

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUBILANT DRAXIMAGE INC.,
Petitioner,

v.

BRACCO DIAGNOSTICS INC.,
Patent Owner.

IPR2018-01450
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 21–23 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 21–23 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 21–23 on all presented challenges. Dec. to Inst. 2, 14, 16, 19.

After institution, Patent Owner filed a Response (Paper 14, “PO Resp.”), to which Petitioner filed a Reply (Paper 15, “Pet. Reply”). Patent Owner thereafter filed a Sur-Reply (Paper 16, “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 25, “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. 10.¹ Patent Owner states that “Bracco Diagnostics Inc. (‘Bracco’) is the owner of U.S. Patent No. 9,299,468” and “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

¹ The Petition does not include page numbers for each page. Thus, we, like Patent Owner, identify page numbers by referring to the page of the PDF document. See PO Resp. 12 n.3.

IPR2018-01450
Patent 9,299,468 B2

(D.N.J.). Pet. 10; Paper 4, 2; PO Resp. 2; 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. 10 (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 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. 2 (citing Exs. 1002–1004). Patent Owner also states that “an ITC evidentiary hearing was held April 11–17[, 2019] 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 20; 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,”

IPR2018-01450
Patent 9,299,468 B2

petitions for review of the FID were filed, 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 26; 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 26, 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 27; Ex. 1048. Petitioner states that the “Commission Opinion addresses several issues that are relevant to the present *inter partes* review.” Paper 27, 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” 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 same patent is also challenged in IPR2018-01448, and a related patent that claims priority to common applications is challenged in IPR2018-01449. Pet. 10; Paper 4, 2; PO Resp. 1–2.

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, 20 (arguing that June 2008 is the earliest date to which the '468 patent claims priority), 14–17 (describing prior applications).

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.

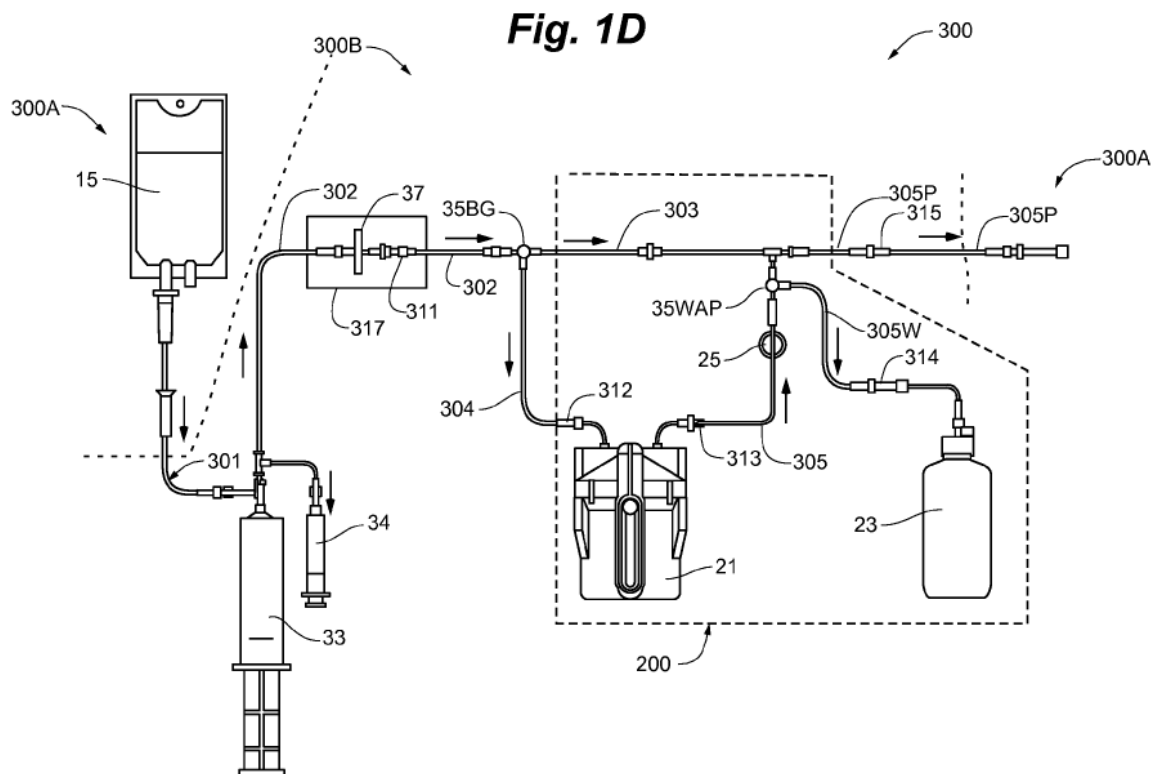


Figure 1D is “a schematic of an infusion circuit.” *Id.* at 2:10–11. Infusion system 10 can be mobile and may incorporate infusion circuit 300, a part of which is contained within shielding assembly 200. *Id.* at 3:52–54, 4:53–61, Fig. 1A. Infusion circuit 300 includes eluant reservoir 15 that contains 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

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.