

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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RESMED INC.,  
Petitioner,

v.

NEW YORK UNIVERSITY,  
Patent Owner.

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IPR2022-00989  
Patent 9,427,539 B2

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Before BART A. GERSTENBLITH, JAMES A. TARTAL, and  
ARTHUR M. PESLAK, *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge*.

ORDER  
Granting Petitioner's Motion to Correct Petition  
*37 C.F.R. § 42.104(c)*

ResMed Inc. (“Petitioner”), with our prior authorization (Paper 6), filed a motion (Paper 7, “Motion” or “Mot.”) pursuant to 37 C.F.R. § 42.104(c) to correct what it argues were clerical mistakes in the Petition (Paper 1) by seeking “to file a corrected petition that (1) removes a single sentence and its errant citation to Exhibit 1022 on page 7 of the Petition, and (2) corrects the exhibit list on page x of the Petition to include a description of Exhibit 1033.” Mot. 1 (citing Ex. 1039 (proposed corrected petition showing the proposed corrections in redline)). In support of the Motion, Petitioner filed the Declaration of Lisa K. Nguyen, counsel for Petitioner, (Ex. 1040), and the Declaration of John M. Eastly, a paralegal with counsel for Petitioner, (Ex. 1041). New York University (“Patent Owner”) filed an opposition to the Motion arguing that the error Petitioner seeks to correct by removing a sentence and citation was not clerical. Paper 8 (“Opposition” or “Opp.”).

Our rules provide that “[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.” 37 C.F.R. § 42.104(c). For the reasons that follow, we find Petitioner has persuasively shown that the mistakes in the Petition it seeks to correct constitute clerical mistakes, and, accordingly, grant the Motion.

*1. Removal of Sentence and Citation to Exhibit 1022*

Petitioner moves to file a corrected petition in which one sentence in the Background section of the Petition and the accompanying citation to Exhibit 1022, an exhibit not filed or served with the Petition, are removed. Mot. 2; *see also* Ex. 1039, 18. In support, Petitioner’s counsel testifies with regard to the Petition filed in this proceeding, as well as petitions filed in a number of related proceedings, that “before the filing, [she] was concerned

that the current drafts of the petitions were over the word count. To address this concern, [she] finalized a common Background Section on ‘Sleep and Breathing Patterns’ for the petitioner that streamlined that section. As part of [her] edits, [she] deleted the . . . sentence [Petitioner seeks to remove].” Ex. 1040 ¶ 7. Counsel further testifies that in finalizing the Petition she “inadvertently copied [an] old version of the Background Section instead, which still included the sentence and citation to Exhibit 1022 that [she] had deleted in the streamlined version.” *Id.* ¶ 9. As a result, the Petition filed in this proceeding includes a sentence and citation that Petitioner intended to, but did not delete from the Petition prior to filing.

Petitioner argues that the inadvertent inclusion of “a single sentence with a citation to Exhibit 1022 in the Background Section of the Petition . . . was a clerical error as the exhibit had been deleted and was not intended to be cited.” Mot. 4 (citing Ex. 1040 ¶¶ 7–10). Petitioner submits “[a]s further evidence of this clerical error, Petitioner’s expert did not reference Exhibit 1022 . . . and the Petition exhibit list [filed with the Petition] identifies Exhibit 1022 as ‘Reserved.’” *Id.* at 4–5 (citing Pet. ix; Ex. 1003).

Petitioner argues Patent Owner will not be prejudiced by the proposed correction, which “does not introduce any new argument or evidence into the Petition.” *Id.* at 6. Petitioner further argues that the correction it seeks will not impact the substance of Petitioner’s arguments. *Id.* at 7. According to Petitioner “given that Exhibit 1022 was merely cited once *in the Background Section* and was not used to support any analysis of the grounds in the Petition, [Patent Owner] cannot establish that the requested correction would have substantively changed its [Patent Owner Preliminary Response] on the merits. *Id.* at 7–8.

Lastly, Petitioner argues the correction is not precluded by 35 U.S.C. § 315(b). *Id.* at 8. Petitioner states that it “seeks to remove the citation to Exhibit 1022, not to file the exhibit” and, according to Petitioner, “the corrected Petition was complete upon the original filing date— Petitioner identified and served all evidence relied upon to support the challenge on May 31, 2022.” *Id.* (citing 37 C.F.R. §§ 42.104, 42.106).

In the Opposition, Patent Owner responds that the “Motion should be denied because the . . . Petition is incomplete without Exhibit 1022 and thus time-barred under 35 U.S.C. § 315(b).” *Opp.* 1. Patent Owner points to our rules and contends “each cited exhibit must be filed along with its petition in order to be deemed complete.” *Id.* at 4 (citing 37 C.F.R. § 42.104(b)(5)). According to Patent Owner, “[b]ecause [Petitioner] failed to file the required exhibit – either by the Time Bar Date or until today – it is barred from pursuing an IPR under § 315(b), and the original May 31, 2022 filing date must be vacated.” *Id.*

Patent Owner asserts that Petitioner’s error in this case is not a clerical error. *Id.* at 5. Patent Owner’s contention is based primarily on the fact that Petitioner’s lead counsel participated in the events surrounding the filing of the Petition. *Id.* According to Patent Owner, “[t]he error by lead counsel cannot be considered merely clerical: she was required to exercise judgment, as she, with her paralegals, participated in drafting and also oversaw the process” and “had the authority and discretion to control the contents and underlying exhibits of the . . . Petition, including Exhibit 1022, but did not attach the exhibit to the Petition despite the fact that counsel clearly relied upon it.” *Id.* at 5–6. Patent Owner bases this contention on the Board’s decision in *Zhongshan Broad Ocean Motor Co. v. Nidec Motor Corp.*, IPR2014-01122, Paper 20 (PTAB Jan. 21, 2015). *Id.* at 5–8.

Relying on *Zhongshan*, Patent Owner would have us create a broad rule that a clerical error essentially can never occur if petitioner’s counsel is involved in drafting and overseeing the process of filing a petition. *Id.* The holding in *Zhongshan*, however, is not so broad.<sup>1</sup> Moreover, the circumstances presented in *Zhongshan* bear no similarity to the circumstances presented in this proceeding.

The issue in *Zhongshan* was that the petitioner filed an English-language translation of a foreign-language prior art reference that it asserted anticipated the challenged claims without an affidavit attesting to the accuracy of the translation. *Zhongshan*, Paper 20 at 11. The Board explained that our rules require that attesting affidavits “must be filed with” the translated documents. *Id.* (citing 37 C.F.R. § 42.63(b)). The petitioner’s counsel in *Zhongshan* assumed an attesting affidavit was obtained and included with the translation of the exhibit *and* failed to notice that the attesting affidavit was, in fact, not only missing from the exhibit, but had not been obtained prior to filing the petition. *Id.* at 11–12. In that case, the Board found the mistake was not a clerical error because it “resulted from a failure to obtain the affidavit at all—until attention was later drawn to the error” by the patent owner. *Id.* at 13.

In this case, Petitioner’s counsel testifies she intended to delete the sentence from the Petition but “copied [an] old version of the Background section instead, which still included the sentence and citation to Exhibit 1022 that [she] had deleted in the streamlined version.” Ex. 1040 ¶¶ 8–9. The fact that Exhibit 1022 was not filed with the Petition, that

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<sup>1</sup> In any event, we are not bound by the holding in *Zhongshan* because it has not been designated as precedential.

Exhibit 1022 is listed as “Reserved” on Petitioner’s exhibit list, and that Petitioner’s expert did not reference Exhibit 1022 in his declaration (Ex. 1003) support Petitioner’s position that the failure to delete the sentence and citation to Exhibit 1022 from the Petition amounts to a clerical error.

We find based on the evidence provided by Petitioner that the sentence and citation at issue appeared in the Petition as a result of a clerical error. Our rules expressly permit Petitioner to seek to correct such clerical errors without a change to the filing date of the petition. *See* 37 C.F.R. § 42.104(c). Patent Owner’s argument that it will be prejudiced if Petitioner’s Motion is granted because it has been placed “in the position of completing its Preliminary Responses in a shorter period of time, without the benefit of having all required documents, including the missing exhibits,” is neither credible nor supported. *Opp.* 9–10.<sup>2</sup> Removal of the sentence and citation at issue has no effect on the substantive arguments for unpatentability set forth in the Petition, has no impact on the amount of time Patent Owner has to prepare a preliminary response, and does not result in any “missing exhibits.” *Cf. Kaijet Tech. Int’l, Ltd., Inc. v. Sanho Corp.*, IPR2021-00886, Paper 14 at 4 (PTAB Sept. 27, 2021) (granting motion to correct petition that involved “delet[ing] words and some figures with annotated words . . . without adding or changing any substance”). Because we find that the substantive arguments for unpatentability are unchanged, we

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<sup>2</sup> Petitioner notes that two days after the Petition was filed it served a copy of Exhibit 1022 on Patent Owner in two related *inter partes* review proceedings. *Mot.* 7. Although we do not rely on this fact as support for this Decision, Patent Owner’s assertion that it suffered prejudice as a result of “missing exhibits” in Patent Owner’s possession shortly after the filing of the Petition is not persuasive.

find Patent Owner will not suffer any undue prejudice by granting the Motion.

2. *Addition of Description of Exhibit 1033 to the Exhibit List*

Petitioner seeks to correct the description of Exhibit 1033 in the exhibit list of the Petition from “Reserved” to provide a proper description of the exhibit. Mot. 10; *see also* Ex. 1039, x (showing in redline the proposed corrected description of Exhibit 1033). Petitioner states that Exhibit 1033 was filed and served with the Petition and that the description of Exhibit 1033 in the exhibit list as “Reserved” was “does not impact the substance of the Petition nor cause prejudice to [Patent Owner].” *Id.* According to Petitioner, making the proposed correction to the Petition “simply clarifies the record.” *Id.*; *see also* Ex. 1041 (testimony from a paralegal with Petitioner’s counsel explaining that Exhibit 1033 was filed and served, but “inadvertently omitted from the exhibit list” for the Petition).

In its Opposition, Patent Owner does not address Petitioner’s request to correct the description of Exhibit 1033 in the exhibit list as proposed by Petitioner. *See generally* Opp. We find that the description of Exhibit 1033 in the exhibit list of the Petition as “Reserved” was a clerical mistake, that correcting the mistake to reflect a proper description of Exhibit 1033 has no effect on the substantive arguments for unpatentability set forth in the Petition, and that Patent Owner will not suffer any undue prejudice by granting the Motion.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s Motion to Correct Petition is *granted*;

and

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FURTHER ORDERED that Petitioner shall file a corrected petition, as reflected in Exhibit 1039 as maintaining the pagination of the original petition, as a paper no later than September 6, 2022.

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