

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

CAPTION HEALTH, INC.,
Petitioner,

v.

UNIVERSITY OF BRITISH COLUMBIA,
Patent Owner.

IPR2025-01066
Patent 11,129,591 B2

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

DECISION
Referring the Petition to the Board

University of British Columbia (“Patent Owner”) filed a request for discretionary denial (Paper 7, “DD Req.”) in the above-captioned case, and Caption Health, Inc. (“Petitioner”) filed an opposition (Paper 12, “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.

Although the parties are engaged in a parallel proceeding involving the challenged patent, it is unclear whether a final written decision in this proceeding will issue after the district court trial occurs. In particular, the projected final written decision due date in this proceeding is December 24, 2026. DD Req. 22. There is no trial date scheduled in the co-pending district court litigation, and the parties offer different time-to-trial statistics that suggest trial could begin between December 2026 and January 2027. DD Req. 22; DD Opp. 24. As such, these considerations neither favor nor counsel against discretionary denial.

Some considerations, however, counsel against discretionary denial. In particular, the challenged patent has not been in force for a significant period of time (issued in 2021), and, accordingly, Patent Owner has not developed strong settled expectations that favor discretionary denial. DD Opp. 38. Early challenges favor robust, predictable patent rights and weigh against discretionary denial. Additionally, Patent Owner’s arguments that discretionary denial is warranted under 35 U.S.C. § 325(d) are not persuasive.

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:

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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