

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDIVIS, INC.
Petitioner

v.

NOVARAD CORP.
Patent Owner

US Patent No. 11,004,271

Inter Partes Review No. IPR2023-00042

Request for Rehearing Under 37 CFR §42.71(d)(2)

INTRODUCTION

The Final Written Decision (FWD) in this IPR overlooked or misapprehended matters related to the evidence of public accessibility of certain non-patent references. When properly considered in view of the totality of facts and circumstances in the record about their public accessibility, Chen (Exhibit 1009)¹, 3D-Slicer-Visualization (Exhibit 1007)², and 3D-Slicer-GUI (Exhibit 1010)³ each qualify as printed publications.

BACKGROUND

This IPR began when Medivis petitioned for *inter partes* review of US Patent 11,004,271 on three grounds. Novarad, the owner of the '271 patent, filed no preliminary response. The Board instituted review on all three grounds and acknowledged that, among other grounds, “[Medivis] contends that claims 1-6 and

¹ X. Chen et al., “Development of a Surgical Navigation System Based on Augmented Reality Using an Optical See-Through Head-Mounted Display,” 55 JOURNAL OF BIOMEDICAL INFORMATICS 124-131 (2015) (“Chen”).

² S. Pujol, Ph.D. et al., 3D Visualization of DICOM Images for Radiological Applications, (Surgical Planning Laboratory, Brigham and Women’s Hospital, Boston, Massachusetts 2014) (“3D-Slicer-Visualization,” aka “3D Visualization”) (Ex. 1007).

³ Main Application GUI for 3D Slicer available at <https://www.slicer.org/wiki/Documentation/4.6/Slicer/Application/MainApplicationGUI> (“last edited 7 November 2016”) (“3D-Slicer-GUI,” aka “3D Slicer”) (Ex. 1010).

11-20 would have been obvious over the combined teachings of Doo and Amira, and the combined teachings of Chen, [3D-Slicer-GUI], and [3D-Slicer-Visualization].” Inst. Dec. 12 (citing Pet. 41-69 and Ex. 1012 ¶¶80-133).

In response to Novarad objections, Medivis timely served declarations and other evidence as an offer of further proof of the public accessibility of its non-patent references. Reply, Table of Exhibits (reporting service of Exhibits 1015-1021 and 1023-1024 on May 22, 2023)). With that proof in hand, Novarad nonetheless asserted that Medivis “offers no proof that any of the asserted documents were in fact publicly available before the priority date of the ‘271 patent.” POR 19 (July 18, 2023). Implicitly acknowledging the lack of candor in its absolute assertion, Novarad argued “a copyright notice ... is not enough.” POR 19-20.

As to obviousness of ‘271 patent claims in view of the combined teachings of Chen, 3D-Slicer-Visualization, and 3D-Slicer-GUI, the FWD “start[ed] and end[ed] the] analysis with public accessibility.” FWD 26. It found that, “[b]ecause [Medivis] has not shown any of the references of this ground to be publicly accessible prior art, Petitioner has not proven by a preponderance of evidence that claims 1-6 and 11-20 would have been obvious over the combination of Chen, [3D-Slicer-Visualization], and [3D-Slicer-GUI].” FWD 31.

STANDARD FOR EVALUATION

“‘[P]ublic accessibility’ [is] the touchstone in determining whether a reference constitutes a ‘printed publication’ bar under 35 U.S.C. § 102(b).” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 (PTAB Dec. 20, 2019) (precedential) at 10 (quoting *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1348 (Fed. Cir. 2016)). “A given reference is ‘publicly accessible’ upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *Hulu*, at 10-11 (quoting *SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008)). “What constitutes a ‘printed publication’ must be determined in light of the technology employed.” *Hulu*, at 10 (citing *Samsung Elecs. Co. v. Infobridge Pte. Ltd.*, 929 F.3d 1363, 1369 (Fed. Cir. 2019)).

Nonetheless, “the indicia on the face of a reference, such as printed dates and stamps, are considered part of the totality of the evidence.” *Hulu*, at 17-18 (citing *Nobel Biocare Servs. AG v. Instradent USA, Inc.*, 903 F.3d 1365, 1377 (Fed. Cir. 2018)). Applying the law to the facts of record, the Hulu decision—which is precedential as to how a petitioner may show an asserted reference qualifies as a printed publication—held that a copyright date, a printing date, an ISBN date, and

an established publisher of a series of a similar type of references demonstrate a reasonable likelihood that a book is a printed publication. *Hulu*, at 19-20.

OVERLOOKED AND MISAPPREHENDED MATTERS

The FWD did not properly evaluate the public accessibility of Chen (Exhibit 1009), 3D Slicer-Visualization (Exhibit 1007) and 3D Slicer-GUI (Exhibit 1010) in view of all of the facts and circumstances relevant to their public accessibility of record with respect to the Petition, the Reply, Novarad's adopted evidence, and undisputed facts set forth in Medivis's Motion to Exclude.

First, the FWD wrongly found that the Petition offers "no proof" that any of these references were publicly accessible. FWD 26 (citing Pet. 29-30). The FWD's citation suggests that finding is based on only two pages of the Petition. But even those two Petition pages cite evidence that the *Hulu* tribunal recognized as a type of evidence that can support a finding that a reference is a printed publication: including a copyright date, a publication date, and an established publisher of a series of a similar type of references. *Hulu*, at 19-20. The Board overlooked or misapprehended the substance of *Hulu*'s precedential decision and how that decision applies to the Petition evidence including, but not limited to, evidence cited on pages 29-30 of the Petition.

Professor Kazanzides qualifies as a person of ordinary skill in the art (POSA), under both his proposed definition and the Board's slightly-modified definition. Pet.

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