



## PTAB: Federal Circuit's Click-to-Call Holding Applies to Statutory Bar Under 35 U.S.C. § 315(a)

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On August 24, 2017, Mylan filed an IPR against Pozen and Horizon Pharma USA, Inc. (the "Patent Owners"). In their preliminary response, Patent Owners contended that the petition was barred pursuant to § 315(a) because the petition was filed after Mylan asserted a counterclaim for declaratory judgment of invalidity of U.S. Patent No. 9,200,698 (the "'698 Patent") in a civil action where the '698 Patent **had not been asserted**. Initially, the Board had found that Mylan was not barred because the counterclaim of invalidity directed to the '698 Patent was voluntarily dismissed without prejudice. Shortly after institution, the Board instituted DRL's petition and granted its motion to join the Mylan IPR proceeding with the understanding that DRL's petition was time-barred pursuant to § 315(b)'s absent joinder. During the pendency of the proceeding, however, the Federal Circuit issued its decision in *Click-to-Call Technologies, LP v. Ingenio, Inc.*, 899 F.3d 1321, 1329 (2018), which held that the statutory time bar of § 315(b) applies even if the litigation triggering the bar was voluntarily dismissed without prejudice. Thus, the Board authorized the parties to file briefs addressing the effect of *Click-to-Call*'s holding on the instant proceeding.

The Board concluded that although the *Click-to-Call* decision directly addressed § 315(b), the Federal Circuit's reasoning applied equally to § 315(a). The Board noted that § 315 governs the relationship between IPRs and other actions; § 315(a) concerns actions by the petitioner triggering the bar and § 315(b) concerns actions by the patent owner triggering the time bar. According to the Board, similar to the Federal Circuit's analysis of the language of § 315(b) in *Click-to-Call*, the language in § 315(a) is plain and unambiguous and contains no exceptions or exemptions for filing civil actions that are later dismissed. The Board, therefore, concluded

that the difference in actors (i.e., petitioner for § 315(a) versus patent owner for § 315(b)) does not justify imposing radically different outcomes for voluntary dismissal of civil actions. The Board reasoned that the petitioner’s filing of a civil action triggers the bar pursuant to § 315(a)(1) regardless of whether the action is later dismissed.

Next, the Board determined that Mylan’s invalidity counterclaim constituted the filing of a civil action challenging the validity of the ’698 Patent thereby triggering the time bar pursuant to § 315(a)(1). Although § 315(a)(3) provides that a counterclaim challenging the validity of a claim of a patent does not constitute a civil action challenging validity of the patent, the Board relied on the legislative history to conclude that this language did not include a counterclaim asserting invalidity of a patent that **was not asserted** in the complaint. Because it was undisputed that the complaint in the civil action did not assert that Mylan infringed the ’698 Patent—and that Mylan introduced the ’698 Patent into the litigation by challenging its validity through a counterclaim—the Board found that Mylan’s counterclaim did not qualify as a “counterclaim” under § 315(a)(3). Instead, the Board determined that it constituted a “civil action challenging the validity of a claim of the patent” pursuant to § 315(a)(1).

Finally, the Board concluded that the appropriate remedy was to vacate its institution decision and terminate the proceeding. The Board found that the regulations expressly grant the Board broad authority to dismiss a petition where appropriate and to terminate a trial without rendering a final written decision. *See* 37 C.F.R. §§ 42.71(a), 42.72, 42.5(a). In addition, the Board vacated its decisions instituting DRL’s petition and granting DRL’s joinder motion. The Board concluded that it lacked authority to join DRL to Mylan’s barred petition, and absent joinder, DRL’s petition was time-barred. Thus, the proceeding was terminated.

**Practice Tip:** An accused infringer in a district court action that is considering filing a counterclaim seeking declaratory judgment of invalidity against an **unasserted** patent must also recognize the potential IPR bar triggered under 35 U.S.C. 315(a).

*Mylan Pharms. Inc. v. Horizon Pharma USA, Inc.*, IPR2017-01995, Paper 71 (PTAB 2019)

## Categories

Federal Circuit

Patent Trial & Appeal Board

35 U.S.C. § 315(b)

Inter Partes Review

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