

Mergers and the 35 U.S.C. § 315(b) Patent IPR Institution Time Bar

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The below article was published in *Westlaw Today*.

[Andrew Lowes](#) of Haynes Boone and Savannah Olmstead, 2023 summer associate at the firm, discuss considerations when navigating how prospective mergers affect existing and potential inter partes review proceedings.

Under 35 U.S.C. § 315(b), "[a]n inter partes review may not be instituted if the petition 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."

Interpretation of this provision has presented many interesting dilemmas for parties, the Patent Trial and Appeal Board (PTAB), and the U.S. Court of Appeals for the Federal Circuit alike in recent years. For companies operating in the spheres of mergers and acquisitions, intellectual property litigation, and IPRs simultaneously, there are several considerations to keep in mind when navigating how prospective mergers affect existing and potential proceedings.

Mergers do not extinguish the merging entity as a real party in interest or privy

Even when petitioners enter into and finalize mergers, they are not immune from the effects of the time bar. The IPR petitioner in *Commscope, Inc. v. TQ Delta, LLC* unsuccessfully attempted to dodge the time bar by arguing that the merging party originally served with a patent infringement complaint was "not a real party in interest" because it merged into another real party in interest and "no longer exist[ed]." *Commscope, Inc. v. TQ Delta, LLC*, IPR2022-00352, 2022 Pat. App. LEXIS 4313, Paper 13 at *7-8 (PTAB Aug. 19, 2022).

The Board declined this argument because the merging party was maintained as a defendant in a related case, and also clarified that the one-year statutory period for filing a petition triggered by service of a patent infringement complaint against a real party in interest does not "restart[]" if the petitioner "subsequently is served with a later complaint alleging" patent infringement. *Id.* at *13.

[Read the full article in *Westlaw Today* here.](#)