

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

1	PROGENICS PHARMACEUTICALS, INC.,	)	
2	et al,	)	
3		)	
4	Plaintiffs	)	
5		)	CA No. 24-10437-PBS
6	-VS-	)	Pages 1 - 13
7	MIM SOFTWARE INC.,	)	
8		)	
9	Defendant	)	

MOTION HEARING BY VIDEO

BEFORE THE HONORABLE PATTI B. SARIS
UNITED STATES DISTRICT JUDGE

United States District Court
1 Courthouse Way
Boston, Massachusetts 02210
May 12, 2025, 10:59 a.m.

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OFFICIAL COURT REPORTER
United States District Court
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1 A P P E A R A N C E S:

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3 Choate, Hall & Stewart, Two International place,
4 100-150 Oliver Street, Boston, Massachusetts, 02110,
5 for the Plaintiffs.

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7 60 State Street, Boston, Massachusetts, 02109, for the
8 Defendant.

9 MARIA R. BUTLER, ESQ., Thompson Hine LLP,
10 Two Alliance Center, 3560 Lenox Road LE, Suite 1600, Atlanta,
11 Georgia, 30326, for the Defendant.

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P R O C E E D I N G

THE CLERK: Good morning, Judge.

THE COURT: Good morning.

THE CLERK: The Court calls Civil Action 24-10437, Progenics Pharmaceuticals v. MIM Software. Could counsel please identify themselves.

MS. PIROZOLLO: I can start. Lisa Pirozollo from Wilmer Hale for the MIM defendant, and with me are cocounsel from Thompson Hine, Marla Butler, Jeff Metzcar, and Jesse Godshalk. Ms. Butler will be arguing this morning.

THE COURT: Thank you.

MR. CALHOUN: Good morning, your Honor. My name is John Calhoun from Choate, Hall & Stewart. I'm joined today by my colleague Anita Spieth, and we represent the plaintiffs opposing the motion to stay.

THE COURT: All right, thank you. So I've read everything at this point, as I'm sure you expect, and the opening question I have is, why wouldn't it make sense for me to stay the portion that's in front of the PTAB -- I think there are four patents -- and keep the two patents that are not pending before the PTAB? I don't have the bandwidth to do six patents and -- what did you say? -- 46 claims. I don't have it. I mean, you may all in your big firms, but I don't. And so I thought that that was a way for me to just take a tiny bite with this, learn the case, let the rest of it go to the

1 PTAB, and basically get things moving on -- I guess it would be
2 two tracks.

3 MR. CALHOUN: I take that as perhaps a question that I
4 should address for the plaintiffs --

5 THE COURT: Yes, yes.

6 MR. CALHOUN: -- and you'll hear from Ms. Butler
7 first.

8 We very much understand the concern. We think that
9 the salient issue here right now is when this motion has been
10 brought, which is that it's been brought before the PTAB has
11 decided whether to even institute any of the IPRs. I think
12 that this would be a very different issue once we had the
13 institution record; but for the time being, any potential
14 simplification is entirely speculative, especially as we
15 explain in our papers, and I won't belabor it.

16 THE COURT: Yes, but what are you going to do about
17 me? I can't do six patents. I mean, you guys have like -- I'm
18 assuming there's a lot of money involved in this to have six
19 patents. I don't have that bandwidth to do those kinds of
20 claims. And this is sort of overkill in terms of the Court's
21 docket. I've never seen a case bring six patents and so many
22 claims and expect me to rule on them.

23 MR. CALHOUN: May I respond, your Honor? I'm sorry.
24 I wasn't sure if you were done.

25 THE COURT: Yes.

1 MR. CALHOUN: Over the next six months, which would be
2 the period of time during which the PTAB would make its
3 decisions, we would receive briefing on claim construction from
4 the parties, but a lot of other important work could be done in
5 trying to --

6 THE COURT: I can't do that many claims, I can't. I
7 mean, I have two law clerks. It doesn't make sense for me,
8 just the court resources. And then I can dig in on two
9 patents. Why doesn't that make sense?

10 MR. CALHOUN: We certainly agree that we should
11 proceed on at least the two patents, your Honor. I'm trying to
12 convince you that the burden on the Court over the next six
13 months, at least for the institution decision timeline, would
14 be, we would hope -- I certainly don't want to tell you what
15 the burden would be for you -- but not as severe as though this
16 were for summary judgment and trial because we would be talking
17 about a limited number of claims to construe, and otherwise the
18 parties would be engaging in fact discovery, which would set
19 this case up for further progression if, as we expect, the IPR
20 doesn't institute these patents.

21 MS. BUTLER: Your Honor, if I can answer your questions.

22 THE COURT: That would be great. Thank you.

23 MS. BUTLER: Yes, so the reason from MIM's perspective
24 that you should not allow the two patents to proceed while the
25 IPRs are before the PTAB is because there is, your Honor,

1 significant overlap in the claims across all six patents. All
2 of these patents relate to use of artificial intelligence in
3 medical imaging to diagnose and treat cancer. They all involve
4 claim terms like "hot spots, detection of radiopharmaceutical
5 uptake, creation of risk maps, risk indices." So across all
6 six patents, the issues relating to claim construction, and to
7 a large extent infringement, are going to overlap. So, your
8 Honor --

9 THE COURT: Well, how do I even know that? I mean,
10 why didn't you institute the IPR, if there's such an overlap,
11 on the last two?

12 MS. BUTLER: Because, your Honor, not only was the
13 Court overwhelmed by six patents, your Honor, we had to get as
14 many IPRs filed as we could within the deadline between this
15 Court's order on the motion to dismiss and the upcoming
16 deadlines, and we prioritized things, and these are the IPRs
17 that we filed during that time period.

18 THE COURT: Are you time barred from the other two?

19 MS. BUTLER: You've got a year, your Honor, yes, from
20 when service of the complaint was filed to get the IPRs on
21 file.

22 THE COURT: So you're time barred now?

23 MS. BUTLER: As to the other two, that's right. There
24 is no intention to file IPRs on the other two, absolutely. We
25 did file on these two. But, your Honor, not only will issues

1 of claim construction overlap, issues of infringement will
2 overlap as well. If you were to look at the specifications for
3 the six patents at issue, you will see that while not all of
4 them are technically related in the same families, there are
5 chunks of or portions of the specifications that carry across
6 all of these patents.

7 THE COURT: Yes, but I'm not going to sit and read six
8 specifications, and it wasn't sort of spelled out that way in
9 the briefing, and I -- I -- I don't know if -- I do not have
10 the bandwidth to handle -- what was it? -- 46 claims, six
11 patents. I don't have that. On the other hand, I do have the
12 bandwidth to handle two patents.

13 MS. BUTLER: Yes, it's 145 claims.

14 THE COURT: 145, well, that's ridiculous. I mean, I
15 just can't do it.

16 MS. BUTLER: So, your Honor --

17 THE COURT: And so I'm going to take them bite-size is
18 how I'm going to do this. And if in fact the IPRs are
19 instituted, which they may well be -- a huge percentage are
20 overturned on obviousness grounds -- you have Wilmer Hale
21 behind you. Wilmer Hale is the mecca of -- I don't know what
22 the right word would be -- one of the country's leading patent
23 firms. I don't totally buy it that you don't have the work
24 force to be able to have filed an IPR. And I do note for the
25 record that you are competitors. On the other hand, it seemed

1 like there was only one real patent product, maybe two, and
2 only five sales. I don't think the competition thing
3 overwhelms me in terms of -- I don't find that so persuasive.
4 What's persuasive for me is that I am eager to roll up my
5 sleeves. I've already done it on the '101. I am eager to
6 either settle this or get it going. So I am going to -- I do
7 hear you that there may be some overlap, and, frankly, if they
8 take all these, maybe I'll reconsider this decision. But right
9 now I'm going to take the -- right now I don't even know that.
10 It could be another five months before they even decide, right?
11 Isn't that what you told me, four or five months before they
12 decide? So coupling up my resource demands as well as the fact
13 that I don't think the argument about competition is
14 particularly strong, although I've considered it, I'm going to
15 take the two patents.

16 And where does that leave us? Do we need to have a
17 scheduling conference on them? Is that it? Or have we already
18 done all that with all the patents?

19 MS. BUTLER: We have a schedule in place. We don't
20 have a trial date set. Infringement contentions have been
21 served, and validity contentions are coming up.

22 THE COURT: Good, good.

23 MS. BUTLER: And if I could just make one point, your
24 Honor. And I hear you that you are going with the two patents
25 and letting those move forward. I will just say that whatever

1 the PTAB decides as to the four patents, that is going to be
2 very relevant to your claim construction as well, right?
3 Because what we risk with having the two patents move forward
4 in the District Court and the other four patents going forward
5 in the PTAB, is that we have inconsistent rulings on claim
6 construction, which could just pose a problem down the road
7 long term in this case, and I --

8 THE COURT: I completely agree with that, and indeed I
9 have been known to change claim constructions if I find
10 something persuasive, so nothing will stop me from changing it
11 because I do view them as more expert than I am. On the other
12 hand, by the time you brief claim construction and we have a
13 hearing, and then it takes me three to six months to write it
14 up, I may well have rulings from the PTAB one way or another.
15 And if they decline, well, then I'm going to have to do quick
16 catch-up with the others.

17 But I'm warning the plaintiffs, I'm just -- I'm beside
18 myself on how many patents you've brought and the number of
19 claims.

20 MR. CALHOUN: Understood, your Honor.

21 THE COURT: I'm not going to do it, okay? So the way
22 I've done it with other people who are a little too, I don't
23 know, "enormous" is the word that comes to mind, is we'll just
24 take a key patent and a key set of claims and take them to
25 trial, and I'll stay the rest. I'm just not going to do it. I

1 don't know what other judges are doing in the United States of
2 America. I don't know what that speedy docket does in Texas.
3 I don't see how you can possibly handle it.

4 MR. CALHOUN: We'll discuss that and take that
5 seriously, your Honor. Can I ask one clarification, the order
6 you're envisioning?

7 THE COURT: Yes.

8 MR. CALHOUN: Am I right that after the PTAB makes its
9 institution decisions, we could then return here to you and ask
10 for your guidance about what degree we would proceed with a
11 stay on the four. The reason why I ask is -- there's four
12 patents that have been challenged for IPR. The reason I ask
13 is, envision a scenario where three are not instituted but one
14 is instituted. Plaintiffs would obviously at that point want
15 to lift the stay as to the three un-instituted patents. I
16 imagine defendant might have a different view. And so I just
17 wanted to seek clarification from you about how -- that we
18 would have the ability then to brief that.

19 THE COURT: Of course you'd have the ability to brief
20 it.

21 MR. CALHOUN: Thank you, your Honor.

22 THE COURT: I've never known patent attorneys to be
23 shy. But let me return to the basic fact: I don't have the
24 staffing to handle the volume of claims and the number of
25 patents.

1 MR. CALHOUN: We hear you clearly, your Honor, I
2 promise.

3 THE COURT: And you need to -- you know, one thing
4 that the best patent lawyers do, and I'm sure you're all in
5 this room, is to give me the one or two or maybe even five
6 claim terms that will settle this case.

7 MR. CALHOUN: Understood. Thank you, your Honor.

8 THE COURT: You know what I mean? You are competitors,
9 so it's harder to settle. Have people thought about a
10 cross-licensing kind of situation?

11 MS. BUTLER: There's been no discussion along those
12 lines, your Honor.

13 THE COURT: I just don't know enough about it to even
14 be helpful, honestly. It just struck me that when you told me
15 it was competition but only four products had been sold so may
16 have lost out, it just seems like a tiny market.

17 MR. CALHOUN: We do think it's a little more
18 complicated than that, your Honor, but I take it that is not
19 about to sway your ruling here.

20 THE COURT: No. I mean, it just -- it just -- I don't
21 know how much money is at stake is what I'm getting at.

22 MR. CALHOUN: It's a substantial threat for plaintiff.
23 That staff was striking about five sales. However, as we
24 said --

25 THE COURT: Five sales, sorry, five sales.

1 MR. CALHOUN: -- in our surreply papers, our products
2 don't just compete with LesionID Pro. In fact, we also compete
3 with the LesionID product, which is, if it's integrated, they
4 are integrated in a different way. There's obviously no
5 discussion in the Piper Declaration from defendant about how
6 often LesionID is sold. We've found marketing materials
7 suggestion that LesionID, rather than LesionID Pro, functions
8 with AI. And so our experience is that GE/Siemens make a lot
9 of the actual medical imaging devices, and MIM had been one of
10 our biggest competitors for software. Well, now GE has
11 purchased MIM, ended its contract, GE ended its contract with
12 us; and, as Dr. Anand testified in his declaration, we're
13 seeing a pretty dangerous, from plaintiff's perspective, swing
14 in the competitive dynamics in the market. It is part of why
15 we're concerned so much about the prejudice of a stay.

16 MS. BUTLER: Your Honor, I just have to add that the
17 chief scientific officer of MIM has testified in his
18 declaration that LesionID does not use AI. In order for any
19 competition to be relevant here, it has to be competition using
20 products that practice the claims of the patent. We can only
21 compete with Progenics' AI products. LesionID does not use AI.
22 Only five products have been sold that, by Mr. Calhoun's own
23 client's declaration, allegedly competes with the Progenics
24 products here.

25 THE COURT: Well, I understand it. To date, the

1 evidence of competitive harms is underwhelming, but I
2 understand their concern going forward. That said, I'm only
3 going to deal with the two patents. If the IPRs are instituted
4 and they come up with a different claim construction, I may
5 defer to the PTAB because I do agree that inconsistent claim
6 construction is a bad idea. If they're denied, then we're
7 going to have to bring in the new patents; and I'm going to
8 force, shall we say, plaintiffs to just pick a few key things
9 so that I can do it in a way that's consistent with my
10 resources, and may move the ball forward, you know what I mean,
11 just can get us there, rather than 147 claim construction
12 issues, so --

13 MS. BUTLER: Understood, your Honor.

14 THE COURT: Okay, thank you very much, and I think you
15 have a game plan for the two where no IPR has even been
16 requested, and we'll go forward. Thank you. All right,
17 bye-bye.

18 (Adjourned, 10:15 a.m.)
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C E R T I F I C A T E

UNITED STATES DISTRICT COURT)
DISTRICT OF MASSACHUSETTS) ss.
CITY OF BOSTON)

I, Lee A. Marzilli, Official Federal Court Reporter,
do hereby certify that the foregoing transcript, Pages 1
through 13 inclusive, was recorded by me stenographically at
the time and place aforesaid in CA No. 24-10437-PBS, Progenics
Pharmaceutcals, Inc., et al v. MIM Software Inc., and
thereafter by me reduced to typewriting and is a true and
accurate record of the proceedings.

Dated this 23rd day of May, 2025.

/s/ Lee A. Marzilli

LEE A. MARZILLI, CRR
OFFICIAL COURT REPORTER