

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMNEAL PHARMACEUTICALS, LLC,
Petitioner,

v.

ENDO PHARMACEUTICALS INC.,
Patent Owner.

Case IPR2014-00361
Patent 8,309,122 B2

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

BONILLA, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Petitioner Amneal Pharmaceuticals, LLC filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of U.S. Patent No. 8,309,122 B2 (“the ’122 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.” 35 U.S.C. § 315; *see* Prelim. Resp. 7-11.

Following a conference call on May 7, 2014, among respective counsel for Petitioner and Patent Owner, we ordered the parties to submit additional briefing to “address Patent Owner’s contention that it served Petitioner with a relevant complaint on November 20, 2012, when Patent Owner served Petitioner an amended complaint (Ex. 2002; Ex. 2003).” Paper 9, 2-3. Thereafter, Petitioner filed a Reply Brief addressing the issue (Paper 11, “Reply”), and Patent Owner filed a Surreply (Paper 13, “Surreply”).

Based on the record before us, for the reasons that follow, we deny the Petition under § 315(b).

II. BACKGROUND

We consider arguments raised in Patent Owner’s Preliminary Response challenging whether Petitioner timely filed its Petition for *inter partes* review of the ’122 patent. Prelim. Resp. 1, 7-11. Patent Owner

initially filed a complaint against Petitioner in the United States District Court for the Southern District of New York (C.A. No. 12-CIV-8115) on November 7, 2012, alleging infringement of two patents other than the '122 patent. Prelim. Resp. 5; Ex. 2001, 9-10. Thereafter, on November 13, 2012, the '122 patent issued to Patent Owner. Prelim. Resp. 5.

On November 14, 2012, Patent Owner filed a first amended complaint (“Amended Complaint”), adding the newly issued '122 patent, as well as another patent, to Patent Owner’s allegations of infringement in the original complaint. *Id.*; Ex. 2002, 9-12. Patent Owner contends it served Petitioner with the Amended Complaint alleging infringement of the '122 patent on November 20, 2012. Prelim. Resp. 5; Ex. 2003. Thereafter, on January 17, 2013, Patent Owner filed a Second Amended Complaint, adding yet another newly issued patent (U.S. Patent No. 8,329,216) to Patent Owner’s allegations of infringement in the Amended Complaint. Prelim. Resp. 6; Ex. 2007, 10-12.

III. DISCUSSION

The issue before us is whether Petitioner was “served with a complaint” alleging infringement of the '122 patent prior to January 16, 2013, which would bar institution of *inter partes* review under 35 U.S.C. § 315(b). Specifically, we address whether service on November 20, 2012, of Patent Owner’s Amended Complaint constituted service of a “complaint,” thereby triggering the one-year time bar under § 315(b), taking into account that Patent Owner filed a Second Amended Complaint, again alleging infringement of the '122 patent, on January 17, 2013.

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 ’122 patent under § 315(b), because Petitioner was served with a complaint on November 20, 2012, i.e., more than one year before the January 16, 2014, filing date of the Petition in this proceeding. Prelim. Resp. 5-11. Patent Owner contends that service of the Second Amended Complaint “has no effect on the one-year statutory window for seeking *inter partes* review of the ’122 patent.” *Id.* at 10. Patent Owner contends that the “Second Amended Complaint merely reiterated those infringement claims [in the Amended Complaint] and did not substantively change them in any way.” *Id.* Thus, according to Patent Owner, its filing of the Second Amended Complaint did not restart the clock in relation to the one-year bar under § 315(b). *Id.* at 11.

Petitioner, on the other hand, contends that the one-year time period under § 315(b) “began on January 17, 2013, the date that Patent Owner (“PO”) filed and served the Second Amended Complaint (“SAC”).” Reply 1. In support, Petitioner points to an agreement between the parties in January 2013 regarding the Second Amended Complaint. *Id.* at 1-2.

Specifically, Petitioner contends that the parties agreed that Petitioner would not oppose Patent Owner's motion to amend the Amended Complaint ("Motion to Amend Complaint") if Petitioner did not need to respond to the Amended Complaint and had thirty days to answer the Second Amended Complaint. *Id.* at 2 (citing Ex. 1026 (e-mail correspondence between counsel dated January 7, 2013)). According to Petitioner, "[t]hus, the parties agreed that no further action would be taken with respect to the Amended Complaint pending the Court's decision on PO's request to file the SAC." *Id.* Petitioner also contends that on January 14, 2013, the district court granted the Motion to Amend Complaint, and on January 17, 2013, Patent Owner filed and served the Second Amended Complaint. *Id.*

Petitioner further argues that the "parties' agreement to take no action with respect to the Amended Complaint in favor of the SAC demonstrates that the Amended Complaint should have no effect." *Id.* at 3. Thus, according to Petitioner, service of the Amended Complaint had no effect in relation to the § 315(b) bar. In support, Petitioner cites to federal case law, such as *Washer v. Bullitt County*, 110 U.S. 558, 562 (1884) ("When a petition is amended by leave of the court, the cause proceeds on the amended petition."), and *Synder v. Pascack Valley Hosp.*, 303 F.3d 271, 276 (3rd Cir. 2002) ("An amended complaint supercedes the original version in providing the blueprint for the future course of a lawsuit."). In addition, Petitioner cites to *Macauto U.S.A. v. BOS GmbH & KG* ("*Macauto*"), IPR2012-00004, contending that "the Board has held that a complaint dismissed without prejudice under Fed. R. Civ. P. 41(a) does not trigger the

§ 315(b) statutory bar because ‘the dismissal of the earlier action . . . nullifies the effect of the alleged service of the complaint on Petitioner.’” Reply 4 (citing *Macauto*, Paper 18, 15-16).

The cases cited by Petitioner, however, do not support the proposition that the filing of an amended complaint renders the original complaint a nullity, i.e. having no legal effect for the purposes of § 315(b). This case is unlike *Macauto*, for example, where our colleagues held that that a voluntary dismissal without prejudice nullified service of the complaint for purposes of § 315(b). The panel in *Macauto* notes that courts have interpreted the effect of voluntary dismissals without prejudice under Fed. R. Civ. P. 41(a) as leaving the parties as though the action had never been brought. *Macauto*, Paper 18, 14-15; *see also Apple Inc. v. Rensselaer Polytechnic Inst.* (“*Apple*”), Case IPR2014-00319, slip op. at 4 (PTAB June 12, 2014) (Paper 12).

By contrast, “[a]n amended complaint is just that—a complaint that has been amended. The original complaint has been amended, and has not gone away in the same sense as a complaint dismissed without prejudice.” *Loral Space & Commc’ns, Inc. v. ViaSat, Inc.* (“*Loral*”), Case IPR2014-00236, slip op. at 7 (PTAB Apr. 21, 2014) (Paper 7); *see also Apple*, Paper 12, 6. As noted by Patent Owner, consistent with the conclusion that service of the Amended Complaint had a “legal effect” here, Federal Rule of Civil Procedure 15(c)(1)(B) states that an amended complaint “relates back to the date of the original pleading” when the amended complaint “asserts a claim . . . in the original pleading.” Surreply 4; Fed. R. Civ. Proc. 15(c)(1)(B).

Moreover, an agreement between the parties that Petitioner need not respond to the Amended Complaint and had thirty days to answer the Second Amended Complaint simply reflects an understanding of a reasonable time frame for Petitioner to respond to a yet-again-revised complaint. The Second Amended Complaint indicated the most updated version of all infringement counts necessitating a response by Petitioner, adding an additional infringement count regarding another patent, without removing the count regarding the '122 patent added in the first Amended Complaint.

In view of the record before us, we conclude that Petitioner was “served with a complaint” alleging infringement of the '122 patent for the purposes of § 315(b) before January 16, 2013. Petitioner does not dispute that Patent Owner served its Amended Complaint, asserting infringement of the '122 patent, on Petitioner on November 20, 2012. Because Petitioner did not file its Petition within one year of that date, we conclude that 35 U.S.C. § 315(b) bars institution of *inter partes* review in this case.

IV. CONCLUSION

For the foregoing reasons, we determine that 35 U.S.C. § 315(b) bars institution of *inter partes* review based on the filing date of the Petition.

V. ORDER

It is

ORDERED that the Petition is denied and no trial is instituted.

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