

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUBILANT DRAXIMAGE INC.,
Petitioner,

v.

BRACCO DIAGNOSTICS INC.,
Patent Owner.

Case IPR2018-01449
Patent 9,299,467 B2

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

MARSCHALL, *Administrative Patent Judge*.

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

I. INTRODUCTION

Jubilant DraxImage Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting institution of an *inter partes* review of claims 1–4, 6–16, and 18–22 of U.S. Patent No. 9,299,467 B2 (Ex. 1001, “the ’467 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 claims 1–4, 6–16, and 18–22 the ’467 patent, on all presented challenges. Paper 7 (“Dec. to Inst.”), 2, 21. After institution, Patent Owner filed a Response (Paper 13, “PO Resp.”), to which Petitioner filed a Reply (Paper 14, “Pet. Reply”), and Patent Owner filed a Sur-Reply (Paper 15, “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 24, “Tr.”).

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 1–4, 6–16, and 18–22 of the ’467 patent are unpatentable.

II. BACKGROUND

A. *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.

B. *Related Proceedings*

The parties indicate that the ’467 patent has been asserted in *Bracco Diagnostics Inc. v. Jubilant DraxImage Inc.*, Case No. 3-18-cv-04422

IPR2018-01449
Patent 9,299,467 B2

(D.N.J.). Pet. 2; Paper 4, 2; Exs. 1002, 1004. A related patent, U.S. Patent No. 9,299,468 B2, claims priority to applications in common with the '467 patent, and is the subject of challenges in IPR2018-01448 and IPR2018-01450. Pet. 2; Paper 4, 2.

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. 2 (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 or more of U.S. Patent Nos. 9,814,826; 9,750,869; and 9,750,870. Ex. 1003, 1, 14. The '467 patent is not part of the ITC investigation, but Patent Owner indicates that the investigation “involv[es] related patents.” PO Resp. 2 (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 19; 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 25, 1; Ex. 1039. According to Petitioner, “Ex. 1039 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 25, 1 (citing Ex. 1039, 2); Ex. 1039, 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 26; Ex. 1040. Petitioner states that the “Commission Opinion addresses several issues that are relevant to the present *inter partes* review.” Paper 26, 1. According to Petitioner, “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, holding that Klein teaches or discloses such subject matter.” *Id.* (citing Ex. 1040, 24–26). Petitioner also states that “the Commission evaluated and rejected testimony from Bracco’s expert, Dr. Norbert Pelc, on several issues.” *Id.* (citing Ex. 1040, 18, 20–21, 25–26). Patent Owner has filed an appeal of the Commission Opinion. Ex. 2019.

C. The ’467 Patent (Ex. 1001)

The ’467 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), 1:8–19.

The '467 patent relates to “systems that generate and infuse radiopharmaceuticals.” *Id.* at 1:23–24. Figure 1D of the '467 patent is reproduced below.

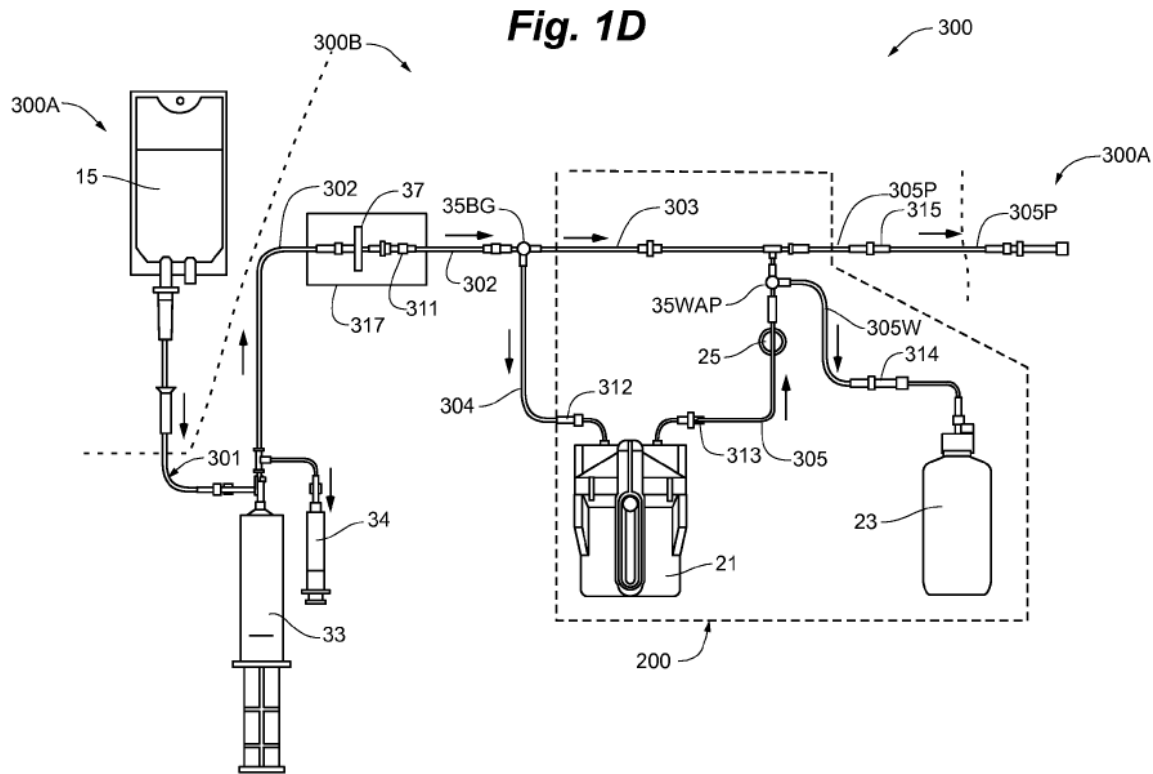


Figure 1D is “a schematic of an infusion circuit.” *Id.* at 2:8–9. Infusion system 10 can be mobile and may incorporate infusion circuit 300, a part of which is contained within shielding assembly 200. *Id.* at 3:46–50, 4:47–56, Fig. 1A. Infusion circuit 300 includes eluant reservoir 15 that contains saline as the eluant, syringe pump 33 that pumps eluant from reservoir 15, radioisotope generator 21 through which eluant is pumped to create a radioactive eluant, and activity detector 25 that measures the activity of the eluant from generator 21. *Id.* at 4:59–5:5. Activity detector 25 also

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.