

UNITED STATES DISTRICT COURT  
DISTRICT OF MASSACHUSETTS

PROGENICS PHARMACEUTICALS, INC.,  
AND EXINI DIAGNOSTICS AB,

Plaintiffs,

v.

MIM SOFTWARE, INC.,

Defendant.

Case No.: 24-10437-PBS

Hon. Patti B. Saris

**DEFENDANT'S MEMORANDUM OF LAW IN SUPPORT OF ITS  
MOTION TO STAY PENDING INTER PARTES REVIEW**

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## INTRODUCTION

Defendant MIM Software, Inc. (“MIM”) requests that the Court stay this action pending the outcomes of parallel *Inter Partes* Review (“IPR”) proceedings before the Patent Trial and Appeals Board (“PTAB”) of the Patent and Trademark Office (“PTO”). Plaintiffs Progenics Pharmaceuticals, Inc. and Exini Diagnostics AB (collectively, “Plaintiffs”) accuse MIM of infringing six patents, collectively containing hundreds of claims. Four of the six patents are the subject of petitions that have been filed with the PTAB. Within a few months, the PTAB will determine whether there is a reasonable likelihood that any of the 112 challenged claims are invalid in light of the prior art.

A stay will conserve judicial resources and simplify the issues in this action without unduly prejudicing any party. First, this case is in its early stages. Minimal discovery has taken place, and the Court’s recent Scheduling Order sets key milestones—such as the *Markman* hearing and *Daubert* and dispositive motions—more than seven months away. There is no trial date.

Second, the IPRs may significantly simplify the case. MIM has challenged over 100 claims across four patents. These challenged claims and patents make up the thrust of Plaintiffs’ case and are considerably similar to the remaining two patents in this action. Therefore, regardless of the outcome of the IPRs, the Court will benefit from the PTAB’s assessment of the patented technology and analysis of issues, including claim construction and validity.

Finally, no undue prejudice or tactical disadvantage will befall Plaintiffs as a result of a stay. IPRs are required by statute to conclude within one year of the PTAB’s institution decision absent good cause. Furthermore, Plaintiffs’ claims are compensable with monetary damages, and any delay incurred because of the PTAB’s careful consideration of the claims can be satisfied by, e.g., prejudgment interest.

For all these reasons, the Court should stay this litigation pending resolution of the IPRs.

## **BACKGROUND**

### **I. THE PARTIES**

Plaintiff Progenics is a corporation that sells “targeted medicines” incorporating artificial intelligence and develops software for medical image analysis. Dkt. 25 ¶ 12. Plaintiff EXINI claims to be a Swedish corporation that develops medical image analysis software. Dkt. 25 ¶ 13; Dkt. 79 at 3. Defendant MIM develops and markets tools for several medical uses, including radiation oncology, radiology, nuclear medicine, neuroimaging, and cardiac imaging. Dkt. 79 at 23, ¶ 1. Plaintiffs accuse several of MIM’s products, including Contour ProtégéAI®, MIM SurePlan™ MRT, LesionID®, and LesionID® Pro (the “Accused Products”), of infringement. Dkt. 25 ¶ 52.

In 2020, Plaintiff EXINI and Defendant MIM began discussions, allegedly about a potential collaboration. Dkt. 25 ¶ 43; Dkt. 79 at 8, ¶ 43. These discussions continued into 2023, but no agreement was ever reached. Dkt. 25 ¶¶ 47, 50; Dkt. 79 at 8, ¶¶ 47, 50. Plaintiffs allege that in June 2023 they “discovered” published materials about the Accused Products. Dkt. 25 ¶ 52; Dkt. 79 at 9, ¶ 52. Plaintiffs filed suit in February of 2024, shortly after GE HealthCare announced that it intended to acquire MIM. Dkt. 25 ¶ 55; Dkt. 79 at 9, ¶ 9; *see generally* Dkt. 1.

### **II. DISTRICT COURT LITIGATION**

Plaintiffs filed this massive case on February 23, 2024 (Dkt. 1), accusing MIM of infringing seven patents: U.S. Patent Nos. 10,665,346 (the “’346 patent”) (Dkt. 25-1); 10,973,486 (the “’486 patent”) (Dkt. 25-2); 11,424,035 (the “’035 patent”) (Dkt. 25-3); 11,894,141 (the “’141 patent”) (Dkt. 25-4); 11,567,508 (the “’508 patent”) (Dkt. 25-5); 11,721,428 (the “’428 patent”) (Dkt. 25-6); and 11,941,817 (the “’817 patent”) (Dkt. 25-7) (collectively, the “Asserted Patents”). Dkt. 25 ¶¶ 120–68.

The Asserted Patents cover related technology.<sup>1</sup> Each claims systems and methods for automatically analyzing one or more medical images of a patient using machine learning. *E.g.*, '346 patent at 4:1–29, 35:46–36:7; '486 patent at 2:60–3:3, 3:52–56, 80:33–81:9; '428 patent at 2:50–52, 2:62–3:4, 48:62–49:27; '817 patent at 3:3–7, 4:66–5:4, 79:5–33. Nuclear medicine images and anatomical images are analyzed in tandem to identify the risk of cancer in specific tissue regions, e.g., organs or bones. '346 patent at 4:62–5:17; '486 patent at 3:17–4:3; '428 patent at 3:39–62; '817 patent at 3:49–64. Regions of high intensity in the nuclear medicine images, called hotspots, indicate the presence of cancerous lesions. '346 patent at 5:20–27; '486 patent at 5:3–20, 57:11–22; '428 patent at 3:5–18; '817 patent at 4:4–20.

MIM moved to dismiss all claims, arguing that four of the Asserted Patents claim ineligible subject matter under 35 U.S.C. § 101, and further that Plaintiffs “failed to plausibly allege that [MIM’s] products infringe the” remaining three patents. Dkt. 72 at 2. This Court granted the motion in part on January 14, 2025, dismissing the claims related to the '508 patent, as well as part of the Plaintiffs’ claim asserting the '486 patent, for Plaintiffs’ failure to plausibly allege infringement. Dkt. 72 at 29–33.

MIM filed its Answer and Counterclaims to the Second Amended Complaint on February 11, 2025, Dkt. 79, which Plaintiffs answered on March 4, 2025. Dkt. 82. The Court entered its Scheduling Order on March 5, 2025, setting the following deadlines (among others):

- Patent owner’s required disclosures: April 17, 2025
- Accused infringer’s required disclosures: May 29, 2025
- Joint statement regarding claim construction: June 18, 2025

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<sup>1</sup> Three of the Asserted Patents belong to the same patent family and share a common title and specification. Dkt. 72 at 4; *compare* '346 patent *with* '035 patent *and* '141 patent.

- *Markman* hearing: November 14, 2025
- Fact discovery cutoff: June 18, 2026
- Expert discovery cutoff: October 13, 2026
- *Daubert* and dispositive motions cutoff: October 23, 2026
- Trial: TBD

Dkt. 85 at 1–4. Discovery to date has been *de minimis*. Neither side has produced documents, noticed depositions, or responded to written discovery requests.

### III. PENDING *INTER PARTES* REVIEW PETITIONS

*Inter partes* review (“IPR”) “is an expedited procedure for challenging the validity of a patent before the [Patent and Trademark Office] and its Patent Trial and Appeal Board (“PTAB”).” *ACQIS, LLC v. EMC Corp.*, 109 F. Supp. 3d 352, 355 (D. Mass. 2015). A party may petition for IPR with the PTAB to cancel one or more of a patent’s claims on anticipation (35 U.S.C. § 102) or obviousness (35 U.S.C. § 103) grounds on the basis of prior art patents and printed publications. 35 U.S.C. § 311(b). The PTAB may institute an IPR upon showing “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).

IPR proceedings must conclude by Congressionally-mandated deadlines. A petition must be filed within one year after the date on which the petitioner is served with a complaint alleging infringement of the patent. 35 U.S.C. § 315(b). The patent owner may then file a preliminary response no later than three months after the date of a notice indicating that the request to institute IPR has been granted a filing date. 37 C.F.R. § 42.107(b); 35 U.S.C. § 313. The PTAB must then determine whether to institute IPR within three months of the patent owner’s preliminary response (or the last date on which such response may be filed, if no response is filed). 35 U.S.C. § 314(b).

If IPR is instituted and not dismissed, the PTAB must issue a final written decision (“FWD”) with respect to the challenged claims within one year, or within 18 months upon a showing of good cause. 35 U.S.C. § 318(a); 37 C.F.R. § 42.100(b).

The PTO releases trial statistics by fiscal year.<sup>2</sup> For FY2024, the PTO reported that the PTAB instituted review of 74% of patents petitioned. Of those claims instituted for review by the PTAB, only 14% were found patentable in a final written decision. The remainder were either found unpatentable by a final written decision (49%), were disclaimed by the patentee (4%), or resulted in no final written decision, typically because of a settlement (33%). *See* Ex. E at 7–11, 13.

In an effort to streamline this six-patent litigation, MIM filed four IPR petitions, each directed to one of the Asserted Patents. Each petition was filed prior to its statutory deadline. The petitions challenge most of the patents’ claims, as set forth in the table below:

| Asserted Patent | Patent Claims | Claims Challenged in IPR       | Filing Date of Petition |
|-----------------|---------------|--------------------------------|-------------------------|
| ’346 patent     | 1–13          | 1–13                           | February 21, 2025       |
| ’035 patent     | 1–45          | 1–38, 42–43                    | March 14, 2025          |
| ’141 patent     | 1–35          | 1–3, 6–9, 11–35                | March 14, 2025          |
| ’817 patent     | 1–32          | 1–5, 7–14, 16–19, 22–26, 28–32 | April 4, 2025           |

*See* Exs. A–D. In its first three petitions, MIM indicated that it planned to move to stay the litigation after the PTAB instituted review of one or more challenged patents. Ex. A, at 8–9; Ex. B, at 10–11; Ex. C, at 10. However, before filing the fourth petition, MIM concluded that bringing its motion at this moment would best assist the Court in considering options that are available to simplify this litigation. *See generally* Exhibit D.

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<sup>2</sup> The PTO’s trial statistics cover IPRs and the closely related post-grant reviews, or PGRs. According to the PTO, 97% of petitions filed in FY2024 were IPR petitions. *See* Ex. E at 3.

## ARGUMENT

The Court, in its discretion, may stay proceedings pending IPR. *See Landis v. N. Am. Co.*, 299 U.S. 248, 254–55 (1936) (“[T]he power to stay proceedings is incidental to the power inherent in every court to control the disposition of the causes on its docket with economy of time and effort for itself, for counsel, and for litigants.”); *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1426–27 (Fed. Cir. 1988) (“Courts have inherent power to manage their dockets and stay proceedings[.]”). A stay can “simplify the rest of [the] litigation, conserve resources, and eliminate inconsistent results.” *Ultratec, Inc. v. CaptionCall, LLC*, 611 F. App’x 720, 722 (Fed. Cir. 2015).

Courts consider three factors to determine whether to grant a stay pending IPR:

(1) the stage of the litigation, including whether discovery is complete and a trial date has been set; (2) whether a stay will simplify the issues in question and the trial of the case; and (3) whether a stay will unduly prejudice or present a clear tactical disadvantage to the nonmoving party.

*ACQIS*, 109 F. Supp. 3d at 356 (internal quotation marks and citation omitted). A stay is “particularly justified” if the IPR “is likely to assist the court in determining patent validity or eliminate the need to try infringement issues.” *NFC Tech. LLC v. HTC Am., Inc.*, No. 2:13-CV-1058-WCB, 2015 U.S. Dist. LEXIS 29573, at \*4 (E.D. Tex. Mar. 11, 2015) (internal quotation marks and citation omitted).

Here, all three factors weigh in favor of a stay.

### **I. THE EARLY STAGE OF THIS CASE FAVORS A STAY.**

The first *ACQIS* factor favors a stay unless “litigation has progressed significantly enough for a stay to be *disfavored*.” 109 F. Supp. 3d at 356 (emphasis added). “Staying a case that is in an early stage of litigation advance[s] judicial efficiency and maximize[s] the likelihood that neither the Court nor the parties expend their assets addressing invalid claims.” *Destination Maternity Corp. v. Target Corp.*, 12 F. Supp. 3d 762, 770 (E.D. Pa. 2014) (internal quotation marks and

citation omitted) (alterations in original). To measure a case’s maturity, courts consider the progression of discovery, claim construction, and summary judgment and whether a trial date is set. *E.g.*, *ACQIS*, 109 F. Supp. 3d at 356; *Teva Pharms. Int’l GMBH v. Eli Lilly & Co.*, No. 18-cv-12029-ADB, 2019 U.S. Dist. LEXIS 67575, at \*15–16 (D. Mass. Apr. 22, 2019); *see also Irwin Indus. Tool Co. v. Milwaukee Elec. Tool Corp.*, No. 3:15-cv-30005-MGM, 2016 U.S. Dist. LEXIS 56885, at \*7 (D. Mass. Apr. 28, 2016) (“There is much more work ahead for the parties and this court than behind the parties and this court. . . . Accordingly, this factor weighs strongly in favor of granting a stay in the instant case.”).

By all metrics, this case is in its early stages. The Court’s only ruling on the merits in this case was an order granting in part MIM’s motion to dismiss. Dkt. 72. Discovery is in its earliest stage, as only preliminary disclosures have been exchanged and no discovery responses have been served by either party. *See* Dkt. 85. The parties have not discussed terms to be construed at the *Markman* hearing, which is at least seven months away. *Id.* at 2. *Daubert* and dispositive motions are not due for at least 18 months, *id.* at 3, and no trial date is set, *id.* at 4.

## II. THE IPRS MAY SIGNIFICANTLY NARROW CLAIMS FOR TRIAL.

The second *ACQIS* factor favors a stay if “the outcome of the IPR would be likely to assist the court in determining patent validity and, if the claims were canceled . . . would eliminate the need to try the infringement issue.” 109 F. Supp. 3d at 357 (internal quotation marks and citation omitted) (alteration in original). The key inquiry is whether the patents subject to review constitute “the gravamen” of the plaintiff’s case. *Koninklijke Philips N.V. v. Amerlux, LLC*, 167 F. Supp. 3d 270, 274 (D. Mass. 2016). Thus, if fewer than all asserted patents are subject to *inter partes* review, this factor favors a stay when there is “significant overlap in claim terms” and “similarity of inventive disclosure” between the remaining patents and those subject to review. *ACQIS*, 109 F. Supp. 3d at 357–58.

The four challenged patents overlap significantly with the remaining two Asserted Patents. Each patent relates to the same technical field of creating, analyzing, and/or presenting medical image data. During prosecution of each subsequent patent, every existing Asserted Patent or its application was disclosed to the Examiner as potential prior art. Moreover, the following terms are central to the claims of the four challenged patents as well as the claims of the remaining two patents: “hot spot,” “machine learning,” “anatomical image,” “nuclear medicine (‘functional’) image,” “risk index,” “risk map,” and “[radiopharmaceutical] uptake.” *See, e.g.*, ’346 patent at 35:46–36:8, 36:38–42 (claims 1, 12); ’486 patent at 74:2–46 (claim 1); ’035 patent at 36:18–52, 37:18–24 (claims 1, 16); ’141 patent at 37:8–41, 38:42–48 (claims 1, 19); ’428 patent at 48:62–49:27, 50:9–12 (claims 1, 9); ’817 patent at 79:5–33, 79:61–64 (claims 1, 5). The parties are likely to seek construction of these terms during the *Markman* hearing; indeed, MIM offered constructions of “risk index,” “risk indices,” and “risk map” in its IPR petitions. *See* Ex. A at 4–6; Ex. B at 3–7; Ex. C at 3–6.

This case will be simplified regardless of the outcome of any IPR, as “the PTAB’s order will facilitate trial by providing the court with the PTAB’s expert opinion and likely will clarify the scope of the claims remaining for trial.” *Irwin Indus. Tool*, 2016 U.S. Dist. LEXIS 56885, at \*8. Last year, the PTAB instituted review of 74% of challenged patents, and within those instituted petitions, 49% of claims were invalidated. *See* Ex. E at 7, 13. Claims invalidated by the PTAB will become moot in this litigation, streamlining this case significantly. But even if each claim of each IPR petition survives final written decision by the PTAB (which is unlikely given the statistics set forth *supra*), the case will still be simplified because it will limit the invalidity arguments raised by MIM in this litigation. 35 U.S.C. § 315(e)(2); *see Gratuity Sols., LLC v. Toast, Inc.*, No. 1:22-cv-11539-JEK, 2024 U.S. Dist. LEXIS 74550, at \*11–12 (D. Mass. Apr. 24, 2024) (granting stay).

Simply put, the PTAB's ruling is "well worth the wait." *InMode Ltd. v. BTL Indus., Inc.*, – F. Supp. 3d –, 2025 U.S. Dist. LEXIS 57253, at \*6 (D. Mass. Mar. 27, 2025) (Saris, J.).

### III. THE STAY WILL NOT CAUSE UNDUE PREJUDICE.

The third *ACQIS* factor considers whether the nonmovant will be unduly prejudiced by a stay or whether the motion to stay is a tactical decision to place the nonmovant at a disadvantage. "Mere delay does not rise to the level of undue prejudice." *ACQIS*, 109 F. Supp. 3d at 358. "Undue prejudice requires a showing . . . such as a dilatory motive on the part of the party seeking a stay, unavailability of legal remedies once the stay is lifted, or the parties' relationship as direct competitors in the marketplace." *DiversiTech Corp. v. RectorSeal, LLC*, No. 20-11896-NMG, 2021 U.S. Dist. LEXIS 131270, at \*8 (D. Mass. July 14, 2021) (internal quotation marks and citation omitted).

First, MIM has not acted in a dilatory manner. The key question is whether the motion to stay or IPR itself are "tactical move[s] to delay trial." *Irwin Indus. Tool*, 2016 U.S. Dist. LEXIS 56885, at \*9–10. They are not. The parties have sought or agreed to multiple extensions of time in this case. *See* Dkt. 46, 51, 54.<sup>3</sup> Furthermore, MIM brings its motion to stay promptly after filing its final IPR petition with the PTAB. *See Gratuity Sols.*, 2024 U.S. Dist. LEXIS 74550, at \*13 (no dilatory motive where alleged infringer filed its motion to stay less than one week after the PTAB instituted IPR); *Pakage Apparel, Inc. v. Tommy John, Inc.*, No. 24-cv-6371 (LJL), 2024 U.S. Dist. LEXIS 163038, at \*15–16 (S.D.N.Y. Sep. 9, 2024) (no undue prejudice "when the motion for a stay was filed in close proximity to the IPR petition").

Second, Plaintiffs will retain all legal remedies available to them once the stay is lifted. A mere delay in a plaintiff's recovery of monetary damages "is not meaningful where the prevailing

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<sup>3</sup> Additionally, Plaintiffs waited roughly eight months from when they allege to have discovered the Accused Products to file their Complaint. *See* Dkt. 1; Dkt. 25 ¶ 52.

party in patent cases may recover prejudgment interest.” *SCVNGR, Inc. v. eCharge Licensing, LLC*, No. 13-12418-DJC, 2014 U.S. Dist. LEXIS 135408, at \*26 (D. Mass. Sep. 25, 2014); *see also*, *e.g.*, *Teva Pharms.*, 2019 U.S. Dist. LEXIS 67575, at \*22. Nor is there any risk of “the quality and quantity of evidence disappearing, the evolving market, [or] the difficulty in tracking down witnesses” that may impact Plaintiffs’ ability to prove infringement after the PTAB’s final written decision. *See Canatelo, LLC v. Avigilon Corp.*, No. 12-1431(JAG), 2014 U.S. Dist. LEXIS 78274, at \*5 (D.P.R. June 5, 2014).

Finally, the parties’ relationship as competitors does not create undue prejudice. While a stay between direct competitors may risk undue prejudice, such risk is minimized “where relief from the injuries flowing from the alleged infringement will not be impaired by a stay.” *Teva Pharms.*, 2019 U.S. Dist. LEXIS 67575, at \*21; *see also Irwin Indus. Tool*, 2016 U.S. Dist. LEXIS 56885, at \*11–12. And a failure by a patent owner to seek a preliminary injunction to halt sales of an alleged competitor is an indication of the absence of undue prejudice. *See ACQIS*, 109 F. Supp. 3d at 358 (“ACQIS did not seek a preliminary injunction in this case, undermining its claim of undue prejudice.”); *Teva Pharms.*, 2019 U.S. Dist. LEXIS 67575, at \*21–22.

Here, Plaintiffs face no undue prejudice from a stay by their mere status as competitors. Plaintiffs will have all of their legal and equitable remedies available once the stay is lifted, and any delay can be compensated upon proving infringement by calculating prejudgment interest. Moreover, despite having filed its case over a year ago, Plaintiffs have not moved for a preliminary injunction and have indicated no intention to do so.

### **CONCLUSION**

For these reasons, MIM respectfully requests that the Court grant its motion to stay this case pending the final resolution of the IPRs adjudicating the ’346, ’035, ’141, and ’817 patents.

Dated: April 8, 2025

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**CERTIFICATE OF SERVICE**

I hereby certify that on April 8, 2025 a true and correct copy of the foregoing document was electronically filed with the Clerk of the Court using CM/ECF. A true and correct copy of the foregoing documents was served this day on all counsel of record via electronic transmission by the Court's CM/ECF system and by email.

/s/ Marla R. Butler