

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

Conduct of the Proceedings
37 C.F.R. § 42.5

In an e-mail to the Board dated September 5, 2024 (Ex. 3003), NEC Corporation (“Patent Owner”) requests authorization to file a motion pursuant to 37 C.F.R. § 42.23(b) to strike portions of Peloton Interactive, Inc.’s (“Petitioner’s”) Reply (Paper 25) and the Supplemental Declaration of Clifford Reader, Ph.D. (Ex. 1040), alleging that “Petitioner’s Reply, citing a newly filed supplemental expert declaration of Dr. Reader, raises new theories and arguments concerning how the ‘available time’ limitation of the claims is met by Chou.” Ex. 3003. “In the alternative, Patent Owner seeks leave to file, with its sur-reply, a supplemental expert declaration responding to the [alleged] new theories and opinions in Dr. Reader’s supplemental declaration, EX1040 at ¶¶6–15, 22–24, and 28–29.” *Id.* Patent Owner represents that the parties have met and conferred and that Petitioner indicated it would oppose. *Id.*

In this Order, we discuss each of Patent Owner’s requests.

REQUESTED MOTION TO STRIKE

Based on our review of the Reply and the accompanying evidence, we conclude that Patent Owner’s Sur-reply is a sufficient procedural vehicle for Patent Owner to discuss the issues underlying the requested motion to strike. Accordingly, we *deny* Patent Owner’s request for authorization to file a motion to strike.

REQUESTED SUBMISSION OF NEW EVIDENCE WITH PATENT OWNER SUR-REPLY

We authorize Patent Owner to file a supplemental expert declaration with its Sur-reply, limited to rebutting paragraphs 6–15, 22–24, 28, and 29 of the Supplemental Declaration of Clifford Reader (Ex. 1040). Other than

this, we do not otherwise waive the requirement that a sur-reply “may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness.” 37 C.F.R. § 42.23(b); *see* PTAB Consolidated Trial Practice Guide (Nov. 2019)¹ at 73–74; *see also* 37 C.F.R. § 42.5(b) (authorizing the Board to waive or suspend default requirements in *inter partes* proceedings).

BRIEFING AND CASE SCHEDULE CONSIDERATIONS

Patent Owner must adhere to the existing October 4, 2024 deadline for filing its Sur-reply (*see* Paper 24), unless otherwise agreed to by the parties, along with the supplemental expert declaration authorized herein. The Sur-reply must comply with the Board’s default 5,600-word count limitation. *See* 37 C.F.R. § 42.24(c)(4).

Petitioner may cross-examine Patent Owner’s declarant via deposition regarding any declaratory testimony that Patent Owner submits with its Sur-reply. Any such deposition must take place no more than five business days after the filing of the Sur-reply and such testimony.

In the event that Petitioner believes a sur-sur-reply is necessary or warranted, it should request a conference call with the panel and the parties to discuss the matter.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner’s request for authorization to file a motion to strike is *denied*;

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

FURTHER ORDERED that Patent Owner is authorized to file a supplemental expert declaration with its Sur-reply on or before October 4, 2024, unless otherwise agreed to by the parties, limited to rebutting paragraphs 6–15, 22–24, 28, and 29 of the Supplemental Declaration of Clifford Reader (Ex. 1040);

FURTHER ORDERED that Petitioner is authorized to cross-examine Patent Owner’s witness via deposition regarding any declaratory testimony that Patent Owner submits with its Sur-reply, no more than five business days after the filing of the Sur-reply and such testimony; and

FURTHER ORDERED that, in the event that Petitioner believes a sur-sur-reply is necessary or warranted, it should request a conference call with the panel and the parties to discuss the matter.

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