

All Complaints Once Served—Even Defective Complaints that are Dismissed—Trigger the IPR Time Bar

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On Friday, the PTAB's Precedential Opinion Panel, colloquially referred to as "the POP," ruled that the one-year window to file *inter partes review* ("IPR") petitions begins once a complaint alleging infringement is served—even if the complaint is defective. Specifically, in *GoPro, Inc. v. 360Heros, Inc.*, IPR2018-01754, Paper 38, the POP ruled that GoPro, Inc. was time-barred from challenging a 360Heros, Inc. camera mount patent, due to a counterclaim for infringement filed by 360Heros that was dismissed for lack of standing, more than one year before GoPro petitioned for IPR.

In April 2016, GoPro sued 360Heros for trademark and copyright infringement in the Northern District of California. In August 2016, 360Heros counterclaimed for patent infringement—even though the inventor had not formally assigned the patent to the company. GoPro was granted summary judgment due to 360Heros lack of standing.

After 360Heros corrected the assignment in September 2017, 360Heros sued GoPro in the District of Delaware for patent infringement. Less than a year later, GoPro filed an IPR challenging the patent, and the PTAB instituted review. The PTAB ruled that GoPro's petition was timely because 360Heros did not own the patent when the initial complaint was filed back in August 2016, thus service of that defective counterclaim did not trigger Section 315(b).

The POP disagreed, and deviated from a line of PTAB cases that reached the opposite conclusion. According to the POP, the time bar clock starts the date the complaint is served, even if the complaint is defective. The POP relied on the recent Federal Circuit decision in [*Click-to-Call Techs., LP v. Ingenio, Inc.*, 899 F.3d 1321 \(Fed. Cir. 2018\) \(en banc in part\)](#), finding that the time bar is triggered as soon as a complaint is served—even if the underlying suit is voluntarily dismissed without prejudice. To the POP, this approach will promote efficiency at the PTAB.

The POP's recent holding goes contrary to the usual circumstance of coin flip decisions being decided against patent owners. While the circumstances at issue in *GoPro v. 360Heros* are somewhat unique, the ruling does show that the PTAB may balance out the competing interests between patent owners and infringers in PTAB jurisprudence. If GoPro appeals this decision to the Federal Circuit, we may discover whether POP decisions are entitled to deference, and if so how

much.

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