



PTAB: Reexamination Does Not Reset the One-Year Deadline For Filing a Petition for Inter Partes Review

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On October 2, 2014, Patent Owner filed a lawsuit in district court accusing Petitioner of infringing several claims of U.S. Patent No. 7,039,033 (the “’033 Patent”). In response, Petitioner filed an IPR (the “original IPR”) challenging the validity of the claims that Patent Owner had asserted against it in district court. The Board instituted the original IPR and ultimately held that all of the challenged claims were unpatentable. The Federal Circuit upheld the Board’s determination and thereafter the Board issued a certification cancelling all claims of the ’033 Patent challenged in the original IPR. Notably, while the Federal Circuit appeal was pending, Patent Owner sought *ex parte* reexamination of the ’033 Patent. The Patent Office granted the reexamination request and issued a reexamination certificate adding 68 new claims to the ’033 Patent. On November 18, 2018, within one year of the reexamination certificate being granted, Petitioner filed six IPRs (the “present IPRs”) challenging the validity of the new claims that were added to the ’033 Patent during reexamination.

The Board, however, declined institution of these IPRs because it found they were filed more than one year after the Petitioner was served with the district court complaint on October 2, 2014. These petitions were, therefore, time-barred under § 315(b). In reaching its decision, the Board rejected Petitioner’s argument that § 315(b)’s one-year time bar did not apply because Patent Owner’s *ex parte* reexamination certificate adding new claims created a new, materially different patent. The Board found that the Federal Circuit in *Click-to-Call Technologies, LP v. Ingenio Inc.* considered and rejected Petitioner’s argument, explaining that “reexamination does not result in the issuance of a new patent for purposes of § 315(b), regardless of claim scope.” Interestingly, the Board acknowledged that while its decision potentially forecloses

the use of IPR for challenging reexamined claims, “Congress could have included in . . . [§] 315(b) language regarding the effect of reexamination on the deadline to file an IPR[,]” but chose not to do so.

The Board also denied Petitioner’s attempt to circumvent the § 315(b) time bar by joining the present IPRs to the original IPR. The Board first noted that the present IPRs were filed more than 34 months after the original IPR was instituted. Accordingly, Petitioner’s motion requesting joinder was filed several years after the one-month (post-institution) deadline set by the joinder rule and was therefore untimely. The Board further noted that even if the rules provide for joinder within one month of the issuance of a reexamination certificate, which they do not expressly do, Petitioner’s request was still several months late. Notwithstanding the joinder deadline, the Board also found that the original IPR was no longer pending before the Board and, therefore, it “cannot serve as a base proceeding to which [the present IPRs] may be joined.” Thus, the Board held that joinder was inappropriate for the independent reason that there was nothing for the present IPRs to join.

Practice Tip: Based on the Board’s current practice, a patent owner whose claims are found to be unpatentable in an IPR proceeding should consider—during the pendency of the proceeding, including an appeal of the Board’s determination—whether it could get new claims through *ex parte* reexamination. Any new claims that issue through reexamination may be immune from an IPR if the patent owner previously asserted the patent against the petitioner. Such consideration should also take into account any potential ramifications of intervening rights.

Apple Inc., v. IXI IP, LLC, IPR2019-00124, -00125, -00139, -00140, -00141, -00181 (PTAB June 3, 2019) (Tierney)

Categories

Patent Trial & Appeal Board

35 U.S.C. § 315(b)

Inter Partes Review

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