

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ELEKTA INC.,
Petitioner,

v.

BEST MEDICAL INTERNATIONAL, INC.,
Patent Owner.

IPR2020-00971
Patent 6,393,096 B1

Before KARL D. EASTHOM, WILLIAM V. SAINDON, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314
Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

On May 28, 2020, Elekta Inc. (“Petitioner”) filed a Petition (Paper 2, “Petition” or “Pet.”) to institute *inter partes* review of claims 1 and 18 of U.S. Patent No. 6,393,096 B1 (Ex. 1001, “the ’096 patent,”) and a Motion for Joinder (Paper 3, “Motion” or “Mot.”) with *Varian Medical Systems, Inc. v. Best Medical International, Inc.*, IPR2020-00071 (“Varian IPR”). Subsequently, during a conference call held on June 10, 2020, counsel for Best Medical International, Inc. (“Patent Owner”) represented that Patent Owner does not oppose Petitioner’s Motion and will not file a preliminary response. *See* Paper 6 (Order documenting the conference call).

Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . 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; *see* 37 C.F.R. § 42.4. Upon consideration of the Petition and the evidence of record, we determine that Petitioner has established a reasonable likelihood of prevailing with respect to the unpatentability of at least 1 claim of the ’096 patent. Accordingly, we institute *inter partes* review of claims 1 and 18 of the ’096 patent. We also grant Petitioner’s Motion.

A. *Related Proceedings*

The parties identify the following proceedings related to the ’096 patent (Pet. 4; Paper 5, 1–2):

Best Med. Int’l, Inc. v. Elekta Inc., No. 1:19-cv-03409-MLB (N.D. Ga.);

Best Med. Int’l, Inc. v. Elekta AB, No. 1:18-cv-01600-MN (D. Del.);

Best Med. Int'l, Inc. v. Varian Med. Sys., Inc., No. 1:18-cv-01599 (D. Del.);

Elekta Inc. v. Best Med. Int'l, Inc., IPR2020-00074; and the Varian IPR.

We also note that Petitioner has challenged patents owned by Patent Owner in IPR2020-00067, IPR2020-00070, IPR2020-00073, IPR2020-00956, and IPR2020-00970.

B. The Asserted Grounds of Unpatentability

Petitioner challenges the patentability of claims 1 and 18 of the '096 patent on the following grounds. Pet 6.

Challenged Claims	35 U.S.C. §	References
1	103(a) ¹	Oldham ² , Viggars ³
18	103(a)	Oldham, Viggars, Morrill-1991 ⁴

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103. Because the '096 patent was filed before March 16, 2013 (the effective date of the relevant amendment), the pre-AIA version of § 103 applies.

² Oldham, M. et al., “A comparison of conventional ‘forward planning’ with inverse planning for 3D conformal radiotherapy of the prostate,” *Radiotherapy and Oncology*, 35:248–62 (1995) (Ex. 1019, “Oldham”).

³ Viggars D.A., et al., “The Objective Evaluation of Alternative Treatment Plans III: The Quantitative Analysis of Dose Volume Histograms,” *International Journal of Radiation Oncology • Biology • Physics*, 23:419–27 (1992) (Ex. 1015, “Viggars”).

⁴ Morrill, S.M. et al., “Treatment planning optimization using constrained simulated annealing,” *Phys. Med. Biol.*, 36(10):1341–61 (1991) (Ex. 1022, “Morrill-1991”).

Challenged Claims	35 U.S.C. §	References
1, 18	103(a)	Carol-2 ⁵ , Carol-17 ⁶
18	103(a)	Carol-2, Carol-17, Morrill-1991

Petitioner relies on the Declaration of Kenneth P. Gall, Ph.D. (Ex. 1002) in support of its contentions.

II. ANALYSIS

A. *Institution of Inter Partes Review*

We instituted an *inter partes* review in the Varian IPR on all challenged claims and all asserted grounds of unpatentability. Varian IPR, Paper 14. Petitioner here challenges the same claims and asserts the same grounds of unpatentability as those on which we instituted the Varian IPR. Pet. 1 (“The challenges to claims 1 and 18 presented herein are substantively identical to Varian’s challenges in IPR2020-00071 and are based on the same evidence as presented in IPR2020-00071”); Mot. 1. Petitioner also relies on the same declarant as did the petitioner in the Varian IPR. Mot. 4. *Compare* Ex. 1002, *with* Varian IPR, Ex. 1002 (Declarations of Kenneth P. Gall, Ph.D.).

Because the issues in the instant Petition are identical to those in the Varian IPR, and for the same reasons stated in our Decision on Institution in

⁵ Carol, M.P., *Chapter 2 – IMRT: Where We Are Today*, *The Theory & Practice of Intensity Modulated Radiation Therapy* (1997) 17–36 (Ex. 1020, “Carol-2”).

⁶ Carol, M.P., *Chapter 17 – Where We Go From Here: One Person’s Vision*, *The Theory & Practice of Intensity Modulated Radiation Therapy* (1997) 243–52 (Ex. 1021, “Carol-17”).

the Varian IPR, we institute *inter partes* review in this proceeding on the grounds presented in the Petition. See Varian IPR, Paper 14.

B. Motion for Joinder

Joinder in an *inter partes* review is subject to the provisions of 35 U.S.C. § 315(c):

(c) JOINDER.—If the Director institutes an *inter partes* review, the Director, in his or her discretion, may join as a party to that *inter partes* review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion for joinder should: (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. *Kyocera Corp. v. SoftView, LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013).

We determine that Petitioner has met its burden of showing that joinder is appropriate because, as set forth above, the Petition here: (1) is substantively identical to the petition in the Varian IPR; (2) contains the same grounds based on the same evidence; and (3) relies on the same declaration of Dr. Kenneth P. Gall. Mot., *passim*; Ex. 1002. Petitioner also represents that it “is willing to streamline discovery and briefing by taking an ‘understudy role,’ so that the proposed joinder will not complicate or delay the schedule in the Varian IPR.” Mot. 1.

Additionally, “so long as Varian remains an active party in the joined proceeding,” Petitioner: (1) “shall be bound by any agreement between Patent Owner and Varian concerning discovery and/or depositions,” (2) shall not receive at depositions “any direct examination, cross examination, or redirect time beyond that permitted in this proceeding under either 37 C.F.R. § 42.53 or any agreement between Patent Owner and Varian,” (3) agrees that “[a]ll filings by Elekta in the joined proceeding shall be consolidated with the filings of Varian, unless a filing solely concerns issues that do not involve Varian,” and (4) “shall not be permitted to raise any new grounds not already instituted by the Board in the Varian IPR, or introduce any argument or discovery not already introduced by Varian.” Mot. 7–8.

We determined above that the Petition warrants the institution of an *inter partes* review. Under these circumstances, we agree with Petitioner that joinder is appropriate and will not unduly impact the ongoing trial in the Varian IPR. We limit Petitioner’s participation in the joined proceeding, as follows: (1) Varian alone is responsible for all petitioner filings in the joined proceeding until such time that it is no longer an entity in the joined proceeding, and (2) Petitioner is bound by all filings by Varian in the joined proceeding, except for (a) filings regarding termination or settlement, and (b) filings where Petitioner receives permission to file an independent paper. Petitioner must obtain prior Board authorization to file any paper or take any action on its own in the joined proceeding, so long as Varian remains as a non-terminated petitioner in the joined proceeding. This arrangement promotes the just and efficient administration of the ongoing trial in the Varian IPR, and protects the interests of Varian as original petitioner in IPR2020-00071, and of Patent Owner.

III. CONCLUSION

For the foregoing reasons, we institute *inter partes* review of claims 1 and 18 of the '096 patent based on the grounds of unpatentability set forth in the Petition. We *grant* Petitioner's Motion for Joinder and join Petitioner to IPR2020-00071, with the limitations set forth herein.

IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review is hereby instituted as to claims 1 and 18 of the '096 patent with respect to the grounds set forth in the Petition;

FURTHER ORDERED that, pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(a), Petitioner's Motion for Joinder (Paper 3) is *granted*, and Petitioner is joined as a petitioner in IPR2020-00071;

FURTHER ORDERED that the asserted grounds of unpatentability on which the Board instituted *inter partes* review in IPR2020-00071 are unchanged and remain the only instituted grounds;

FURTHER ORDERED that the Scheduling Order in IPR2020-00071, and any modifications thereto, shall govern the schedule of the joined proceeding;

FURTHER ORDERED that all further filings in the joined proceedings are to be made in IPR2020-00071;

FURTHER ORDERED that the case caption in IPR2020-00071 for all further submissions shall be modified to add Elekta Inc. as a named Petitioner, and to indicate by footnote the joinder of IPR2020-00971 to that proceeding, as indicated in the attached sample case caption; and

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FURTHER ORDERED that a copy of this Decision shall be entered into the record in IPR2020-00971.

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Sample Case Caption

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¹ IPR2020-00971 has been joined with this proceeding.