

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FUJIFILM CORPORATION, FUJIFILM MEDICAL SYSTEMS USA, and
FUJIFILM TECHNO PRODUCTS CO., LTD.,
Petitioner,

v.

HOLOGIC, INC.,
Patent Owner.

Case IPR2018-00651
Patent 7,831,296 B2

Before MEREDITH C. PETRAVICK, BRIAN J. McNAMARA, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. BACKGROUND

Petitioner filed a Request for Rehearing of our Decision (Paper 14, “Decision” or “Dec.”) denying institution of *inter partes* review of claims 23–25, 33, 35, 36, 39, 40, 42, and 44 of U.S. Patent No. 7,831,296 B2 (Ex. 1001, “the ’296 Patent”). Paper 15 (“Req. Reh’g.”).

Petitioner contends that we erred by adopting Patent Owner’s proposed claim construction and not its proposed construction of independent claim 23’s limitation “while a patient’s breast remains immobilized in the breast support at each of said different angular positions,” because we allegedly overlooked a relevant disclosure in the ’296 Patent and misapplied the law. Req. Reh’g 1. Further, Petitioner urges us to institute *inter partes* review in this proceeding to ensure a consistent outcome with *inter partes* review in related IPR2018-00672. *Id.*

For the reasons discussed below, Petitioner has not demonstrated that we abused our discretion in denying institution.

II. ANALYSIS

A. *Standard of Review*

When rehearing a decision on petition, the Board will review the decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c). An abuse of discretion may be determined if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *See Arnold Partnership v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004). A request for rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed.” 37 C.F.R. § 42.71(d).

“The burden of showing a decision should be modified lies with the party challenging the decision.” *Id.*

B. Analysis

Claim Construction

As our Decision points out,

Claim 23 recites, “a control configured to selectively energize the source to emit x-rays through the breast support to the imager, while a patient’s breast remains immobilized in the breast support at each of said different angular positions.” Ex. 1003, 11:16–19. Claim 23 requires that the angular positions include a mammogram position that is the same or similar to a position for a conventional mammogram and positions that are tomosynthesis positions that are different from conventional mammogram positions (*id.* at 11:20–24) and that the x-ray dose in the tomosynthesis positions are less than that applied in the mammogram positions (*id.* at 11:25–35).

Dec. 7. Claim 23, thus, requires selectively energizing the source while the patient’s breast remains immobilized at different angular positions, including a conventional mammogram imaging position and tomosynthesis imaging position. *See id.*

In the Petition, Petitioner proposed that “while a patient’s breast remains immobilized in the breast support at each of said different angular positions” be construed so that “the claimed system is **not** required to be configured to capture both a mammogram image and tomosynthesis images during a single compression of the patient’s breast.” Pet. 18. In contrast, Patent Owner argued that the limitation precludes decompression of the breast in between imaging positions and requires keeping the breast compressed during an entire exam spanning multiple imaging positions,

because the claim recites that the breast remains immobilized in the breast support at each of said different angular positions. Paper 9, 9–13.

In our Decision, we declined to adopt Petitioner’s proposed construction because it was unreasonably broad in light of the plain language of claim 23 and ’296 Patent’s disclosure. Dec. 9–10. With regards to the ’296 Patent’s disclosure, we stated:

[Patent Owner’s position] is consistent with the specification of the ’296 patent, which indicates that the breast remains compressed during an entire exam spanning multiple imaging positions. *See, e.g.*, Ex. 1003, Abstract (“Multiple x-ray images are taken as the x-ray source and the receptor move relative to the immobilized breast”), 5:58 (describing taking images at multiple positions “[f]or a given position of breast 102”). In particular, the ’296 patent states:

Unlike conventional x-ray mammography, in which typically a breast is imaged from only from one angle at a given compression, here the immobilized breast is imaged with x-rays from the source that pass through the breast and impinge on the receptor, from a greater number of different positions of the source and receptor relative to the breast while maintaining the breast immobilized, to derive image data for the respective positions. To do this, the x-ray source moves around the immobilized breast . . .

Ex. 1003, 2:37–46. The ’296 patent does not describe decompressing the breast between imaging positions. *See generally* Ex. 1003.

Dec. 9. We construed the limitation, “while a patient’s breast remains immobilized in the breast support at each of said different angular positions,” to require the breast to remain compressed during an entire exam spanning multiple imaging positions. *Id.* at 10.

Petitioner contends that we erred in our construction because we overlooked that the '296 Patent, at column 6, lines 32–37, does disclose decompressing the breast between imaging positions. Req. Reh'g 2–4.

As an initial matter, we are not persuaded by Petitioner's contention that we misapprehended or overlooked its claim construction arguments concerning the disclosure of the '296 patent. Petitioner points to pages 18–19 of the Petition as where it previously addressed this matter. Req. Reh'g 3. Although pages 18–19 contain Petitioner's argument construing this limitation, those arguments make no mention of the disclosure at column 6, lines 32–37 of the '296 patent or any other disclosures of the '296 patent. Pet. 18–19. Indeed, Petitioner's argument does not address the '296 patent's disclosure at all. *Id.* We could not have misapprehended or overlooked an argument not made or evidence not cited in the Petition.

Nonetheless, we have reconsidered the construction of this limitation in light of the disclosure at column 6, lines 32–37 of the '296 Patent, but still determine that Petitioner's proposed construction is unreasonably broad. Petitioner's reliance on the disclosure at column 6, lines 32–37 is misplaced. When reviewed in a wider context, the '296 Patent's disclosure is consistent with our construction adopted in the Decision.

Starting at column 5, line 58, the '296 Patent describes a process or procedure “[f]or a given position of breast 102, such as a position that is the same or similar to the CC position for a conventional mammogram.” The process or procedure includes moving the x-ray source, relative to the immobilized breast, to different angular positions, including conventional mammogram imaging positions and tomosynthesis imaging positions. See Ex. 1003, 5:58–21. The '296 Patent then states:

Thus, two types of images can be produced in accordance with the currently preferred embodiment while breast 102 is immobilized in the same position. One type is the same or is at least similar to a conventional mammogram, which can be read and interpreted in the manner familiar to health professionals. The other type is tomosynthetic images reconstructed from the image data and displayed either separately or as an adjunct to the display of the image that is the same or similar to a conventional mammogram. The process described above for one position of breast 102 can be repeated for another position. For example one process can be for a breast position in a manner that is the same or similar to positioning the breast for a conventional CC view, the breast can then be released, the support 204 and C-arm 200 rotated to other angular positions and the breast repositioned in a manner that is the same and similar to the position for an MLO view, and the procedure repeated.

Ex. 1001, 6:21–37 (emphases added). Consistent with our statement in the Decision that “[t]he ’296 patent does not describe decompressing the breast between imaging positions” (Dec. 9), but describes decompressing the breast between processes or procedures, in other words between exams. *Id.* at 6:32–37. As can be seen from the discussion above, the ’296 Patent discloses moving the source to conventional mammogram imaging positions and tomosynthesis imaging positions while the breast remains immobilized during one process, procedure, or exam. *Id.* at 5:58–6:37.

We, thus, are not persuaded by Petitioner that we erred in our claim construction because we misapprehended or overlooked its arguments concerning the disclosure of the ’296 patent.

Petitioner also contends that we erred by misapplying the law by citing to *Telecordia Techs., Inc. v. Cisco Sys., Inc.*, 612 F.3d 1365, 1375 (Fed. Cir. 2010) for the proposition that prosecution history comments cannot trump the plain language of the claims and the direct teaching of the

specification. Req. Reh’g 4–5. According to Petitioner, *Telecordia* does not control here because the court was not applying the broadest reasonable interpretation standard. *Id.* at 5.

In *Telecordia*, the Federal Circuit stated: “These prosecution history comments cannot trump the plain language of the claims and the direct teaching of the specification. *See Biogen Inc. v. Berlex Labs., Inc.*, 318 F.3d 1132, 1140 (Fed. Cir. 2003) (‘Representations during prosecution cannot enlarge the content of the specification’).” *Telecordia*, 612 F.3d at 1375. Petitioner, however, provides no persuasive reasoning, explanation, or law to show that under the broadest reasonable interpretation standard, as opposed to the narrower district court standard, statements made during prosecution should trump the plain language of the claims and the direct teaching of the specification. For example, Petitioner cites to *Liebel-Flarsheim Co. v. Medrad, Inc.*, 481 F.3d 1371, 1380 (Fed. Cir. 2007), but like in *Telecordia*, the court was not applying the broadest reasonable interpretation standard. We, thus, are not persuaded by Petitioner that we misapplied the law.

For these reasons, we are not persuaded by Petitioner that we abused our discretion and that our decision should be modified.

Consistency with Related IPR2018-00672

A related patent is the subject of IPR2018-00672, and it includes claims that similarly require “a single compression” limitation. *See* IPR2018-00672, Paper 11, 13. That patent also includes some claims that omit “a single compression” limitation. *Id.* at 14. We instituted *inter partes* review in IPR2018-00672 because we determined that the information in

that petition showed a reasonable likelihood that Petitioner would prevail on at least one of the claims that omit “a single compression” limitation. *See id.* at 16. In accordance with the Supreme Court’s decision in *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018), we instituted an *inter partes* review of all challenged claims of the ’379 patent on all grounds alleged in the Petition. *Id.*

Petitioner urges us to institute *inter partes* review in this proceeding to ensure a consistent outcome with *inter partes* review in related IPR2018-00672. Req. Reh’g 6–8. Petitioner argues that we

may ultimately conclude that the prior art does render obvious obtaining a mammogram and tomosynthesis images in a ‘single compression,’ based on the full evidentiary record developed in IPR2018-00672. Should that happen, claims with effectively the same scope (as compared to the prior art) would be unpatentable and cancelled in the ’379 patent but would survive in the ’296 patent. This outcome would be undesirable. Patent Owner would have patent claims still existing that should be unpatentable, impeding fair and robust competition in the industry, while FUJIFILM or others would be forced to challenge those claims in some other proceeding, wasting resources. If the Board institutes review of the ’296 challenged claims, then the overlapping issues can be addressed consistently in both proceedings.

Id. at 8.

The Statute, however, provides that:

[t]he Director *may not* authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

35 U.S.C. § 314(a) (emphasis added). Here, we have determined that the information presented in the Petition fails to show a reasonable likelihood that Petitioner would prevail with respect to at least one of challenged claims 23–25, 33, 35, 36, 39, 40, 42, and 44. Pursuant to § 314(a), we may not institute an *inter partes* review in this proceeding.

III. CONCLUSION

We are not persuaded by Petitioner of an abuse of discretion. Petitioner's request for rehearing is denied.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Request for Rehearing is *denied*.

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PETITIONER:

T. Vann Pearce, Jr.
Christopher J. Higgins
ORRICK, HERRINGTON & SUTCLIFF LLP
vpearce@orrick.com
chiggins@orrick.com

PATENT OWNER:

Jennifer A. Sklenar
Jeffrey A. Miller
ARNOLD & PORTER KAYE SCHOLER LLP
Jennifer.Sklenar@arnoldporter.com
jmillerptab@apiks.com