



## IP Law News

# GoPro Patent Review Bid Reversed by Precedent-Setting Panel (1)

By Ian Lopez

Posted Aug. 23, 2019, 2:46 PM

- Decision issued by Precedential Opinion Panel
- Comes in dispute between GoPro and 360Heros

GoPro Inc. missed the window to challenge the validity of the patent it's accused of infringing, a Patent and Trademark Office panel said, reversing a decision to review the patent's claims.

The office's Precedential Opinion Panel issued the decision Aug. 23 in a dispute between GoPro and 360Heros, Inc. The panel, known as POP, overturned a Patent Trial and Appeal Board decision to review the validity of claims in 360Heros' U.S. Patent No. 9,152,019. The patent covers a "360 degree camera mount and related photographic and video system."

The POP precedential decision clarifies that petitioners have just one year from a pleading asserting infringement to challenge claims in a patent, even if a party "lacks standing to sue or the pleading is otherwise deficient."

Precedential decisions serve as guideposts for practitioners in PTAB proceedings.

GoPro asked the board to review the patent's claims in light of prior art. 360Heros argued that the challenge was "untimely" because it served GoPro with an infringement counterclaim in a litigation more than a year before GoPro went to the board. The PTAB instituted the review, saying the action didn't start the clock.

360Heros asked POP for a rehearing on the decision. GoPro's petition for review of the patent came less than a year after 360Heros was served with a patent infringement complaint in the U.S. District Court for the District of Delaware. But GoPro sought review more than a year after 360Heros filed a counterclaim alleging infringement of the '019 patent in the U.S. District Court for the Northern District of California.

GoPro, in the California lawsuit, claimed 360Heros didn't own the '019 patent when it filed the counterclaim and "thus lacked standing to sue," according to the POP decision. The California court granted GoPro's motion for summary judgment in the suit for lack of standing.

The PTAB, in instituting the review, found that the filing of the counterclaim in the California case didn't trigger the time bar.

**'Exact Language'**

POP, however, said that because GoPro filed its petition "more than one year after Petitioner was served with a pleading alleging infringement in the California case, the Petition is time-barred under §315(b)." That section of patent law prohibits inter partes reviews "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."

"The exact language of 'served with a complaint alleging infringement' seems to be the operative phrase," Ravi Mohan, intellectual property partner at Rutan & Tucker LLP, said.

GoPro argued as much, noting that the phrase "served with a complaint alleging infringement" in §315(b) is ambiguous as to whether a complaint needs to be "a proper federal pleading." 360Heros, however, said that the dismissal of a court case for lack of standing is "irrelevant" to applying the time bar.

The POP said that the language in §315(b) is "plain and unambiguous." It concluded that "service of a pleading asserting a claim alleging infringement triggers the one-year time period for a petitioner to file a petition under 35 U.S.C. §315(b), even where the serving party lacks standing to sue or where the pleading is otherwise deficient."

"This struck me as a decision that's grounded in practicality," Mohan said.

The Patent and Trademark Office created the POP in 2018 to deal with issues of exceptional importance in board disputes. It's composed of PTO Director Andrei Iancu and other agency leadership. The Aug. 23 decision is the panel's second since its creation.

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(March 14, 2019, 10:44 AM  
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