

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MIM SOFTWARE INC.,
Petitioner,

v.

EXINI DIAGNOSTICS AB, INC.,
Patent Owner.

IPR2025-00827
Patent 11,941,817 B2

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 Petition to the Board

EXINI Diagnostics AB, Inc. (“Patent Owner”) filed a request for discretionary denial (Paper 9, “DD Req.”) in the above-captioned case, and MIM Software Inc. (“Petitioner”) filed an opposition (Paper 11, “DD Opp.”).

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

In particular, the challenged patent has not been in force for a significant period of time (issued in 2024). 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 patent, and no trial date has been set for the portion of the trial involving patents not challenged at the Board. DD Opp. 2, 4–5; Ex. 1033. As a result, there is no immediate concern of inconsistent outcomes or significant duplication of efforts. In addition, Petitioner provides persuasive reasoning, supported by evidence, that discretionary denial under 35 U.S.C. § 325(d) is not appropriate. DD Opp. 21–29.

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 Petition is referred to the Board to handle the case 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:

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

FURTHER ORDERED that the Petition is 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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