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PTAB Finds Service of Complaint for Infringement Without Exhibits Does Not Trigger 35 U.S.C. § 315(b) Time Bar

In *Lightricks Ltd. v. Plotagraph, Inc.*, the Patent Trial and Appeal Board (PTAB or “Board”) recently clarified the standard for what triggers the 35 U.S.C. § 315(b) time bar for filing a petition for *inter partes* review. Section 315(b) requires that petitions for *inter partes* review be filed with the Board within “[one] year after the date on which the petitioner ... is served with a complaint alleging infringement of the patent.” 35 U.S.C. § 315(b).

In *Lightricks v. Plotagraph*, the Patent Owner (“PO”) argued that the petition at issue was filed outside of the one-year anniversary of the service of its complaint for infringement in the related federal district court action and was therefore time barred. The PO had attempted to serve its complaint at two of the petitioner’s office locations more than one year before the petition was filed. However, the exhibits to the complaint were not included in either of those two service attempts. The petitioner argued that the date of service for purposes of § 315(b) was the date that it filed a waiver of service with the district court, and that because the waiver of service was filed less than one year before the petition was filed, the petition was not time barred under § 315(b).

The Board agreed with the petitioner and reasoned that “defective service of a district court complaint does not trigger the time bar under § 315(b).” *Id.* at *10. The Board noted that pursuant to Fed. R. Civ. P. 10(c) “an exhibit to a pleading is a part of the pleading for all purposes.” *Id.* And, citing prior decisions, the Board disagreed with the PO’s argument that mere notice of a lawsuit is not sufficient to trigger the § 315(b) time bar. *Id.* at *11 (citing *GoPro, Inc. v. 360Heros, Inc.*, IPR2018-01754, Paper 38 at 15 (PTAB Aug. 23, 2019) (“a complaint improperly served does not trigger the § 315(b) time bar”)); *id.* (citing *IpDatatel, LLC v. ICN Acquisition, LLC*, IPR2018-01823, Paper 17 at 13–18 (PTAB Apr. 17, 2017) (§ 315(b) requires

compliance with Rule 4 of the Federal Rules of Civil Procedure, and that mere “notice” is not legally effective “service”)).

Thus, the PTAB concluded that the “[p]etitioner was not ‘served with a complaint alleging infringement of the patent’ for purposes of 35 U.S.C. § 315(b) until [the waiver of service was filed with the district court].” *Id.* at *12. And, the PTAB added, the petition was therefore not time barred.

This issue can arise in Hatch–Waxman litigations when a new patent gets issued and added to the Orange Book for a brand product. In those instances, the plaintiff can either seek to amend the original complaint to add the new patent or simply file a second complaint. In those latter instances, it is totally feasible for a defendant to answer the complaint before the plaintiff completes service of the second complaint. However, plaintiffs should be diligent in completing service of the second complaint – either through actual service of a summons and complaint, acknowledgement of service, or some other memorialization that service was complete. Otherwise, until service is complete, the clock does not start for purposes of § 315(b).

Gibbons will continue to monitor and report developments in patent litigation and proceedings before the PTAB.

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