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The One-Year Bar Applies Even After a Voluntary Dismissal without Prejudice

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Today, the Federal Circuit issued an en banc decision in *Click-to-Call Technologies, LP v. Ingenio, Inc, Yellow Pages.com, LLC* (Case No. 2015-1242), finding that a voluntary dismissal without prejudice of a lawsuit does not reset the clock for determining whether the Petition was "filed more than 1 year after the date on which the petitioner … [was] served with a complaint alleging infringement of the patent," pursuant to section 315(b).

In view of this decision, a defendant cannot file a petition for IPR challenging a patent if that defendant was served with a complaint alleging infringement of the challenged patent more than one year prior to filing the petition, even if the earlier complaint was dismissed without prejudice. The Federal Circuit noted, "[t]he statute does not contain any exceptions or exemptions for complaints served in civil actions that are subsequently dismissed, with or without prejudice." Slip at 13. The court stated that the fact that a complaint is later voluntarily dismissed without prejudice is "wholly irrelevant to the § 315(b) inquiry." *Id*. "Simply put, § 315(b)'s time bar is implicated once a party receives notice through official delivery of a complaint in a civil action, irrespective of subsequent events." *Id*.

Defendants who have been sued in the past year and then had the suit voluntarily dismissed, should evaluate whether to move forward with an IPR before the one year date passes. Similarly, patent owners that have dismissed a complaint without prejudice should consider whether to re-file that complaint after one year has passed.

In the long-term, the outcome of this decision may be to encourage plaintiffs to seek voluntary dismissal before defendants invest resources in filing an IPR, and then re-file the complaint one year later.

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