Trials@uspto.gov
571-272-7822

Paper 30
Entered: February 6, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUBILANT DRAXIMAGE INC.,
Petitioner,

v.

BRACCO DIAGNOSTICS INC.,
Patent Owner.

IPR2018-01448
Patent 9,299,468 B2

Before HYUN J. JUNG, GEORGE R. HOSKINS, and RICHARD H. MARSCHALL, *Administrative Patent Judges*.

JUNG, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons that follow, we determine that Petitioner has shown by a

preponderance of the evidence that claims 1, 2, 4–20, and 24–28 of U.S. Patent No. 9,299,468 B2 are unpatentable.

A. Background and Summary

Jubilant DraxImage Inc. ("Petitioner") filed a Petition (Paper 1, "Pet.") requesting institution of an *inter partes* review of claims 1, 2, 4–20, and 24–28 of U.S. Patent No. 9,299,468 B2 (Ex. 1001, "the '468 patent"). Bracco Diagnostics Inc. ("Patent Owner") filed a Preliminary Response. Paper 6. Pursuant to 35 U.S.C. § 314, we instituted an *inter partes* review of the '468 patent. Paper 7 ("Dec. to Inst."). In particular, we instituted review of claims 1, 2, 4–20, and 24–28 on all presented challenges. Dec. to Inst. 2, 16, 22.

After institution, Patent Owner filed a Response (Paper 13, "PO Resp."), to which Petitioner filed a Reply (Paper 14, "Pet. Reply"). We authorized via email (1) Patent Owner to file a paper identifying arguments in Petitioner's Reply that Patent Owner believed exceeded proper scope and (2) Petitioner to file a paper to identify where the contention Petitioner was responding to can be found. Patent Owner filed its authorized paper (Paper 15), and Petitioner filed its authorized response (Paper 16). Patent Owner thereafter filed a Sur-Reply (Paper 17, "PO Sur-Reply").

An oral hearing in this proceeding was held on October 29, 2019; a transcript of the hearing is included in the record (Paper 26, "Tr.").

B. Real Parties in Interest

Petitioner states that the "real parties-in-interest for this Petition are Jubilant DraxImage Inc., Jubilant Pharma Limited, and Jubilant Life Science Limited." Pet. 2. Patent Owner states that "Bracco Diagnostics Inc. ('Bracco') is the real party-in-interest." Paper 4, 2.

C. Related Matters

The parties indicate that the '468 patent has been asserted in *Bracco Diagnostics Inc. v. Jubilant DraxImage Inc.*, Case No. 3:18-cv-04422 (D.N.J.). Pet. 2; Paper 4, 2; PO Resp. 5; Ex. 1002 (complaint for patent infringement involving the '468 patent and others). The parties also indicate that the district court litigation is stayed pending resolution of Investigation No. 337-TA-1110 by the U.S. International Trade Commission ("ITC" or "Commission"). Pet. 2 (citing Exs. 1002–1004); PO Resp. 5 (citing Exs. 1002–1004); Ex. 1004 (order from civil action no. 3:18-cv-4422 granting joint motion to stay pending resolution of ITC Investigation No. 337-TA-1110).

In the ITC investigation filed March 27, 2018, Bracco Diagnostics, Inc. contends that Jubilant DraxImage Inc., Jubilant Pharma Limited, and Jubilant Life Sciences violate Section 337 of the Tariff Act of 1930 by importing strontium-rubidium infusion systems and components that infringe one of U.S. Patent Nos. 9,814,826; 9,750,869; and 9,750,870. Ex. 1003, 1, 14. The '468 patent is not part of the ITC investigation, but Patent Owner indicates that the investigation "involv[es] related patents." PO Resp. 5 (citing Exs. 1002–1004). Patent Owner also states that "an ITC evidentiary hearing was held April 11–17 relative to the related patents, and many of the same factual issues disputed there are also in dispute here." *Id.*

Patent Owner subsequently filed a "Notice of Commission Determination to Review in Part a Final Initial Determination Finding No Section 337 Violation." Paper 21; Ex. 2018 (notice from Investigation No. 337-TA-1110 issued Sept. 30, 2019). The notice states that a Final Initial Determination ("FID") was issued on August 1, 2019, "the FID finds . . . all

asserted claims are infringed but invalid as obvious over the prior art," and the "Commission has determined to review the FID in part." Ex. 2018, 2.

Petitioner filed a "Notice of Commission Final Determination of No Violation of Section 337; Termination of the Investigation." Paper 27, 1; Ex. 1047. According to Petitioner, "Ex. 1047 indicates that the Commission determined to affirm with modification and to supplement the prior Final Initial Determination's findings with respect to the invalidity of the patent claims asserted in the 1110 Investigation." Paper 27, 1 (citing Ex. 1047, 2); Ex. 1047, 2 (stating that "the Commission has determined to affirm with modification and to supplement the FID's findings with respect to the invalidity of the asserted patent claims").

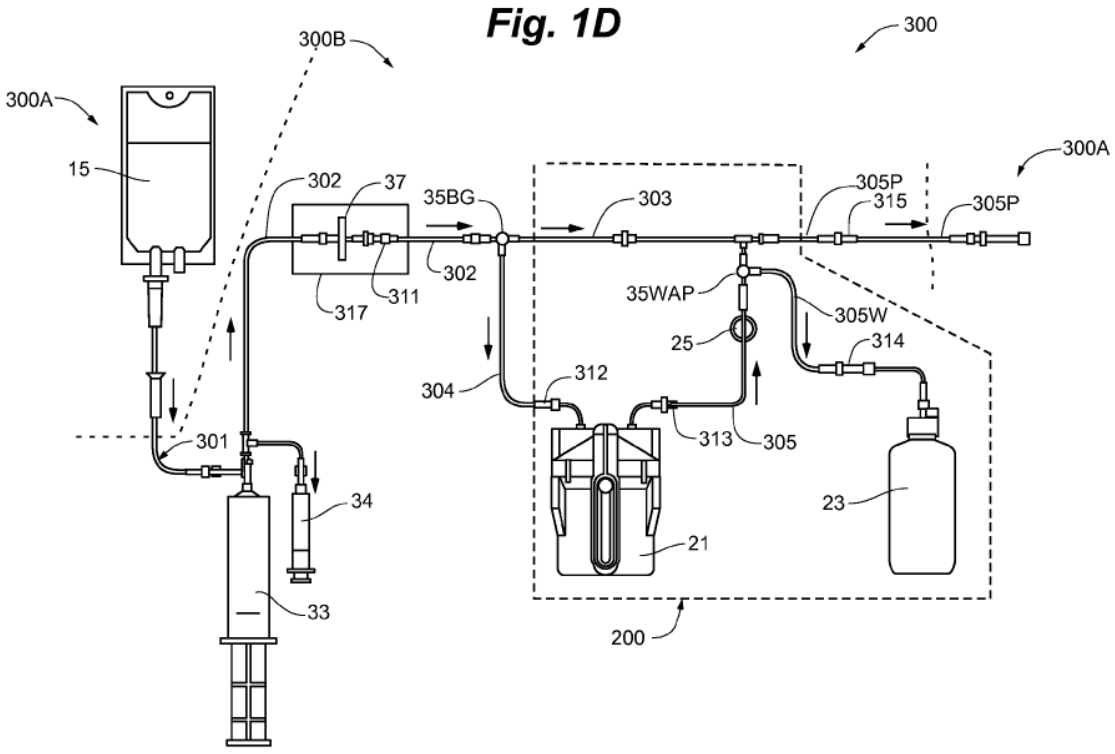
Petitioner also filed a public version of a Commission Opinion for Investigation No. 337-TA-1110. Paper 28; Ex. 1048. Petitioner states that the "Commission Opinion addresses several issues that are relevant to the present *inter partes* review." Paper 28, 1. According to Petitioner, "the Commission considered teachings of the Klein and Tate references against claim elements that require an eluate reservoir, a shielded well, and a dose calibrator to be located 'on-board a cart'" and held that "Klein, alone or in combination with Tate, teaches or discloses such subject matter." *Id.* (citing Ex. 1048, 13–19). Petitioner also states that "the Commission considered teachings of the Klein reference against claim elements that require a computer not to allow a patient infusion when a strontium breakthrough test result is greater than or equal to an allowed limit" and held that "Klein teaches or discloses such subject matter." *Id.* (citing Ex. 1048, 24–26). Patent Owner has filed an appeal of the Commission Opinion. Ex. 2019.

The ’468 patent is also challenged in IPR2018-01450, and a related patent that claims priority to common applications is challenged in IPR2018-01449. Pet. 2; Paper 4, 2; PO Resp. 5.

D. The ’468 Patent

The ’468 patent issued March 29, 2016, from an application filed August 8, 2014, which is a continuation of an application filed June 11, 2009, which, in turn, is a continuation of four applications filed June 11, 2008. Ex. 1001, codes (22), (45), (63), 1:8–21; *see also* Pet. 9 (asserting that the “priority date for the ’468 Patent is June 11, 2009” because the applications filed on June 11, 2008 fail to “provide written description support for ‘a dose calibrator carried by [a] movable cart’ as required by claims 1 and 24”).

The ’468 patent relates to “systems that generate and infuse radiopharmaceuticals.” Ex. 1001, 1:25–26. Figure 1D of the ’468 patent is reproduced below.



DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.