

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MIM SOFTWARE INC.,
Petitioner,

v.

EXINI DIAGNOSTICS AB,
Patent Owner.

IPR2025-00827
(U.S. Patent No. 11,941,817)

JOINT MOTION TO TERMINATE PROCEEDING

EXHIBIT LIST

No.	Description
Ex1001	U.S. Patent No. 11,941,817 (“the ’817 patent”)
Ex1002	Declaration of Dr. Bruce Rosen
Ex1003	Dr. Rosen Curriculum Vitae
Ex1004	Prosecution History File of the Patent (Application No. 18/127,991)
Ex1005	U.S. Patent Application Publication No. 2012/0123253 (“Renisch”)
Ex1006	U.S. Patent Application Publication No. 2011/0007954 (“Suehling”)
Ex1007	U.S. Patent No. 10,140,544 (“Zhao”)
Ex1008	U.S. Patent Application Publication No. 2018/0144828 (“Baker”)
Ex1009	Eiber, “Prostate Cancer Molecular Imaging Standardized Evaluation (PROMISE): Proposed miTNM Classification for the Interpretation of PSMA-Ligand PET/CT,” <i>The Journal of Nuclear Medicine</i> 59(3):469-478 (March 2018) (“Eiber”)
Ex1010	U.S. Patent Application Publication No. 2010/0032575 (“Iagaru”)
Ex1011	U.S. Patent Application Publication No. 2015/0287188 (“Gazit”)
Ex1012	RESERVED
Ex1013	Second Amended Complaint, <i>Progenics Pharms., Inc. v. MIM Software Inc.</i> , Case No. 1:24-cv-10437-PBS, Dkt. 25 (D. Mass. Apr. 5, 2024).
Ex1014	U.S. Patent No. 8,855,387 (“Hamadeh”)
Ex1015	Kaur, “Various Image Segmentation Techniques: A Review,” <i>International Journal of Computer Science and Mobile Computing</i> 3(5):809-814 (May 5, 2014) (“Kaur”)
Ex1016	Sharma, “Automated medical image segmentation techniques,” <i>Journal of Medical Physics</i> 35(1):3-14 (2010) (“Sharma”)
Ex1017	Greenspan, “Deep Learning in Medical Imaging: Overview and Future Promise of an Exciting New Technique,” <i>IEEE</i>

	Transactions on Medical Imaging 35(5):1153-1159 (May 2016) (“Greenspan”)
Ex1018	Litjens, “A Survey on Deep Learning in Medical Image Analysis,” <i>Medical Image Analysis</i> 42:60-88 (Dec. 2017) (“Litjens”)
Ex1019	Shen, “Deep Learning in Medical Image Analysis,” <i>Annual Review of Biomedical Engineering</i> 19:221-248 (2017) (“Shen”)
Ex1020	Gandaglia, “Distribution of metastatic sites in patients with prostate cancer: A population-based analysis,” <i>The Prostate</i> 74(2):210-216 (2014) (“Gandaglia”)
Ex1021	Declaration of Marla R. Butler in Support of Motion for Admission <i>Pro Hac Vice</i>
Ex1022	Declaration of Jesse L. Jenike-Godshalk in Support of Motion for Admission <i>Pro Hac Vice</i>
Ex1023	RESERVED
Ex1024	RESERVED
Ex1025	RESERVED
Ex1026	RESERVED
Ex1027	RESERVED
Ex1028	RESERVED
Ex1029	RESERVED
Ex1030	RESERVED
Ex1031	Defendant’s Motion to Dismiss the Second Amended Complaint, <i>Progenics Pharms., Inc. v. MIM Software Inc.</i> , Case No. 1:24-cv-10437-PBS, Dkt. 43 (D. Mass. June 17, 2024).
Ex1032	Order on Motion to Dismiss, <i>Progenics Pharms., Inc. v. MIM Software Inc.</i> , Case No. 1:24-cv-10437-PBS, Dkt. 72 (D. Mass. Jan. 14, 2025).
Ex1033	Scheduling Order, <i>Progenics Pharms., Inc. v. MIM Software Inc.</i> , Case No. 1:24-cv-10437-PBS, Dkt. 85 (D. Mass. Mar. 5, 2025).
Ex1034	Order on Motion to Stay, <i>Progenics Pharms., Inc. v. MIM</i>

	<i>Software Inc.</i> , Case No. 1:24-cv-10437-PBS, Dkt. 102 (D. Mass. May 13, 2025).
Ex1035	Transcript, Hearing on Motion to Dismiss, <i>Progenics Pharms., Inc. v. MIM Software Inc.</i> , Case No. 1:24-cv-10437-PBS (D. Mass. Oct. 8, 2024).
Ex1036	Transcript, Hearing on Motion to Stay, <i>Progenics Pharms., Inc. v. MIM Software Inc.</i> , Case No. 1:24-cv-10437-PBS (D. Mass. May 12, 2025).
Ex1037	Petitioner’s <i>Sotera</i> Stipulation, <i>MIM Software Inc. v. Progenics Pharms., Inc.</i> , IPR2025-00827, Paper 5 (PTAB Apr. 30, 2025).
Ex1038	Defendant’s Memo of Law in Support of its Motion to Stay, <i>Progenics Pharms., Inc. v. MIM Software Inc.</i> , Case No. 1:24-cv-10437-PBS, Dkt. 89 (D. Mass. Apr. 8, 2024).
Ex1039	Complaint, <i>Progenics Pharms., Inc. v. MIM Software Inc.</i> , Case No. 1:24-cv-10437-PBS, Dkt. 1 (D. Mass. Feb. 23, 2024).
Ex1040	First Amended Complaint, <i>Progenics Pharms., Inc. v. MIM Software Inc.</i> , Case No. 1:24-cv-10437-PBS, Dkt. 14 (D. Mass. Mar. 15, 2024).
Ex1041	Corporate Disclosure Statement, <i>Progenics Pharms., Inc. v. MIM Software Inc.</i> , Case No. 1:24-cv-10437-PBS, Dkt. 3 (D. Mass. Feb. 23, 2024).
Ex1042	Corporate Disclosure Statement, <i>Progenics Pharms., Inc. v. MIM Software Inc.</i> , Case No. 1:24-cv-10437-PBS, Dkt. 4 (D. Mass. Feb. 23, 2024).
Ex1043	Confidential Settlement Agreement – BUSINESS CONFIDENTIAL INFORMATION

Petitioner MIM Software Inc. (“Petitioner”) and Patent Owner EXINI Diagnostics AB (“Patent Owner”) (collectively referred to herein as “the Parties”) have reached a settlement with respect to disputes involving U.S. Patent No. 11,941,817 (the “817 patent”). Under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, the Parties jointly move to terminate the present *inter partes* review proceeding. The Parties are filing concurrently a request that the Confidential Settlement Agreement be treated as business confidential information, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The Board authorized the parties to file these Joint Motions on February 25, 2026, via email.

I. INTRODUCTION

A joint motion to terminate generally “must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26, at *2 (July 28, 2014). The enumerated information is provided herein.

The Parties respectfully submit that termination of the IPR proceeding is appropriate at this stage because the Parties have reached an agreement resolving the dispute involving the patent-at-issue in the IPR proceeding. *See* Ex1043. The Parties

have further settled and will move to dismiss the parallel litigation, *Progenics Pharmaceuticals, Inc. et al. v. MIM Software Inc.*, 1:24-cv-10437-PBS, District of Massachusetts, concerning the patent-at-issue. Finally, the other IPR proceedings, IPR2025-00630, IPR2025-00725, and IPR2025-00726, directed to other patents involved in the parallel litigation have not been instituted. The Parties do not anticipate further litigation between them concerning the '817 patent.

Under 37 C.F.R. § 42.74(b), the Confidential Settlement Agreement is in writing. A true and correct copy is being filed as Ex1043, which is the only agreement made in connection with or in contemplation of the requested termination. There are no other collateral agreements in connection with the settlement. The Confidential Settlement Agreement is being filed electronically with access to "Board and Parties Only."

II. REQUESTED RELIEF

The Parties request termination of this *inter partes* review and respectfully submit that such termination is justified. "There are strong public policy reasons to favor settlement between the parties to a proceeding." Consolidated Trial Practice Guide 86 (Nov. 2019). "The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding." *Id.* (citing 35 U.S.C. §§ 317(a)).

The Board should terminate this proceeding, as the Parties jointly request, for the following reasons:

First, the Parties have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). Under section 317(a), an inter partes review shall be terminated upon such joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions recited in 35 U.S.C. § 317(a).

Second, the Parties have reached a settlement as to all the disputes in this proceeding and as to the '817 patent. A true copy of the Confidential Settlement Agreement is being filed concurrently herewith. *See* Ex1043. This agreement contains confidential commercial and financial information of the Parties. The Parties are concurrently requesting that the Confidential Settlement Agreement be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). The parties hereby represent that the documents filed as Exhibit 1043 represent all agreements made in connection with, or in contemplation of, the termination of this proceeding. There are no other collateral agreements in connection with the settlement. This agreement has been filed with the Board as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).

Third, termination would save significant further expenditure of resources by the Parties. Termination upon settlement, as requested, would also further the purpose of *inter partes* review proceedings, which seeks to provide an efficient and less costly alternative forum for patent disputes. Further, maintaining the proceeding would discourage further settlements, as patent owners in similar situations would have a strong disincentive to settle if they perceived that an *inter partes* review would continue regardless of a settlement.

III. CONCLUSION

For the foregoing reasons, the Parties respectfully request termination of this *inter partes* review.

Dated: March 2, 2026

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), the undersigned hereby certifies that true and correct copies of the above-captioned JOINT MOTION TO TERMINATE PROCEEDING and MIM Ex1043 were served in their entirety on March 2, 2026 via electronic mail on the following counsel of record:

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