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Patent Trial and Appeal Board

**Informative**

Standard Operating Procedure 2

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AMNEAL PHARMACEUTICALS, LLC,  
Petitioner,

v.

ENDO PHARMACEUTICALS INC.,  
Patent Owner.

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Case IPR2014-00360  
Patent 8,329,216 B2

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Before TONI R. SCHEINER, FRANCISCO C. PRATS, and  
JACQUELINE WRIGHT BONILLA, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

DECISION  
Service Under 35 U.S.C. § 315(b)

## INTRODUCTION

Petitioner Amneal Pharmaceuticals, LLC, filed a Petition (Paper 1) requesting *inter partes* review of U.S. Patent No. 8,329,216 (“the ’216 patent”) on January 16, 2014. Patent Owner Endo Pharmaceuticals Inc. filed a Preliminary Response (Paper 7) (“Prelim. Resp.”) asserting, *inter alia*, that the Petition is time-barred under 35 U.S.C. § 315(b), which provides that an *inter partes* review may not be instituted based on a petition “filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.” Prelim. Resp. 6-11.

Following a conference call on May 7, 2014, among respective counsel for Petitioner and Patent Owner, we ordered the parties to submit additional briefing addressing the issue “of whether Petitioner was ‘served with a complaint’ alleging infringement of the ’216 patent more than one year before the petition was filed—i.e., more than one year before January 16, 2014,” under 35 U.S.C. § 315(b). Paper 9, 2-3. Thereafter, Petitioner filed a Reply Brief addressing the issue (Paper 11, “Reply”), and Patent Owner filed a Surreply (Paper 14, “Surreply”).

Based on the record before us, for the reasons that follow, we do not deny the Petition under § 315(b).<sup>1</sup>

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<sup>1</sup> This Decision only addresses Patent Owner’s contentions in relation to § 315(b), but does not address any other issues affecting whether we will institute an *inter partes* review in this case. We will address separately whether to institute an *inter partes* review in a forthcoming decision.

## I. BACKGROUND

We consider arguments raised in Patent Owner's Preliminary Response challenging whether Petitioner timely filed its Petition for *inter partes* review of the '216 patent. Prelim. Resp. 1, 6-11. Patent Owner initially filed a complaint against Petitioner on November 7, 2012, and then filed an amended complaint ("First Amended Complaint") on November 14, 2012, in the United States District Court for the Southern District of New York, alleging infringement of patents other than the '216 patent. Prelim. Resp. 4-5; Ex. 2008, 14-15.

On December 11, 2012, the '216 patent issued to Patent Owner. Prelim. Resp. 5. On January 9, 2013, Patent Owner filed an "Unopposed Motion to Amend Complaint Under Rule 15(a)" ("Motion to Amend Complaint" or "Motion"). Ex. 2004; Ex. 2008, 17 (referring to "MOTION to Amend/Correct the Amended Complaint"). The Motion to Amend Complaint attached, as Exhibit 1, a copy of a Second Amended Complaint for the court's consideration, adding the newly issued '216 patent to Patent Owner's allegations of infringement in the First Amended Complaint. Ex. 2004, Exhibit 1.

Thereafter, on January 14, 2013, the court granted Patent Owner's Motion. *Id.* at 5-6; Ex. 2006. The Order granting the Motion stated that "Plaintiff shall file the Second Amended Complaint promptly," and that "[a]ny response to the Amended Complaint is due on February 14, 2013." Ex. 2006. On January 17, 2013, Patent Owner filed its Second Amended Complaint. Ex. 2007.

## II. DISCUSSION

### A. 35 U.S.C. § 315(b)

The issue before us is whether Petitioner was “served with a complaint” alleging infringement of the ’216 patent prior to January 16, 2013, which would bar the Petition under 35 U.S.C. § 315(b). Specifically, we address whether service on January 9, 2013, of Patent Owner’s Motion to Amend Complaint, attaching a proposed “Second Amended Complaint” as an exhibit, or the district court Order granting that Motion on January 14, 2013, constituted service of a “complaint,” thereby triggering the one-year time bar under § 315(b).

The relevant portion of § 315(b) provides:

(b) PATENT OWNER’S ACTION.—An *inter partes* review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is *served with a complaint alleging infringement of the patent*.

35 U.S.C. § 315(b) (emphasis added).

Patent Owner urges us to deny the instant Petition, arguing that Petitioner is time-barred from seeking *inter partes* review of the ’216 patent under § 315(b), because Petitioner was *served with a complaint* on January 9, 2013, i.e., more than one year before the January 16, 2014, filing date of the Petition in this proceeding. Prelim. Resp. 6-11.

As shown in Exhibit 2005, the district court provided a Notice of Electronic Filing (“NEF”), via electronic mail, on January 9, 2013, in relation to the “MOTION to Amend/Correct *the Amended Complaint*.”

*Document* filed by Endo Pharmaceuticals Inc., Grunenthal GMBH,” and “Attachments,” including “# (1) Exhibit 1 Proposed Second Amended Complaint, . . . .” Prelim. Resp. 5; Ex. 2005, 1.

Patent Owner points us to district court Local Rule 9.1 on electronic filing, which provides that the “[t]ransmission of the NEF constitutes service upon all Filing and Receiving Users who are listed as recipients of notice by electronic mail.” Prelim. Resp. 8 (citing Ex. 2009 (Southern District of New York “Electronic Case Filing Rules and Instructions”), 9, § 9.1). Thus, according to Patent Owner, when the district court electronically mailed the NEF regarding the Motion to Amend Complaint and Exhibit 1 attachment to Petitioner, it “effected service of the Second Amended Complaint on January 9, 2014.” Prelim. Resp. 8-9. Because § 315(b) refers to being “served,” Patent Owner contends that it does not matter that Patent Owner did not *file* the Second Amended Complaint until January 17, 2013. *Id.* at 10. Rather, it only matters when Patent Owner *served* the Second Amended Complaint, which, according to Patent Owner, occurred on January 9, 2013. *Id.* at 10-11.

In response, Petitioner does not dispute that on January 9, 2013, Patent Owner served its Motion to Amend Complaint and a “Proposed” Second Amended Complaint, attached as an exhibit. Reply 1. Petitioner counters, however, that the filing and service of that Motion and exhibit “cannot and did not trigger § 315(b).” *Id.* at 4. According to Petitioner, Patent Owner did not “have the legal right to file or serve the Second Amended Complaint (‘SAC’) until the District Court granted it leave to do

so on January 14, 2013.” *Id.* at 1, 3. Petitioner cites Federal Rule of Civil Procedure 15(a)(2), which permits a party to file an amended pleading “once as a matter of course,” but requires that “in all other cases, a party may amend its pleading only with the opposing party’s written consent or court’s leave.” Fed. R. Civ. P. 15(a)(2). Under this rule, according to Petitioner, Patent Owner required the district court’s leave to file the SAC. Reply 3. Thus, Patent Owner filed and served the SAC on January 17, 2013, after the court granted that leave. *Id.* at 4. Petitioner contends the one-year period under § 315(b) did not begin until January 17, 2013, when Patent Owner actually filed and served its SAC. *Id.* at 2.

In its Surreply, Patent Owner refers to cases from other district courts that have based “service-dependent deadlines on the date the court granted the motion to amend” a complaint, where that motion attached a “proposed” amended complaint. Surreply 2-3. Thus, according to Patent Owner, it properly served its SAC when it served a copy of the proposed amended complaint on Petitioner on January 9, 2013. Patent Owner further contends that, as of January 14, 2013, when the district court granted the Motion to Amend Complaint, “the Second Amended Complaint had legal effect because the court ordered Petitioner to respond to it by February 14, 2013, . . . despite Petitioner’s request to be given one month from the date of *filing* of the Second Amended Complaint to answer.” *Id.* at 3-4 (emphasis in original) (citing Ex. 2010, Fed. R. Civ. P. 15(a)(3)). In addition, Patent Owner argues that “Petitioner’s contention that service of the Second Amended Complaint was not authorized until it was actually filed is wrong

because Petitioner expressly consented to its filing.” *Id.* at 4-5 (citing Fed. R. Civ. P. 15(a)(2)).

We have considered the arguments and evidence provided by Petitioner and Patent Owner in view of the requirements of § 315(b), local court rules, and the Federal Rules of Civil Procedure. For example, we note that the district court’s docket sheet and NEF confirm the filing of the Motion to Amend Complaint, including its “Exhibit 1 Proposed Second Amended Complaint,” on January 9, 2013. Ex. 2008, 17; Ex. 2005. The docket sheet and other evidence also confirm that Magistrate Judge Gabriel Gorenstein granted the Motion on January 14, 2013, in an Order stating that Patent Owner “shall file the Second Amended Complaint promptly” and that Petitioner’s response “is due on February 14, 2013.” Ex. 2008, 17; Ex. 2006. The docket sheet further confirms that Patent Owner filed the Second Amended Complaint three days later, on January 17, 2013. Ex. 2008, 17-18. At that time, service of the Second Amended Complaint was accomplished via the court’s electronic filing system.<sup>2</sup>

In view of the record before us, we conclude that on January 9, 2013, Patent Owner served Petitioner with a Motion to Amend Complaint seeking permission to file its Second Amended Complaint, but did not serve a “complaint” for purposes of § 315(b). On that date, Patent Owner requested that the court grant “leave to file a Second Amended Complaint for patent

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<sup>2</sup> The local court rules provide that transmission of an NEF, which the court sends automatically by e-mail, satisfies the “service” requirement. Ex. 2009, 9, §9.1; 5, §1.

infringement (*attached hereto as Exhibit 1*).” Ex. 2006 (emphasis added). In other words, on January 9, Patent Owner requested, but had not obtained yet, permission to file a Second Amended Complaint. At the point of filing the Motion to Amend Complaint, the attachment to the Motion was merely a proposed complaint, and Petitioner was not yet a defendant in a lawsuit with respect to the ’216 patent.

“We do not believe that the Congress intended to have the [one-year] time period start before a petitioner is officially a defendant in a law suit.” *Motorola Mobility LLC v. Arnouse*, IPR2013-00010, Paper 20, 5 (Jan. 30, 2013). Moreover, as stated by the Supreme Court as “a bedrock principle,” an “entity named as a defendant is not obliged to engage in litigation unless notified of the action, and brought under a court’s authority, by formal process.” *Murphy Bros. v. Michetti Pipe Stringing*, 526 U.S. 344, 347 (1999). Here, Petitioner was not “brought under a court’s authority, by formal process,” i.e., was not officially a defendant, in relation to the ’216 patent, by virtue of the filing of the Motion to Amend Complaint on January 9, 2013. *Id.* Patent Owner’s request for the court’s leave did not obligate Petitioner to engage in litigation in relation to that patent.

In relation to Federal Rule of Civil Procedure 15(a)(2), which states in relevant part that “a party may amend its pleading only with the opposing party’s written consent or the court’s leave,” we note that it is undisputed that Patent Owner requested the court’s leave in this case.<sup>3</sup> Thus, regardless

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<sup>3</sup> We also note that Fed. R. Civ. P. 15(a)(3) states that “[u]nless the court



of any prior “consent” by Petitioner, on January 9, 2013, Patent Owner requested leave to amend its pleading and make Petitioner a defendant with respect to the ’216 patent, which left the matter in the court’s hands to decide. The attachment to the Motion was merely a proposed complaint, not an actual “complaint” within the meaning of § 315(b).

Moreover, Petitioner was not “served with a complaint” for the purposes of § 315(b) when the district court granted Patent Owner’s Motion to Amend Complaint on January 14, 2013. While the Order stated that Patent Owner “shall file the Second Amended Complaint promptly,” the Order did not indicate that the Second Amended Complaint was filed or served on Petitioner as of January 14, 2013, or retroactively on January 9, 2013. Ex. 2006. Rather, the court specified the timing of the filing of the Second Amended Complaint, i.e., that it must be filed “promptly.” *Id.* Patent Owner then filed its complaint three days later, on January 17, 2014. Patent Owner could have filed its Second Amended Complaint earlier, for example, on January 15, 2013, but chose to file when it did. Petitioner was “brought under a court’s authority, by formal process,” and became “obliged to engage in litigation” in relation to the ’216 patent, on January 17, 2013, when Patent Owner actually filed its Second Amended Complaint, and not

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orders otherwise, any required response to an amended pleading must be made within the time remaining to respond to the original pleading or within 14 days after service of the amended pleading, whichever is later.” Here, the court clearly “orders otherwise.” The court did not require a response “within 14 days after service” of either the Motion to Amend Complaint or the Second Amended Complaint, for example. Ex. 2006.

beforehand. *Murphy Bros.*, 526 U.S. at 347.

In view of the record before us, we conclude that Petitioner was not “served with a complaint” alleging infringement of the ’216 patent for the purposes of § 315(b) before January 17, 2013. Because Petitioner filed its Petition within one year of that date, i.e., on January 16, 2014, we conclude that 35 U.S.C. § 315(b) does not bar institution based on the Petition in this case.

### III. CONCLUSION

For the foregoing reasons, we determine that 35 U.S.C. § 315(b) does not bar institution based on the Petition in this case.

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