1 IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS
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3 PROGENICS PHARMACEUTICALS, INC.,)
et al,)
4)
Plaintiffs)
5) CA No. 24-10437-PBS
-VS-) Pages 1 - 13
6)
MIM SOFTWARE INC.,)
7)
Defendant)
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MOTION HEARING BY VIDEO
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BEFORE THE HONORABLE PATTI B. SARIS
11 UNITED STATES DISTRICT JUDGE

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United States District Court
16 1 Courthouse Way
Boston, Massachusetts 02210
17 May 12, 2025, 10:59 a.m.

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MIM Ex1036
MIM Software Inc. v. Progenics Pharmaceuticals, Inc.
Trial IPR2025-00725

A P P E A R A N C E S:

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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

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

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

THE COURT: Yes, yes.

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

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

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

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

THE COURT: Yes.

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

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

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

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

THE COURT: That would be great. Thank you.

MS. BUTLER: Yes, so the reason from MIM's perspective that you should not allow the two patents to proceed while the 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

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

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

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

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

MS. BUTLER: So, your Honor --

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

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

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

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

THE COURT: Good, good.

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

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

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

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

MR. CALHOUN: Understood, your Honor.

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

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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.

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

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

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

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

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

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

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

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

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

THE COURT: Five sales, sorry, five sales.

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

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

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

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

MS. BUTLER: Understood, your Honor.

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

(Adjourned, 10:15 a.m.)

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1 C E R T I F I C A T E

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

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7 I, Lee A. Marzilli, Official Federal Court Reporter,
8 do hereby certify that the foregoing transcript, Pages 1
9 through 13 inclusive, was recorded by me stenographically at
10 the time and place aforesaid in CA No. 24-10437-PBS, Progenics
11 Pharmaceutcals, Inc., et al v. MIM Software Inc., and
12 thereafter by me reduced to typewriting and is a true and
13 accurate record of the proceedings.
14 Dated this 23rd day of May, 2025.

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19 /s/ Lee A. Marzilli
_____
20 LEE A. MARZILLI, CRR
OFFICIAL COURT REPORTER

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