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11
12 UNITED STATES DISTRICT COURT
13 NORTHERN DISTRICT OF CALIFORNIA
14 SAN JOSE DIVISION

15 UNIVERSITY OF BRITISH COLUMBIA,
16 Plaintiff/Counterclaim-
17 Defendant,
18 v.
19 CAPTION HEALTH, INC.; GE
HEALTHCARE TECHNOLOGIES INC.,
20 Defendant/Counterclaim-
21 Plaintiff.

Case No. 5:24-cv-03200-EKL

**DECLARATION OF DORIANNE
SALMON IN SUPPORT OF UBC'S
OPPOSITION TO DEFENDANTS'
MOTION TO STAY PENDING INTER
PARTES REVIEW**

22
23 I, Dorianne Salmon, hereby declare as follows:

24 1. I am an attorney at Perkins Coie LLP, counsel of record for Plaintiff University of
25 British Columbia ("UBC") in the above referenced action. I am submitting this declaration in
26 support of UBC's Opposition to Defendants' Caption Health, Inc. ("Caption Health") and GE
27 HealthCare Technologies Inc. ("GE HealthCare") (collectively, "Defendants") Motion to Stay

1 Pending *Inter Partes* Review (Dkt. No. 72). I make this declaration based on my personal
2 knowledge of the facts set forth herein, unless otherwise indicated.

3 2. UBC filed its original Complaint in this case on May 28, 2024, asserting U.S. Patent
4 No. 11,129,591 (the “’591 Patent”). On December 20, 2024, UBC amended its Complaint (Dkt.
5 No. 46) to add a claim of infringement for another patent – U.S. Patent No. 10,751,029 (the “’029
6 Patent”). My understanding is that Defendants have only filed an IPR on the ’591 Patent. No
7 petition for IPR has been filed on the ’029 Patent.

8 3. On February 28, 2025, the United States Patent and Trademark Office (USPTO)
9 rescinded its June 21, 2022 “Interim Guidance” on factors to be considered for “discretionary
10 denials.” Attached hereto as Exhibit A is a copy of the Board’s Guidance on USPTO’s Recission
11 of Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel
12 District Court Litigation, dated March 24, 2025, available at
13 [https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_reci](https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf)
14 [ssion_20250324.pdf](https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf). On March 26, 2025, the USPTO issued a memorandum with new guidelines
15 “due, in part, to the current workload needs of the PTAB.” Attached hereto as Exhibit B is a copy
16 of the Memorandum re Interim Processes for PTAB Workload Management, dated March 26, 2025,
17 available at [https://www.jonesday-](https://www.jonesday-ecommunications.com/292/10836/downloads/interimprocesses-ptabworkloadmgmt-20250326.pdf)
18 [ecommunications.com/292/10836/downloads/interimprocesses-ptabworkloadmgmt-](https://www.jonesday-ecommunications.com/292/10836/downloads/interimprocesses-ptabworkloadmgmt-20250326.pdf)
19 [20250326.pdf](https://www.jonesday-ecommunications.com/292/10836/downloads/interimprocesses-ptabworkloadmgmt-20250326.pdf). There have been published reports that the institution rates will drop going forward

20 because of an anticipated shortage of administrative judges at the PTAB. More specifically, there
21 are reports that there will be resignations and/or layoffs at the PTAB. *See, e.g.*, Exhibit C, attached
22 hereto is a copy of the Law360 webpage PTAB Judges Told to Get Ready for Layoffs, available at
23 <https://www.law360.com/articles/2314328>. Apparently in anticipation of these layoffs and
24 shortages, the PTAB will likely be issuing more “discretionary denials” of IPRs. Specifically,
25 “Discretionary denials” refers to IPR denials for reasons other than the merits, including denials
26 based on pending district court litigation involving the same patent. Many commentators have
27 published articles expressing their opinion that the new rules will lead to a higher institution denial

1 rate. *See, e.g.*, Exhibit D, attached hereto is a copy of the ipfray webpage “Discretionary denials of
2 PTAB inter partes reviews come back with a vengeance: Fintiv review inserted before potential
3 merits proceedings,” available at [https://ipfray.com/discretionary-denials-of-ptab-inter-parties-](https://ipfray.com/discretionary-denials-of-ptab-inter-parties-reviews-come-back-with-a-vengeance-fintiv-review-inserted-before-potential-merits-proceedings/)
4 [reviews-come-back-with-a-vengeance-fintiv-review-inserted-before-potential-merits-](https://ipfray.com/discretionary-denials-of-ptab-inter-parties-reviews-come-back-with-a-vengeance-fintiv-review-inserted-before-potential-merits-proceedings/)
5 [proceedings/](https://ipfray.com/discretionary-denials-of-ptab-inter-parties-reviews-come-back-with-a-vengeance-fintiv-review-inserted-before-potential-merits-proceedings/) (opining that the changes are a “clear indication that discretionary denials will go up
6 substantially”); *see also*, attached hereto as Exhibit E is a copy of the JD Supra webpage “A New
7 Era for the PTAB: Discretion Returns, Layoffs Loom, and Early Challenges Encourages,” available
8 at <https://www.jdsupra.com/legalnews/a-new-era-for-the-ptab-discretion-3485941/>. They have
9 also opined that delay in filing an IPR will be a more significant factor in denying institution.

10 4. Published statistics indicate that about 68% of IPR petitions were instituted in 2024,
11 but only 14% of patents with proceedings ending in 2024 were fully invalidated. Attached hereto
12 as Exhibit F is a copy of the PTAB Trial Statistics FY24 End of Year Outcome Roundup IPR, PGR,
13 Fiscal Year 2024, available at
14 https://www.uspto.gov/sites/default/files/documents/ptab_aia_fy2024_roundup.pdf.

15 5. In addition to document production, UBC has retained two experts on the issues of
16 source code discovery and damages. UBC conducted a review of Defendants’ source code at
17 Thompson Hine LLP’s Cleveland, Ohio office on January 27-28, 2025. Further, both parties have
18 served multiple supplements to their responses to interrogatories and requests for production.

19 6. Attached hereto as Exhibit G is a copy of the Order in *Asetek Danmark A/S v. Coolit*
20 *Sys., Inc.*, No. 19-cv-00410-EMC, Dkt. No. 380 (N.D. Cal. Feb. 10, 2020), cited in UBC’s
21 opposition, which does not appear to be published on Westlaw.

22 7. On December 6, 2024, Defendants served their invalidity contentions for the ’591
23 patent, including a single, 49-page claim chart alleging invalidity of claims 1-20 in view of four
24 prior art references: U.S. Patent Application Publication No. 2005/0251013 (“Krishnan”),
25 International Patent Application Publication WO2016/189313 (“Paterson”), U.S. Patent
26 Application Publication No. 2016/0247034 (“Lee”), and U.S. Patent Application Publication No.
27 2017/0262982 (“Pagoulatos”). On May 28, 2025, Defendants filed IPR2025-01066 on U.S. Patent

1 No. 11,129,591, proposing grounds for invalidity based on three of the four previously identified
2 prior art references (Krishnan, Lee, and Pagoulatos) as well as a new reference *Automatic Fetal*
3 *Ultrasound Standard Plane Detection Using Knowledge Transferred Recurrent Neural Networks*
4 (“Chen”).

5 8. The UBC inventors performed the design, development, and integration tasks
6 required to reduce the '591 invention to practice. This includes developing prototypes of the neural
7 network architecture. Attached hereto as Exhibit H is a copy of UBC's Mar 7, 2025 1st
8 Supplemental Responses to Defendants' 1st Set of Rogs (Nos 1-3).

9
10 I declare under penalty of perjury that the foregoing statements are true and correct to the
11 best of my knowledge.

12 Dated and signed this 11th day of July, 2025, in Seattle, Washington.

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14 By: /s/ Dorianne Salmon
Dorianne Salmon

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