

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

FUJIFILM CORPORATION,  
Petitioner,

v.

HOLOGIC, INC.,  
Patent Owner.

---

Case IPR2018-00538  
Patent 7,123,684 B2

---

Before MEREDITH C. PETRAVICK, BRIAN J. McNAMARA, and  
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review

35 U.S.C. § 314(a)

## I. INTRODUCTION

### A. OVERVIEW

FUJIFILM Medical Systems USA, Inc., FUJIFILM Corporation, and FUJIFILM Techno Products Co., Ltd. (collectively, “Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 11, 29, 33, and 41 of U.S. Patent No. 7,123,684 B2 (Ex. 1003, “the ’684 patent”). Pet. 1. Hologic, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”), to which we authorized Petitioner to file a Reply (Paper 10, “Pet. Reply”).

Section 314(a) of Title 35 of the United States Code provides that an *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . shows that there is 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). Upon consideration of the Petition, the Preliminary Response, and Petitioner’s Reply, for the reasons explained below, we conclude that the information presented in the Petition does not establish a reasonable likelihood that Petitioner would prevail with respect to any of the challenged claims.

Accordingly, we decline to institute an *inter partes* review.

### B. RELATED PROCEEDINGS

Petitioner indicates that the ’684 patent is involved in: *In the Matter of Certain X-Ray Breast Imaging Devices and Components Thereof*, Investigation No. 337-TA-1063 in the U.S. International Trade Commission and *Hologic, Inc., v. FUJIFILM Medical Systems USA, Inc., Ltd.*, No. 3:17-

cv-1056 in the United States District Court for the District of Connecticut.  
Paper 1, 3.

C. THE '684 PATENT

The '684 patent relates to X-ray mammography using digital image receptors. Ex. 1003, 1:14–44. The '684 patent acknowledges that conventional mammography systems “have provisions for partly or fully automating the selection of appropriate technic factors for an x-ray exposure, such as one or more of kVp (the x-ray tube accelerating potential), mA (x-ray tube current), and exposure time.” *Id.* at 1:45–49. The '684 patent describes that

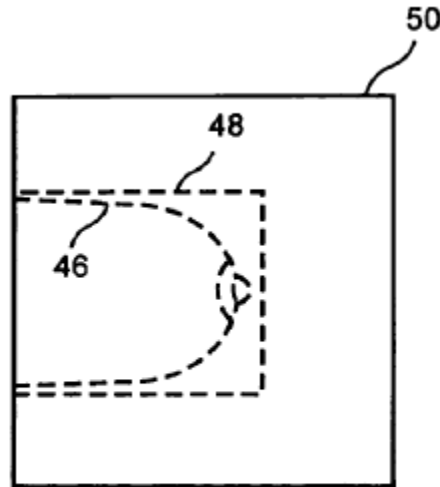
one known approach for use with digital flat panel image receptors is to take a short, low x-ray dosage pre-exposure after the breast has been compressed, and then take an imaging exposure while the breast remains immobilized, using technic factors based on measurements taken with the same receptor in the pre-exposure.

*Id.* at 1:56–61. The '684 patent further describes that it is known to transmit and store mammography images. *Id.* at 2:16–20. However, the '684 patent identifies that known processes are inefficient because “in many if not most cases, the breast takes up only a part of the image taken with flat panel digital receptors such that an imaginary rectangle that envelops the image of the breast is smaller than the field of view of the receptor.” *Id.* at 2:21–24.

To address this drawback, the '684 patent discloses “transmit[ing] and stor[ing] only a portion of the field of view” of the digital receptor by defining a “reduced field of view area 48” using various methods. *Id.* at 5:58–6:10; *see id.* at Fig. 6, elements 52, 54, 56. In effect, the '684 patent

discloses “crop[ping] the resulting breast image before transmitting and/or storing and/ or formatting it for transmission or storage.” *Id.* at 5:65–6:2.

Reproduced below is Figure 5 of the '684 patent.



**FIG. 5**

FIG. 5 illustrates selection of a decreased size mammography image for storage and transmission.

Figure 5 depicts field of view 50 of flat panel x-ray image receptor 12c along with breast image 46, which is within reduced field of view 48. *Id.* at 5:41–48.

#### D. ILLUSTRATIVE CLAIMS

Petitioner challenges claims 11, 29, 33, and 41 of the '684 patent. Each of claims 11, 29, 33, and 41 are independent. Independent claim 11 is illustrative of the challenged claims, and is reproduced below:

11. A mammography method comprising:

providing an image of a patient's breast that occupies less than the entire field of view of an imaging receptor;

automatically selecting an outline that encompasses the breast image to thereby define a reduced field of view image, wherein said outline is selected based on automatically derived information about a compression paddle selected to compress the breast for x-ray imaging, said outline encompasses an entirety of the patient's breast in the breast image, and the reduced field of view is defined based on said outline; and

using said reduced field or view image for further processing, transmission, and/or archiving.

E. EVIDENCE AND ASSERTED GROUNDS OF UNPATENTABILITY

Petitioner challenges the claims on the following grounds:

Claims	Basis	Reference(s)
11 and 41	§ 102(b)	Defreitas <sup>1</sup>
29 and 33	§ 103(a)	Defreitas and Niklason <sup>2</sup>
11 and 41	§ 103(a)	Muller <sup>3</sup> and Admitted Prior Art <sup>4</sup>
29 and 33	§ 103(a)	Muller, Admitted Prior Art, and Niklason
11 and 41	§ 103(a)	Kawamata <sup>5</sup> and Yamada <sup>6</sup>

<sup>1</sup> U.S. Patent No. 7,443,949 B2, issued Oct. 28, 2008 (Ex. 1005; "Defreitas").

<sup>2</sup> U.S. Patent No. 5,872,828, issued Feb. 16, 1999 (Ex. 1006; "Niklason").

<sup>3</sup> U.S. Patent Application Publication No. US 2001/0038679 A1, published Nov. 8, 2001 (Ex. 1007; "Muller").

<sup>4</sup> "'Background' of the '684 patent describing characteristics of 'typical[]' X-ray mammography systems, and known proposals for improving upon such systems" (Ex. 1003; "Admitted Prior Art").

<sup>5</sup> Japanese Patent Application Publication No. S64-46436, published February 20, 1989 (Ex. 1009; "Kawamata").

<sup>6</sup> Japanese Patent Application Publication No. H08-186762, published July 16, 1996 (Ex. 1011; "the '762 publication").

# 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.