



Timing is Everything: Patent Trial and Appeal Board Clarifying When the One Year Clock For Requesting Inter Partes Review Begins to Run

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At issue was U.S. Patent No. 8,381,712 relating to a barbeque grill. On August 21, 2013, the patent owner, A&J sued Brinkmann for patent infringement of the 712 patent in the Southern District of Georgia. A&J sent Brinkmann a copy of the complaint and a request for waiver of service on October 7, 2013. Brinkmann executed the waiver of service on October 14, 2013, and A&J filed the executed waiver of service with the district court on October 21, 2013. Meanwhile, on the same day that A&J filed the district court complaint, it also filed a complaint with the U.S. International Trade Commission naming 21 respondents, including Brinkmann. A&J served its ITC complaint on Brinkmann on September 23, 2013. Thereafter, Brinkmann filed its petition for inter partes review of the 712 patent on October 13, 2014.

A&J alleged that Brinkmann did not have standing to request the *inter partes* review because its request was time barred. Under 35 U.S.C. § 315(b), an *inter partes* review may not be instituted if it is filed more than one year after the petitioner “is served with a complaint alleging infringement of the patent.” A&J relied on the date it served the district court complaint on Brinkmann, October 7, 2013, to allege that Brinkmann’s inter partes review request of October 13, 2014 was more than a year after service of the district court complaint, and hence untimely. The board disagreed, resting its decision on Fed. R. Civ. P. 4(d)(4). That rule states that “[w]hen the plaintiff files a waiver, proof of service is not required and these rules apply as if a summons and complaint had been served at the time of filing the waiver.” Fed. R. Civ. P. 4(d)(4). Applying this rule, the board determined that the date on which A&J filed Brinkmann’s waiver of service with the district court, October 21, 2013, sets the clock for requesting inter partes review, and thus Brinkmann’s petition was timely.

A&J also argued that the date it served Brinkmann with the ITC complaint (September 23, 2013) should control whether Brinkmann's petition was timely. The Board also rejected this argument, finding that the language "served with a complaint alleging patent infringement" in 35 U.S.C. § 315(b) means "a complaint in a civil action for patent infringement, not in an arbitral or administrative proceeding."

The Brinkmann Corp. v. A&J Manufacturing, LLC, IPR201500056, Paper No. 10 (PTAB Mar. 23, 2015).

Categories

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