

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE  
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

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MIM SOFTWARE INC.,  
Petitioner,

v.

PROGENICS PHARMACEUTICALS, INC.,  
Patent Owner.

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IPR2025-00630 (Patent 10,665,346 B2)  
IPR2025-00725 (Patent 11,424,035 B2)  
IPR2025-00726 (Patent 11,894,141 B2)

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Before COKE MORGAN STEWART, *Acting Under Secretary of  
Commerce for Intellectual Property and Acting Director of the United States  
Patent and Trademark Office.*

DECISION  
Referring the Petitions to the Board

IPR2025-00630 (Patent 10,665,346 B2)

IPR2025-00725 (Patent 11,424,035 B2)

IPR2025-00726 (Patent 11,894,141 B2)

Progenics Pharmaceuticals, Inc. (“Patent Owner”) filed a request for discretionary denial (Paper 7, “DD Req.”) in the above-captioned cases, and MIM Software Inc. (“Petitioner”) filed an opposition (Paper 11, “DD Opp.”).<sup>1</sup>

After considering the parties’ arguments and the record, and in view of all relevant considerations, discretionary denial of institution is not appropriate in these proceedings. This determination is based on the totality of the evidence and arguments the parties have presented.

In particular, the challenged patents have not been in force for a significant period of time (issued in 2020, 2022, and 2024, respectively). Accordingly, Patent Owner has not developed strong settled expectations that favor discretionary denial. Additionally, early challenges favor robust, predictable patent rights and weigh against discretionary denial. Furthermore, the related district court proceeding is currently stayed with respect to the challenged patents, and no trial date has been set for the portion of the trial involving patents not challenged at the Board. DD Opp. 4, 10–11; Ex. 1034. In addition, Petitioner provides persuasive reasoning, supported by evidence, that discretionary denial under 35 U.S.C. § 325(d) is not appropriate. *Id.* at 13–17; IPR2025-00725, Paper 11 at 30–33; IPR2025-00726, Paper 11 at 33–36.

Although certain arguments are highlighted above, the determination not to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petitions

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<sup>1</sup> Citations are to papers in IPR2025-00630. The parties filed similar papers in IPR2025-00725 and IPR2025-00726.

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are referred to the Board to handle the cases in the normal course, including by issuing a decision on institution addressing the merits and other non-discretionary considerations, as appropriate.

In consideration of the foregoing, it is:

ORDERED that Patent Owner's request for discretionary denial is *denied*;

FURTHER ORDERED that the Petitions are referred to the Board; and

FURTHER ORDERED that neither party shall file a request for rehearing or Director Review of this decision until the Board issues a decision on institution.

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