

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDIVIS, INC.,
Petitioner,

v.

NOVARAD CORP.,
Patent Owner.

IPR2023-00042
Patent 11,004,271 B2

Before MIRIAM L. QUINN, *Acting Vice Chief Administrative Patent Judge*,
MICHAEL R. ZECHER and SCOTT RAEVSKY, *Administrative Patent
Judges*.

RAEVSKY, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request on Rehearing of
Final Written Decision
37 C.F.R. § 42.71(d)

I. INTRODUCTION

We issued a Final Written Decision determining no challenged claims unpatentable. Paper 35 (“Decision” or “Dec.”). Petitioner timely filed a Request for Rehearing of our Decision. Paper 36 (“Request” or “Req.”). For the reasons explained below, we *deny* Petitioner’s Request.

II. LEGAL STANDARD

The requirements of a request for rehearing are set forth in 37 C.F.R. § 42.71(d):

The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, a reply, or a sur-reply.

Thus, a request for rehearing is not an opportunity to present new arguments or evidence or merely to disagree with the panel’s assessment of the arguments or weighing of the evidence. With this in mind, we address the arguments presented in turn.

III. ANALYSIS

The Request challenges our Decision’s finding that Petitioner failed to establish public accessibility of the references Chen, 3D Visualization,¹ and 3D Slicer. Req. 1. The Petition challenged claims 1–6 and 11–20 as

¹ The Request refers to this reference with different name variations: “3D-Slicer-Visualization,” “3D Slicer-Visualization,” and “3D Visualization.” Req. 1, n.2, 7. For consistency with the Petition, we refer to it solely as “3D Visualization.” *See* Pet. 31, 54–69.

allegedly being obvious over the combination of Chen, 3D Visualization, and 3D Slicer. Pet. 31, 54–69. Because our Decision determined that Petitioner did not prove public accessibility of these references, our Decision concluded that Petitioner did not prove unpatentability of these claims over the combination of these references. Dec. 25–31.²

In our Decision, we faulted the Petition for not presenting evidence of public accessibility. *Id.* at 26 (citing Pet. 29–30). We also found the Reply’s conclusory arguments unavailing. *Id.* (citing Reply 27–28). For example, for the Chen reference, we found the Reply’s reliance on a copyright date, statements on the face of Chen, and mere assertion that Chen was cited by seven publications as insufficient to establish public accessibility. *Id.* at 27–28. We found Petitioner’s arguments for the public accessibility of 3D Visualization and 3D Slicer “similarly terse and unpersuasive.” *Id.* at 29–30. Further, we found Petitioner’s citation to two supporting declarations to be improper incorporations by reference and therefore not entitled to consideration. *Id.* at 28–30.

Petitioner argues that we overlooked or misapprehended arguments and evidence addressing public accessibility in both the Petition and Reply. Petitioner also alleges that we overlooked certain other documents. We address these arguments in turn.

A. Petition

Petitioner first argues that the Decision “wrongly found that the Petition offers ‘no proof’ that any of these references were publicly

² Petitioner does not request rehearing of our determination that Petitioner failed to prove anticipation of claims 1, 5, and 6 by Doo or our determination that Petitioner failed to prove obviousness of claims 1–6 and 11–20 over the combination of Doo and Amira. *See* Dec. 8–25, 33–34.

accessible.” Req. 4. For instance, Petitioner argues that pages 29–30 of the Petition present evidence recognized by our precedential *Hulu* decision as supporting a printed publication, namely “a copyright date, a publication date, and an established publisher of a series of a similar type of references.” *Id.* (citing *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 19–20 (PTAB Dec. 20, 2019) (precedential)). We disagree. Petitioner’s argument overstates the evidence submitted with the Petition and misapplies our precedential *Hulu* decision.

On pages 29–30 of the Petition, Petitioner cites no evidence for public accessibility, except the references Chen, 3D Visualization, and 3D Slicer themselves. This is insufficient and tantamount to submitting no proof of public accessibility. To find public accessibility, we must determine that a “document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art[,] exercising reasonable diligence, can locate it.” *SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008), *quoted in* Dec. 26–27. Petitioner has insufficiently explained, by a preponderance of the evidence, how Chen, 3D Visualization, and 3D Slicer themselves answer the question of whether they have been disseminated or otherwise made available to those of ordinary skill in the art. Thus, we did not overlook or misapprehend any evidence of public accessibility on pages 29–30 of the Petition.

Petitioner’s argument regarding *Hulu* is also unpersuasive. There, a reference bearing a copyright date, a printing date, and an ISBN date, as well as an indication that it was from an established publisher and “well-known book series,” supported a finding of a *reasonable likelihood* that the reference was a printed publication. *Hulu*, Paper 29 at 19–20. In other words, *Hulu* considered whether a petitioner had met its institution burden

for public accessibility, not whether the petitioner had proven that the reference was publicly accessible at the final decision stage. *Id.* As we explained in our decision, however, at the final decision stage, Petitioner must establish public accessibility by a preponderance of the evidence. *See* Dec. 26. The *Hulu* panel itself confirmed in its final decision that a petitioner must prove public accessibility at that stage by a preponderance of the evidence. *Hulu*, Paper 66 at 22 (“The standard of proof to *institute* a trial is ‘that there is a reasonable likelihood that the petitioner would prevail’ (35 U.S.C. § 314(a)) while the standard of proof for a final decision is whether the Petitioner has met ‘the burden of proving a proposition of unpatentability by a preponderance of the evidence’ (35 U.S.C. § 316(e)).”). Thus, we cannot have overlooked or misapprehended our precedential *Hulu* decision because it addresses a lesser required showing of public accessibility at the institution stage.

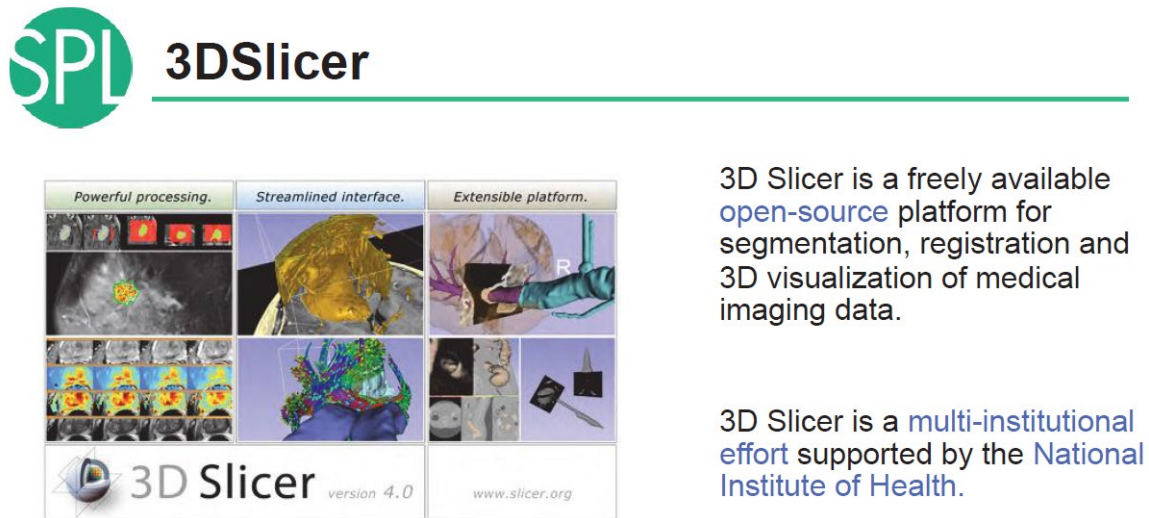
Petitioner also points to other statements in the Petition that we allegedly overlooked. Req. 5–6 (citing Pet. 16–19, 54–55). According to Petitioner, these statements reference Dr. Kazanzides’s testimony that 3D Slicer was a printed publication. *Id.* (citing Ex. 1012 ¶¶ 41–43, 106). Petitioner contends, for example, that 3D Slicer software was available “by 2014” and that the website “www.slicer.org” about this software was a known source of information. *Id.* at 5 (citing Pet. 16–17, 54; Ex. 1012 ¶ 41; Ex. 1007, slides 6–7). Petitioner further argues that, “[b]ased on his knowledge and experience as an expert qualified as a POSA [person of ordinary skill in the art], [Dr.] Kazanzides testified that ‘[a] POSA would have been familiar with the 3D Slicer application and its ability to load and display data for a user.’” *Id.* (citing Pet. 16–17; Ex. 1012 ¶ 41). Petitioner also references Dr. Kazanzides’s testimony regarding example data

published by Surgical Planning Laboratory, presumably using 3D Slicer software. *Id.* (citing Ex. 1012 ¶¶ 42–43). Finally, Petitioner asserts that Dr. Kazanzides testified that by 2016, 3D Slicer software “included published documentation of the Main Application Graphical User Interface (GUI).” *Id.* at 6 (citing Pet. 55; Ex. 1012 ¶ 106). Thus, Petitioner concludes, we “overlooked or misapprehended [Dr.] Kazanzides’s original testimony cited in the Petition as to the public accessibility of non-patent references related to 3D Slicer.” *Id.* at 6.

We disagree that we overlooked or misapprehended these arguments and testimony. Although our Decision does not discuss them, none of these arguments or testimony supports a finding of public accessibility. Petitioner’s argument boils down to this—3D Slicer software was publicly known, so its documentation, the 3D Slicer reference, must also have been publicly accessible. This conclusion does not follow. Petitioner needed to show that 3D Slicer itself, the reference, was “disseminated or otherwise made available.” *SRI*, 511 F.3d at 1194. At best, Petitioner presented evidence that 3D Slicer *software* may have been available and then asks us to infer that the software’s documentation, 3D Slicer, must also have been publicly accessible. This leap we cannot make without supporting evidence. For example, unlike a recent case where an operating manual for a food slicer machine was publicly accessible because evidence showed that it was disseminated, Petitioner presents no evidence that 3D Slicer was disseminated along with the 3D Slicer software. *See Weber, Inc. v. Provisur Techs., Inc.*, 92 F.4th 1059, 1068 (Fed. Cir. 2024) (finding, based on employee testimony, that users obtained the operating manual upon purchase of the food slicer or upon request, and that this testimony was corroborated by additional testimony and documentary evidence).

Dr. Kazanzides’s testimony on this point insufficiently supports the inference Petitioner wants us to draw. Dr. Kazanzides testifies that 3D Slicer was publicly accessible by relying on 3D Visualization and Chen. *See* Ex. 1012 ¶¶ 41–43 (citing Ex. 1007, relying on 3D Visualization), 106 (citing Ex. 1010, relying on Chen). Setting aside that Petitioner did not establish the public accessibility of 3D Visualization and Chen, this testimony is still deficient. Dr. Kazanzides refers to several slides from 3D Visualization, but these slides discuss only 3D Slicer the *software*, not the *reference* relied upon by Petitioner. *E.g.*, Ex. 1012 ¶¶ 41–43 (citing Ex. 1007, slides 6–7, 39, 42).

For example, slide 6 of 3D Visualization is reproduced below:



Ex. 1007, slide 6. This slide explains that “3D Slicer is a freely available open-source platform” and includes an image that states, “3D Slicer version 4.0.” *Id.* This slide does not support public accessibility because, again, the existence of 3D Slicer software does not prove the public accessibility of alleged documentation about that software.

Dr. Kazanzides's reliance on Chen to prove public accessibility of 3D Slicer is similarly unavailing. Dr. Kazanzides testified that because Chen mentions 3D Slicer software, 3D Slicer itself must be prior art:

In my opinion, Chen expressly suggests combination of the systems and methods disclosed therein with the “well-known, free and open-sourced package named 3D Slicer (<http://www.slicer.org/>) for visualization and medical image computing.” Ex. 1009, Chen, 131/1:29-41. . . . By 2016, the 3D Slicer software included published documentation of the Main Application Graphical User Interface (GUI). See Ex. 1010 [3D Slicer]. I understand that 3D Slicer is prior art because its publication date predates the assumed March 10, 2017 relevant date.

Ex. 1012 ¶ 106. Like 3D Visualization, Chen mentions the 3D Slicer software and does not refer to 3D Slicer, the reference. Also, Dr. Kazanzides's statement that, “[b]y 2016, the 3D Slicer software included published documentation” is not supported by any evidence apart from 3D Slicer itself, so this statement is entitled to little weight. 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”). Thus, Dr. Kazanzides's unsupported conclusion that “3D Slicer is prior art because its publication date predates the assumed March 10, 2017 relevant date” is also entitled to little weight.

Accordingly, Petitioner does not persuade us that we overlooked or misapprehended arguments or testimony submitted with the Petition regarding 3D Slicer.

Returning to the Chen reference, Petitioner argues that, in light of *Hulu*, we overlooked or misapprehended that certain information on the face of Chen (such as a statement that Chen was “[a]vailable online 13 April 2015”). Req. 6. Petitioner also faults our Decision for ignoring its argument

that Chen “was published in volume 55 of the JOURNAL OF BIOMEDICAL INFORMATICS.” *Id.* (citing Pet. 29–30). Petitioner asserts that our Decision “directly contradicts *Hulu*’s explanation that ‘the indicia on the face of a reference, such as printed dates and stamps, are considered part of the totality of the evidence.’” *Id.* (citing *Hulu*, Paper 29 at 17–18). This argument is unpersuasive because Petitioner again conflates *Hulu*’s analysis based on the lower reasonable likelihood standard with Petitioner’s burden at the final decision to prove a proposition by a preponderance of the evidence. *See Hulu*, Paper 29 at 18.

Yet, even if we were to determine that Petitioner had proven Chen’s public accessibility based on the indicia on the face of Chen (i.e., printed date and established publisher), this still would have been insufficient to grant rehearing. 3D Visualization and 3D Slicer do not have similar facial indicia and, for reasons we explain herein, are not shown to be publicly accessible. Since Petitioner’s challenges based on Chen also rely on 3D Visualization and 3D Slicer, the alleged public accessibility of Chen alone is insufficient to grant rehearing. *See* Pet. 31, 54–69 (e.g., relying on 3D Visualization to disclose the “confined” limitation of independent claim 1 (*id.* at 59) and various limitations of independent claim 11 (*id.* at 65–68)).

B. Reply

Petitioner next argues that we “overlooked or misapprehended most of the relevant evidence presented in the Reply.” Req. 7. We first address Petitioner’s footnote at the beginning of this argument:

The Board expressed its willingness to consider **uncited exhibits, filed without explanation**, for [Patent Owner]’s benefit. Order, Paper 23 (Dec. 11, 2023), 4 (“At a minimum, we are able to assess the qualifications of [Patent Owner]’s declarants based on their [uncited] curricula vitae.”)). It would

be arbitrary and capricious for the Board to not be at least as willing to review **cited** exhibits of similar length for [Petitioner]'s benefit.

Id. at 7, n.7. Here, Petitioner refers obliquely to our Decision's finding that Petitioner's wholesale citation of two declarations (Exs. 1021, 1028), without discussion, constituted improper incorporations by reference. Dec. 28–30. Petitioner's footnote does not adequately explain how our decision not to permit these improper incorporations by reference somehow overlooked or misapprehended anything. Petitioner does not, for instance, assert that the Reply's citation to, yet total absence of any discussion of, these declarations was not an improper incorporation by reference. Instead, Petitioner conflates its incorporation by reference with our reliance on Patent Owner's curriculum vitae exhibit. But our rules prohibit parties' incorporation of arguments by reference, not the Board's consideration of curricula vitae. *See* 37 C.F.R. § 42.6(a)(3) ("Arguments must not be incorporated by reference from one document into another document."), *cited in* Dec. 28. And Petitioner makes no colorable argument that Patent Owner incorporated arguments from the curriculum vitae by reference.

Petitioner's related assertions that "the Board overlooked [Dr.] Kazanzides's cited [Reply] testimony" and that we found this testimony "somehow unduly burdensome" miss the mark. Req. 7. As we explained in our Decision, "incorporation 'by reference amounts to a self-help increase in the length of the . . . brief.'" Dec. 28–29 (quoting *DeSilva v. DiLeonardi*, 181 F.3d 865, 866–67 (7th Cir. 1999)). This is not an issue of us finding Petitioner's declaration testimony "somehow unduly burdensome"; it is an issue of Petitioner relying on declaration testimony to expand its word count beyond the word count limit, to the prejudice of Patent Owner. Our

reviewing court has explained that “incorporating argument by reference ‘cannot be used to exceed word count’” because “[i]t is ‘fundamentally unfair to allow a party to use incorporation to exceed word count.’”

Promptu Sys. Corp. v. Comcast Cable Comm’s, LLC, 92 F.4th 1384, 1385 (Fed. Cir. 2024) (quoting *Microsoft Corp. v. DataTern, Inc.*, 755 F.3d 899, 910 (Fed. Cir. 2014)).

Although Petitioner improperly incorporated Dr. Kazanzides’s reply declaration by reference, we exercised our discretion to address a portion of it in our Decision. Dec. 30–31. We did so because we noted that his testimony was “particularly deficient for [the 3D Slicer] reference.” *Id.* at 30. Petitioner now asserts that in doing so, we “misapprehended or overlooked the logic that application documentation” like 3D Slicer’s “must be accessible to potential application users because it serves to help users use the application.” Req. 7. But Petitioner’s assertion that “application documentation must be accessible to potential application users because it serves to help users use the application” is a new argument, not raised in the Petition or Reply. Even if Petitioner’s assertion were correct, it falls far short of the evidence required to prove that 3D Slicer was actually disseminated to interested members of the public. *See, e.g., Weber*, 92 F.4th at 1068. Thus, Petitioner’s argument fails to persuade us that we overlooked or misapprehended anything.

Regarding 3D Visualization, Petitioner asserts that, despite *Hulu*, our Decision found “that the fact that 3D Slicer’s Director of Training had presented similar tutorials at 22 conferences to more than 2700 people . . . does not support the public accessibility of [3D Visualization].” *Id.* at 8 (citing Dec. 29; Ex. 1007, *passim*; Ex. 1021 ¶¶ 11–23). What Petitioner argued in the Reply was merely that 3D Visualization is “a tutorial by 3D

Slicer’s Director of Training, *like* previous trainings given at 22 conferences to more than 2700 people.” Reply at 27–28 (emphasis added). We explained in our Decision that “Petitioner’s assertion that 3D Visualization is ‘*like* previous trainings’ given at conferences does not assert that 3D Visualization *itself* was presented at any conferences before any skilled artisans,” and thus, “this bare assertion does not support public accessibility.” Dec. 29. Petitioner provides no persuasive reason to disturb our finding that Petitioner presented no evidence that 3D Visualization itself was presented at any conference before any skilled artisans.

C. Other Documents

Finally, Petitioner argues that we overlooked or misapprehended certain other documents.

Petitioner argues that we overlooked the Price Declaration (Ex. 1023), which allegedly addresses the public accessibility of 3D Visualization.³ Req. 8. Petitioner asserts that we also overlooked Patent Owner’s “adoption of the Price Declaration as its own evidence of the state of the art at the relevant time.” *Id.* (citing Sur-reply 20–21). In particular, Petitioner notes that Patent Owner filed a copy of the Price Declaration as its own exhibit, which we later expunged as duplicative. *Id.* (citing Ex. 2023). “By adopting the Price Declaration as its own evidence of the state of the art, [Patent Owner] waived the right to challenge the Price Declaration and added to the

³ Petitioner also contends that the Price Declaration addresses the public accessibility of Amira (Ex. 1005). Req. 8. Whether Amira is publicly accessible is irrelevant because in our Decision, we found (and Petitioner does not challenge on rehearing) that Petitioner failed to articulate a persuasive rationale to combine Amira with Doo. Dec. 25.

record evidence of the public accessibility of [3D Visualization],” Petitioner asserts. *Id.* at 9.

We disagree with Petitioner’s characterization of Patent Owner’s citation of Exhibit 1023 and refileing of this exhibit. Patent Owner only discusses the Price Declaration in the context of Amira, not 3D Visualization. Sur-reply 20–21. Whatever tenuous connection Patent Owner’s citation and refileing of the Price Declaration may have had to public accessibility of 3D Visualization, Petitioner does not clearly illuminate.

Relatedly, Petitioner argues that it cannot be faulted for not discussing the Price Declaration because we denied Petitioner’s request for additional briefing after Patent Owner filed its Sur-reply. Req. 9. This argument has no merit. Petitioner submitted the Price Declaration with its Reply. *See* Reply v (listing Exhibit 1023 in the Exhibit List). Petitioner’s decision not to address the Price Declaration in the Reply means that it is too late to address it now. Moreover, in our brief review of this lengthy exhibit spanning several hundred pages, we also do not see any discussion of the alleged public accessibility of 3D Visualization. So the Price Declaration also does not appear to support Petitioner’s rehearing request.

Petitioner also asserts that we “overlooked undisputed facts in [Petitioner’s] Motion to Exclude [Mot.]” Req. 9. In particular, Petitioner asserts that Patent Owner’s “expert admitted that multiple research groups commonly used 3D Slicer technology before the relevant time.” *Id.* at 10 (citing Mot. 6–7 (“[Dr.] Mulumudi agreed that the underlying technology was commonly used by multiple research groups before the relevant time”). In addition to this alleged admission, Petitioner would have us draw an “inference that groups commonly using 3D Slicer technology before the

relevant time must have had some way to understand the 3D Slicer technology and to learn how to use it.” *Id.* We decline to do so for reasons we explain above. Further, Petitioner did not make this argument in its briefing or at the oral hearing, so it is a new argument that we could not have overlooked or misapprehended because it was presented for the first time in Petitioner’s rehearing request. It is also unpersuasive because, even if we take as true Dr. Mulumudi’s alleged admission that 3D Slicer technology was commonly used, it still does not prove that the reference submitted by Petitioner as prior art here (e.g., the 3D Slicer reference) was publicly accessible.

IV. CONCLUSION

For the forgoing reasons, Petitioner has not shown that we misapprehended or overlooked any arguments or evidence presented in the Petition, Reply or other documents. Accordingly, we deny the Request for Rehearing.

V. ORDER

It is, therefore:

ORDERED that Petitioner’s request for rehearing is *denied*.

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