patent Public Search tool for wording corresponding to disclosure cited in the Petition as appearing in Wang '230 (e.g., "the transmission rate and/or nominal playout rate of the different media to maintain the receive buffer fullness level" (Pet. 62 (citing Ex. 1016 [Wang '230], 7:13–20; Ex. 1006 [Reader Dec.] ¶ 250)), using the search string *"transmission rate" near2 "nominal playout rate"*, identifies Wang '928 as the only patent document satisfying the specified search criteria.

based on language quoted from the Wang reference as set forth in the Petition.

We further are unpersuaded that “Petitioner is attempting to substantively alter the evidence—and the Grounds—in the Petition by submitting an entirely new reference not previously of record.” Opp. 1. The substantive descriptions and arguments presented in the Petition sought to be corrected are based on disclosure found in Wang ’928. What Petitioner requests is to correct the miscitation or misattribution of those descriptions, not their substance or the substance of any argument.

We are also unpersuaded by Patent Owner’s contention the Petition’s failure to properly cite to Wang ’928 “is not merely a ‘clerical’ error.” Opp. 2. None of the arguments or even language attributable to the references would be changed or otherwise affected by entry of the requested corrections. Moreover, Petitioner asserts that the error resulted from a failure to include the previously identified and intended Wang ’928 in “a folder directory of the references and documents cited in the Petition [that was sent] to support staff that could be used to generate the final exhibits and to fill out the Exhibit List table with Exhibit Numbers and descriptions of the Exhibits.” Mot. 2. Patent Owner fails to explain why such an error is not clerical in nature.⁷

⁷ Although not controlling, at least one source defines “clerical error” as “an error in the preparation, assembly, or submission of a document which results when a person intends to do one thing but does something else. It includes, for example, errors in transcribing numbers, errors in arithmetic, and the failure to assemble all the documents in a record.” 19 CFR § 162.71 - Definitions.

We are further unpersuaded by Patent Owner’s assertion that the Hopkins Declaration is insufficient because it does not include an explanation of “how or why the same errors were also included in [the Reader Declaration].” Opp. 3. Petitioner explains Wang ’928 was inadvertently omitted from the directory used “throughout the Petition *and Declaration* of Clifford Reader.” Mot. 2 (emphasis added). However, we do agree it would be improper to introduce corrections to the Reader Declaration without requiring the affiant or declarant, Dr. Reader, to review and indicate adoption of the changes. Opp. 3. Accordingly, we require the requested changes to the Reader Declaration be submitted in the form of a corrected version of the Reader Declaration, which has been properly executed by Dr. Reader pursuant to 18 U.S.C. § 1001, as another instance of Exhibits 1006 and 1037, the Declaration including the word “Revised” in its title.

Although we agree that because “Mr. Yannuzi’s signature appears on the Petition, he is ultimately responsible . . . for the error,” Patent Owner fails to explain why there is a need for his explanation concerning the error in view of the Hopkins Declaration. Opp. 5. In connection with Patent Owner’s contention that “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” (*id.*), it is unclear why an earlier filing would have provided either party with a further opportunity to discover and correct the error. To be sure, an earlier filing may have allowed Petitioner to file a revised Petition accorded a new filing date to the extent the new filing date was before any statutory time-bar. Although that would have provided Patent Owner with additional time to respond to the revised Petition, it is not

clear how it would have provided either party with additional opportunity to discover and correct the error. Moreover, as noted below, Patent Owner's net loss here is only 3 business days (8 to be notified of the error, of which 5 were granted back). In any case, Petitioner's requested remedy under 37 C.F.R. § 42.104(c) is only necessary because it is made after passage of the one-year statutory deadline of 35 U.S.C. § 315(b). Thus, it is not clear why, on this basis, the instant request is any different from similar requests in which the Board has granted a request to correct typographical or clerical errors in a petition.

Moreover, we disagree that the delay in providing the correct reference covered "almost a full third of Patent Owner's statutory guaranteed three-month period for submission of the POPR." Opp. 5–6. Petitioner brought the error to Patent Owner's attention on August 21, 2023, 12 calendar days (i.e., less than one-seventh, not one-third, of the statutory three-month period and representing only 8 business days) after the entry of the Board's Notice of Filing Date Accorded (Paper 3) starting the three-month clock for the filing of Patent Owner's Preliminary Response, and Petitioner brought the error to the Board's attention one week later, on August 28, 2023. Ex. 3001, Email and attachments from Petitioner. That is, even if we were not to extend the due date for filing Patent Owner's Preliminary Response, Patent Owner had 80 calendar days (56 business days) after being put on notice of the error to file its Preliminary Response. In any case, as our Order of October 26, 2023, extended that due date until one week after issuance of the instant Decision, we ascertain little to no significant prejudice to Patent Owner based on Petitioner's delay in its identification of the error.

Finally, although we agree replacement of Wang '230 with Wang '928 potentially impacts whether to institute trial as it is dispositive as to Ground 2 of the Petition, Wang '928 is asserted as an alternative to Chou as applied under Ground 1 for the limited purpose of disclosing “the transmission rate and/or nominal playout rate of the different media to maintain the receive buffer fullness level.” Pet. 62. Thus, whether or not Wang '928 is available to support Ground 2, although potentially significant to our decision whether to institute trial, substitution of the correct patent number of the reference has not been shown to require significant additional briefing or analysis.

V. Conclusion

On the current record, we determine that allowing the requested correction would be in the interests of justice and would advance the core functions described in the Trial Practice Guide. Additionally, we determine allowing the requested correction would also promote “the just, speedy, and inexpensive resolution of our proceedings.” 37 C.F.R. § 42.1. Accordingly, we exercise our discretion to allow Petitioner to file a corrected Petition and Declaration of Clifford Reader, Ph.D. in Support of Petition for *Inter Partes* Review of U.S. Patent No. 8,752,101 as detailed in the attachment to Petitioner’s email of October 26, 2023, EX3001. Petitioner shall file its corrected version of the Petition as a paper at the next available paper number. Petitioner also shall file its corrected versions of the Reader Declaration as other instances of Exhibits 1006 (unredacted version) and 1037 (redacted version) for consistency with Petitioner’s citations. Each revised paper shall include the word “Revised” in its title. We shall treat

each revised paper as if it had been filed on the original filing date of the Petition. *See* 37 C.F.R. § 42.104(c).

Although we grant the instant motion, we observe that the errors at issue here could have been avoided with rudimentary proofreading.⁸ The panel will be reluctant to entertain such corrections in the future.

In consideration of the foregoing, it is

ORDERED that Petitioner’s motion to correct clerical or typographical mistakes is *granted*;

FURTHER ORDERED that Petitioner shall file its corrected version of the Petition using the paper type “Petition: corrected”;

FURTHER ORDERED that Petitioner shall file its corrected versions of the Reader Declaration as other instances of Exhibits 1006 (unredacted version) and 1037 (redacted version);

FURTHER ORDERED that each revised paper shall include the word “Revised” in its title;

FURTHER ORDERED that the filing of these revised papers does not change the original filing date of the Petition; and

FURTHER ORDERED that the due date for Patent Owner’s Preliminary Response is five business days after the date of this order.

⁸ We note, as a further example and as pointed out by Patent Owner (*see* Opp. 1 n.1), Petitioner’s Motion is incorrectly signed as “Counsel for *Patent Owner*” (Mot. 5 (emphasis added)).

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