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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IPR Case No. IPR2023-01240
Patent 9,769,427

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STATEMENT REGARDING MULTIPLE PETITIONS

Petitioner Peloton Interactive, Inc. ("Petitioner") submits this paper pursuant to pages 59-60 of the Patent Trial and Appeal Board Consolidated Trial Practice Guide (November 2019). Petitioner has filed two petitions for *inter partes* review of U.S. Patent No. 9,769,427 ("the '427 Patent") and ranks them as follows: (1) IPR2023-01240 ("Petition A") challenging claims 1-9, 14-18, 20, 22, 32 and 34-36; and (2) IPR2023-01241 ("Petition B") challenging claims 10-13, 19, 21, 23 and 33.

Both petitions are necessary for Petitioner to fully address all challenged claims of the '427 Patent without exceeding the Board's word-count limitation. The challenged claims are numerous in total number of claims (28), numerous in total number of independent claims (14), and voluminous in length (5,738 words).

I. Two Petitions Are Needed to Address the Volume of Asserted Claims

Two petitions are necessary for Petitioner to challenge the claims of the '427 Patent. Patent Owner NEC Corporation ("Patent Owner") has asserted that Petitioner infringes the '427 Patent in a related proceeding pending in the U.S. District Court for the District of Delaware (*NEC Corp. v. Peloton Interactive, Inc.*, No. 1:22-cv-00987-CFC, filed July 28, 2022) (hereinafter, the "Related Litigation"). Specifically, Patent Owner asserts that Petitioner infringes claims 1, 4, 5, 14-18, 20, 22, 32 and 34-36 of the '427 Patent (challenged in Petition A). Several of the unasserted claims of the '427 patent (challenged in Petition B) have

certain limitations that are similar or identical to limitations in the asserted claims (for example, compare claim 1 to claims 10 and 21; compare claims 1, 4 and 5 to claim 33; and compare claims 1, 15 and 17 to claims 19 and 23). Patent Owner has reserved the right to supplement its initial infringement contentions and thus might attempt to assert additional claims of the '427 Patent against Petitioner at a later date.

Accordingly, Petitioner requires a full and fair opportunity to challenge the claims of the '427 Patent. In light of the number of claims (28), the number of independent claims (14), and their collective length (5,738 words), Petitioner is unable to properly address each of the challenged claims in one petition within the Board's word-count limitation. In these circumstances, filing multiple petitions is reasonable. *See, e.g., Microsoft Corp. v. IPA Techs. Inc.*, IPR2019-00810, Paper 12 at 14 (finding Petitioner's decision to file five separate petitions reasonable given word-count limitations and "a large number of challenged claims"); *Intel Corp. v. VLSI Tech. LLC*, IPR2019-01199, Paper 19 at 11 (Feb. 6, 2020) (finding three petitions reasonable where the patent owner initially asserted 20 claims against the petitioner in a related district court action); *Intel Corp. v. Tela Innovations, Inc.*, IPR2019-01520, Paper 14 at 16-17 (Mar. 11, 2020) (finding three petitions challenging 24 claims reasonable).

Here, both petitions rely on related grounds and challenge different sets of independent claims while relying on common prior-art references for the challenged claims.

Specifically, the Petition A challenges the claims asserted in the Related Litigation as follows:

(a) independent claims 1, 14, 18, 20, 22, 32 and 34-36 and dependent claims 4, 5 and 16 as rendered obvious by (1) U.S. Patent Application Publication No. 2009/0094321 A1 to Ueda et al. ("Ueda"); in view of (2) J. Rosenberg et al., *SIP: Session Initiation Protocol* (RFC 3261, Network Working Group, Internet Engineering Task Force, June 2002) (the "SIP Standard"); and (3) either M. Handley et al., *SDP: Session Description Protocol* (RFC 4566, Network Working Group, Internet Engineering Task Force, July 2006) (the "SDP Standard") or U.S. Patent Application Publication No. 2009/0100496 A1 to Bechtolsheim et al. ("Bechtolsheim"); and

(b) dependent claims 15 and 17 as rendered obvious by (1) Ueda in view of (2) the SIP Standard and (3) either the SDP Standard or Bechtolsheim, in further view of (4) U.S. Patent Application Publication No. 2010/0010884 A1 to Cohee et al. ("Cohee").

Petition A also challenges the remaining claims depending from claim 1. Specifically, Petition A challenges dependent claims 2 and 3 as rendered obvious by (1) Ueda in view of (2) the SIP Standard and (3) either the SDP Standard or Bechtolsheim, in further view of (4) Cohee. Petition A also challenges dependent claims 6-9 as rendered obvious by (1) Ueda in view of (2) the SIP Standard and (3) either the SDP Standard or Bechtolsheim.

Petition B challenges the unasserted claims as follows:

(a) independent claims 10, 21 and 33 as rendered obvious by (1) Ueda in view of (2) the SIP Standard and (3) either the SDP Standard or Bechtolsheim; and

(b) independent claims 19 and 23 and dependent claims 11 and 13 as rendered obvious by (1) Ueda in view of (2) the SIP Standard and (3) either the SDP Standard or Bechtolsheim, and further in view of (4) Cohee.

II. Two Petitions Are Needed to Fully Analyze the Asserted Claims Given Their Length and Complexity

As discussed above, the 28 challenged claims (particularly the 14 independent claims) contain lengthy limitations. Indeed, the claim set itself is 5,738 words in length – almost 41% of the word count limit. Two petitions are reasonable to provide a thoughtful and thorough discussion of the challenged

claims. *See Snap Inc. v. Sanderling Management LTD.,* IPR2021-00780, Paper 20 at 18-19 (finding Petitioner's decision to file two separate petitions reasonable, in part, given that "the word count for the 34 claims challenged in the two petitions is approximately 10% of the word count limit for a single petition").

III. The Differences in the Claims Addressed by the Petitions Are Material

Despite their similarities, the differences between the petitions—the challenged claims—are material, and denial of either petition would be highly prejudicial to Petitioner. Here, two petitions are needed because the differences between the claims, as well as the number, length, and complexity of the claims, warrants discussion beyond the word-count limitation of a single petition. This is not a situation where multiple petitions attack identical claim sets, leveraging the extra space to assert additional prior-art references or multiple reference permutations against the same claims.

IV. Two Petitions Are Not Unduly Burdensome on the Board Given Overlapping Prior Art Grounds

Both petitions are based on the same primary reference (Ueda), and both rely upon the SIP Standard, the SDP Standard, Bechtolsheim, and Cohee for various grounds. While the petitions have differences in their treatment of independent claims 19, 23 and 33, petitions can be efficiently resolved without undue burden on

the Board because both petitions rely on the same prior art and similar argument as to the independent and dependent claims.

Moreover, the Board's familiarity with the commonly asserted art and other issues in one petition will streamline its analysis of the other. To the extent that two petitions causes any increased burden on the Board, the burden can be reduced by consolidating the instituted proceedings, which would streamline briefing, motion practice, and hearings. *See IPA Techs.*, IPR2019-00910, Paper 12 at 15 (Oct. 16, 2019). Petitioner would not object to such consolidation if the Board were to institute proceedings on both petitions.

V. No Duplication of Previous Efforts

The '427 Patent is not the subject of *any* prior filed *inter partes* review petition by any petitioner.

VI. Conclusion

As explained above, institution of both petitions is necessary to allow Petitioner the opportunity to fully and fairly challenge the claims of the '427 Patent and does not present an undue burden on the Board. Denial of the petitions would prejudice Petitioner by depriving it of such an opportunity.

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Respectfully submitted,

Dated: July 27, 2023

/Darren M. Franklin/

Darren M. Franklin (Registration No. 51,701)
Daniel N. Yannuzzi (Registration No. 36,727)
Mark W. Catanese (Reg. No. 64,279)
SHEPPARD, MULLIN, RICHTER & HAMPTON LLP
333 South Hope Street, 43rd Floor
Los Angeles, California 90071-1422
Telephone: 213.620.1780
Facsimile: 213.620.1398
dfranklin@sheppardmullin.com
dyannuzzi@sheppardmullin.com
mcatanese@sheppardmullin.com

Counsel for Petitioner
PELOTON INTERACTIVE, INC.

ATTACHMENT 1

SIMILARITIES AND DIFFERENCES BETWEEN THE PETITIONS

IPR Section	IPR2023-01240	IPR2023-01241
I. Introduction	same	same
II. Mandatory Notices	same	same
III. Payment of Fee	same	Same
IV. Requirements for IPR	Same except for claims 1-9, 14-18, 20, 22, 32, and 34-36 discussed	Same except for claims 10-13, 21, 19, 21 and 33 discussed
V. Summary of U.S. Patent No. 9,769,427	same	same
VI. Claim Construction	same	same
VII. Relied-Upon Art	same	same
VIII. Discretionary Analysis for Review	same	same
IX. Detailed Explanation	Substantively similar except for claims 1-9, 14-18, 20, 22, 32, and 34-36 discussed	Substantively similar except for claims 10-13, 19, 21, and 33 discussed
IX. No Objective Individua of Non-Obviousness	same	same
X. Conclusion	same	same

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6 and 42.105, I hereby certify that on July 27, 2023, the foregoing Statement Regarding Multiple Petitions was served in its entirety by overnight Federal Express on the following correspondence address of record for Patent Owner:

71799 - NEC-IPC
2000 Pennsylvania Ave., NW, Suite 9000
Washington, DC 20006

A courtesy copy was provided to Patent Owner's litigation counsel:

Kenneth L. Dorsney, Esq.
Cortlan S. Hitch, Esq.
MORRIS JAMES LLP
500 Delaware Avenue, Suite 1500
Wilmington, Delaware 19801-1494

Robert L. Maier, Esq.
Jennifer C. Tempesta, Esq.
Nick Palmieri, Esq.
Michael E. Knierim, Esq.
BAKER BOTTS L.L.P.
30 Rockefeller Plaza
New York, New York 10112

Date: July 27, 2023

/Darren M. Franklin/
Darren M. Franklin (Reg. No. 51,701)

Counsel for Petitioner
PELOTON INTERACTIVE, INC.

Sheppard, Mullin, Richter & Hampton
333 South Hope Street, 43rd Floor
Los Angeles, California 90071-1422
Telephone: 213.620.1780
Facsimile: 213.620.1398
dfranklin@sheppardmullin.com