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PTAB HIGHLIGHTS

New developments in post-issuance proceedings

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IPR Petition Barred Under 35 U.S.C. § 315(b)

By J. Pieter van Es

September 17, 2014 – The PTAB denied a petition for *inter partes* review as barred under 35 U.S.C. § 315(b) because the PTAB determined that the petitioner was served with a complaint alleging infringement of the patent more than a year before it filed its petition.

[IPR2014-00779 – Histologics, LLC v. CDX Diagnostics, Inc. et al. \(Paper 6, Sept 12\)](#)

The petitioner requested institution of an *inter partes* review of U.S. Patent No. 6,258,044. According to the PTAB, the petitioner did not dispute that it was served with a complaint alleging infringement of the '044 patent soon after a complaint was filed on April 19, 2012. In the district court case, the petitioner moved to dismiss the complaint for lack of standing. Although the district court granted the motion to dismiss and ordered the action dismissed without prejudice, the action was stayed pending a bankruptcy proceeding, according to the PTAB. After bankruptcy, stay, transfer and consolidation issues were addressed, the case was pending in the Central District of California.

The petitioner argued its IPR petition was timely because it was not filed more than a year after being served with a “non-jurisdictionally deficient” complaint. Because suit was dismissed without prejudice, service of that complaint was nullified and did not trigger the time bar, according to the petitioner. The PTAB disagreed, finding that in view of the pending suit, the parties are not left in the same legal position as if the original action had never been filed, distinguishing *Macauto USA v. Bos GmbH*, Case IPR2012-00004 (PTAB 2013). The PTAB also distinguished *InVue Sec. Prods. Inc. v. Merch. Techs., Inc.*, Case IPR2013-00122 (PTAB 2013), because that case dealt with the dismissal of a declaratory judgment action for invalidity under 35 U.S.C. § 315(a), not the effect of dismissal of an infringement action under § 315(b).

The Leahy-Smith America Invents Act established new patent post-issuance proceedings, including the inter partes review, post grant review and transitional program for covered business method patents, that offer a less costly,

streamlined alternative to district court litigation. With the U.S. Patent and Trademark Office's Patent Trial and Appeal Board conducting a large and increasing number of these proceedings, and with the law developing rapidly, Banner & Witcoff will offer weekly summaries of the board's significant decisions and subsequent appeals at the U.S. Court of Appeals for the Federal Circuit.



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