

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAPTION HEALTH, INC.,

Petitioner,

v.

UNIVERSITY OF BRITISH COLUMBIA,

Patent Owner.

IPR2025-01422

Patent No. 10,751,029

**PATENT OWNER'S SUPPLEMENTAL BRIEF
FOR DISCRETIONARY DENIAL**

EXHIBIT LIST

Exhibit	Description
2001	Complaint for Patent Infringement, <i>Univ. of British Columbia v. Caption Health, Inc.</i> , No. 5:24-cv-03200-EKL (N.D. Cal. May 28, 2024), ECF No. 1
2002	Decision Referring the Petition to the Board, <i>Caption Health, Inc. v. Univ. of British Columbia</i> , IPR2025-01066, Paper 13 (Oct. 10, 2025)
2003	GE HealthCare Techs. Inc. Corporate Structure Tree (July 24, 2025)
2004	GE HealthCare Techs. Inc. Corporate Family Report (July 24, 2025)
2005	Non-Final Rejection, App. No. 16/146770 (June 2, 2020)
2006	Non-Final Rejection, App. No. 17/558271 (June 4, 2024)
2007	Ex. C to Joint Amended and Supplemented Claim Construction and Prehearing Statement, <i>Univ. of British Columbia v. Caption Health, Inc.</i> , No. 24-cv-03200 (N.D. Cal. Oct. 10, 2025), ECF No. 87-3
2008	Defendants' Notice of Motion and Motion to Stay Case Pending <i>Inter Partes</i> Review, <i>Univ. of British Columbia v. Caption Health, Inc.</i> , No. 24-cv-03200 (N.D. Cal. June 27, 2025), ECF No. 72
2009	Order Denying Motion to Stay and Granting Motion to Seal, <i>Univ. of British Columbia v. Caption Health, Inc.</i> No. 24-cv-03200, (N.D. Cal. Aug. 6, 2025)
2010	Order Setting Initial Case Management Conference & ADR Deadlines, <i>Univ. of British Columbia v. Caption Health, Inc.</i> , No. 24-cv-03200 (N.D. Cal. May 31, 2024), ECF No. 9

Exhibit	Description
2011	Defendants' First Amended Invalidity Contentions, <i>Univ. of British Columbia v. Caption Health, Inc.</i> , No. 3:24-cv-03200 (N.D. Cal. Aug. 22, 2025)
2012	Decl. of Dorianne Salmon in Support of UBC's Opp. to Defendants' Motion to Stay Pending <i>Inter Partes</i> Review, <i>Univ. of British Columbia v. Caption Health, Inc.</i> , No. 24-cv-03200 (N.D. Cal. July 11, 2025), ECF No. 77-1
2013	Appendix A to Defendants' First Amended Invalidity Contentions, dated August 22, 2025
2014	Exhibit E to Infringement Contentions
2015	UBC's Objections and Responses to Defendants' Second Set of Requests for Production of Documents and Things (Nos. 64-113), <i>Univ. of British Columbia v. Caption Health, Inc.</i> , No. 24-cv-03200 (N.D. Cal. Apr. 21, 2025)
2016	Defendant GE Healthcare's Responses to UBC's Third Set of Requests for Production to Defendant GE Healthcare (Nos. 55-86), <i>Univ. of British Columbia v. Caption Health, Inc.</i> , No. 24-cv-03200 (N.D. Cal. May 27, 2025)
2017	Defendant Caption Health's Responses to UBC's Third Set of Requests for Production to Defendant Caption Health (Nos. 30-54), <i>Univ. of British Columbia v. Caption Health, Inc.</i> , No. 24-cv-03200 (N.D. Cal. May 27, 2025)
2018	Joint Statement regarding Discovery Dispute Over Plaintiff's Amended Infringement Contentions, <i>Univ. of British Columbia v. Caption Health, Inc.</i> , No. 24-cv-03200 (N.D. Cal. Mar. 19, 2025), ECF No. 58
2019	Administrative Motion Regarding Case Schedule and Motion to Stay, <i>Univ. of British Columbia v. Caption Health, Inc.</i> , No. 24-cv-03200 (N.D. Cal. July 3, 2025), ECF No. 75
2020	Plaintiff UBC's Motion for Leave to Amend Infringement Contentions regarding US Patent Nos. 11,129,591 and

Exhibit	Description
	10,751,029, <i>Univ. of British Columbia v. Caption Health, Inc.</i> , No. 24-cv-03200 (N.D. Cal. May 9, 2025), ECF No. 65
2021	Order Granting Plaintiff's Motion for Leave to Amend Infringement Contentions, <i>Univ. of British Columbia v. Caption Health, Inc.</i> , No. 24-cv-03200 (N.D. Cal. July 2, 2025), ECF No. 74
2022	Civil Minutes, <i>Univ. of British Columbia v. Caption Health, Inc.</i> , No. 24-cv-03200 (N.D. Cal. Aug. 6, 2025), ECF No. 81
2023	UBC's list of claim terms, dated April 11, 2025
2024	Defendants' Amended and Supplemented Proposed Claim Terms from U.S. Patent No. 11,129,591 for Construction Pursuant to L.R. 4-1, <i>Univ. of British Columbia v. Caption Health, Inc.</i> , No. 24-cv-03200 (N.D. Cal. Apr. 11, 2025)
2025	Joint Claim Construction and Prehearing Statement Pursuant to Pat. L.R. 4-3, <i>Univ. of British Columbia v. Caption Health, Inc.</i> , No. 24-cv-03200 (N.D. Cal. May 30, 2025), ECF No. 68
2026	Scheduling Order, <i>Univ. of British Columbia v. Caption Health, Inc.</i> , No. 24-cv-03200 (N.D. Cal. Aug. 13, 2025), ECF No. 82
2027	UBC's Additional Proposed Terms for Construction, dated Sept. 5, 2025
2028	Defendants' Additional Proposed Terms for Construction, <i>Univ. of British Columbia v. Caption Health, Inc.</i> , No. 24-cv-03200 (N.D. Cal. Sept. 5, 2025)
2029	UBC's Supplemental Preliminary Claim Constructions, dated Sept. 19, 2025
2030	Defendants' Supplemental Preliminary Claim Constructions Pursuant to L.R. 4-2, <i>Univ. of British Columbia v. Caption Health, Inc.</i> , No. 24-cv-03200 (N.D. Cal. Sept. 19, 2025)

Exhibit	Description
2031	Amended Supplemental Joint Claim Construction and Prehearing Statement Pursuant to Patent Local Rule 4-3, <i>Univ. of British Columbia v. Caption Health, Inc.</i> , No. 24-cv-03200 (N.D. Cal. Oct. 10, 2025), ECF No. 87
2032	U.S. Pub. No. US2019/0266716 (“Rothberg”)
2033	U.S. Pub. No. US2009/0088640 (“Park”)
2034	’029 Patent Grants Spreadsheet
2035	Krizhevsky, Sutskever, and Hinton, <i>ImageNet classification with deep convolutional neural networks</i> (“AlexNet”) (2012)
2036	Zhang, Lipton, Li, and Smola, <i>Dive into Deep Learning</i> , Chapter 8.1 Deep Convolution Neural Networks (AlexNet), https://d2l.ai/chapter_convolutional-modern/alexnet.html
2037	Ghada Zamzmi, et al., <i>Harnessing Machine Intelligence in Automatic Echocardiogram Analysis: Current Status, Limitations, and Future Directions</i> (Apr. 27, 2021)
2038	Geoffrey Hinton, The Nobel Prize, https://www.nobelprize.org/prizes/physics/2024/hinton/facts/
2039	Press release, The Nobel Prize (Oct. 8, 2024), https://www.nobelprize.org/prizes/physics/2024/press-release/
2040	U.S. Patent No. 10,878,311
2041	App. No. 16/146,770 Non-Final Rejection dated June 2, 2020
2042	U.S. Patent No. 12,369,883
2043	App. No. 18/431,566 Non-Final Rejection dated May 10, 2024
2044	Japanese Patent No. 7,284,298
2045	Japanese Patent App. No. 2021 to 572915 Notice of Reasons for Refusal dated Nov. 24, 2022 (English translation)

Exhibit	Description
2046	November 25, 2025 Email from Tina Williams
2047	Plaintiff UBC's Opening Claim Construction Brief, Redacted Version (Dkt. 92)
2048	Defendants' Claim Construction Brief (Dkt. 94)

I. INTRODUCTION

After the Request for Discretionary Denial (Paper 9), the Director issued the precedential decision in *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20, 3-4 (Nov. 3, 2025), in which the Director held “when a petitioner takes alternative positions before the Board and a district court, that petitioner should, at a minimum, explain why alternative positions are warranted.”

Here, after Patent Owner raised the Petitioner’s inconsistent claim construction positions (no construction provided at all in its IPR petition and a narrow construction provided in district court), the Director provided Petitioner with an opportunity to explain them. EX2046. Instead of doing so, Petitioner attempts to (1) distinguish *Revvo* by limiting it to its precise facts, (2) justify its failure to offer any construction at all in IPR, while at the same time offering a narrow construction in district court for the admitted purpose of avoiding infringement liability, and (3) belatedly consent to its district court construction in this IPR. *See* Paper 12 (“Supp. Discr. Opp.”). For the reasons discussed below, Petitioner’s arguments should be rejected, and this IPR should be discretionarily denied.¹

¹ Patent Owner has requested additional briefing to address the same issue in IPR2025-01066 (involving the same parties and a related patent), which was previously referred to a merits panel; the panel has not yet responded to that request.

II. DISCUSSION

A. The Director Has Not Limited Application of *Revvo* to Its Facts.

First, Petitioner attempts to justify its differing claim construction positions by arguing *Revvo* does not apply because in that proceeding the petitioner offered different express constructions, whereas here Petitioner offered an express construction in district court and no construction in IPR. Supp. Discr. Opp. 2-3.

But the Director has applied *Revvo* to facts similar to those here. For example, in IPR2025-01095, the Director initially referred the petition but subsequently discretionarily denied it in light of *Revvo*. *See Baby Generation, Inc. v. Baby Jogger, LLC*, IPR2025-01095, Paper 17, 1 n.* (Dec. 1, 2025). In that IPR, petitioner proposed constructions for terms in district court, whereas it contended no express constructions were needed for those terms in IPR. *See id.*, Paper 14, 4 (citing Pet. 7-9). Petitioner did not dispute that it failed to offer a construction for those terms in the petition, but instead argued that “the challenged claims are unpatentable under any reasonable interpretation.” *Id.*, Paper 15, 2.

So too here. Specifically, in district court, Petitioner is advancing an express construction of “quality assessment value” as “score of diagnostic image quality” (EX1039, 1), whereas in IPR, Petitioner provided no construction for that term at all, instead arguing the prior art “discloses the claimed features under any reasonable interpretation of the claim language” (Pet. 10). These are similar facts to IPR2025-

01095, where the Director applied *Revvo* to discretionarily deny institution. The Director should follow suit here.

B. Petitioner Has Not Justified Its Inconsistent Claim Construction Positions.

In attempting to justify its differing claim construction positions in different forums, Petitioner admits that it proposed its express construction of “quality assessment value” in district court in an attempt to avoid infringement liability. Supp. Discr. Opp. 4. This alone supports discretionary denial under *Revvo*, which stated “[t]he Board’s...rules are designed to...discourage petitioners from seeking broader constructions at the Board to support a patentability challenge *while seeking narrower constructions in litigation to avoid infringement liability.*” *Revvo*, at 4 (emphasis added).

Petitioner next argues its district court construction is really “an express statement of the *correct* plain and ordinary meaning.” Supp. Discr. Opp., at 4. But the parties’ district court construction briefing makes clear that Petitioner is proposing a construction in litigation that is narrower than the plain and ordinary meaning by attempting to limit a “value” to only a “score” based on non-limiting examples in the patent specification. *See* EX2047, 6-10; EX2048, 19-21. Indeed, despite Petitioner’s attempt to limit the term, the specification also describes the term as “representing a quality assessment” of ultrasound images—which is broader than a “score.” EX1001, Abstract, 1:42-43, 2:37-40, 3:40-41, 3:53-56, 6:42-45, 12:56-57,

16:39-43. Petitioner’s litigation construction is narrower on its face than the plain and ordinary meaning of the term.

Petitioner further argues that “the construction provided to the district court is an express statement of the same interpretation Petitioner is applying in the Petition.” Supp. Discr. Opp., at 4. But Petitioner chose not to provide that express construction in the Petition, and neither Patent Owner nor the Director should be expected to intuit Petitioner’s unwritten but allegedly intended construction. Indeed, Petitioner’s choice to hide the ball in its Petition is directly contrary to the Board’s rules, which require a petition to identify “[h]ow the challenged claim is to be construed.” 37 C.F.R. §42.104(b)(3).

Additionally, Petitioner’s argument that Krishan discloses a “quality assessment value” under its district court construction should not be countenanced. If Petitioner wanted to argue this claim term is limited to a score, and that Krishnan discloses that claim term under Petitioner’s narrow construction, Petitioner should have done so in the Petition. Springing this position on Patent Owner and the Director now is simply too late. Importantly, allowing such an ex post facto justification would disadvantage patent owners by depriving them the chance to address such claim construction arguments in the preliminary response and would encourage gamesmanship by petitioners. And it appears the Director rejected such a justification in IPR2025-01092. *See id.*, Paper 15, 2-5 (attempting to justify

inconsistent claim construction positions based on the IPR prior art's alleged teachings), Paper 17, 1 n.* (discretionarily denying institution based on *Revvo*). The Director should reject that justification here.

C. Petitioner Cannot “Consent” To Applying Its District Court Construction in the IPR.

As a last-ditch effort to avoid discretionary denial, Petitioner states it “consents to use before the Board the same construction that was expressly stated to the district court.” Supp. Discr. Opp., at 5. It is unclear what Petitioner intends with such “consent”; nevertheless, it would not resolve the issue. As the Director stated in *Revvo*, the Board’s rules “are designed to ensure that the Board correctly construes claim terms and to minimize inconsistency in claim construction between forums.” *Revvo*, at 4.

Here, Petitioner had an obligation to present its construction to the Board, so that Patent Owner could dispute that construction, and the Board could apply the correct construction based on its own determination. In other words, the Board, not the Petitioner, decides the correct construction of claim terms.

III. CONCLUSION

For the reasons discussed herein and in Patent Owner’s Request for Discretionary Denial (Paper 9), the Director should discretionarily deny institution of this IPR.

Respectfully submitted,

/ Jessica Kaiser /

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Date: December 5, 2025

CERTIFICATE OF SERVICE

The undersigned certifies that true and correct copies of **PATENT OWNER'S SUPPLEMENTAL BRIEF FOR DISCRETIONARY DENIAL, and EXHIBITS 2046-2048** was served electronically on December 5, 2025, in their entirety on the following counsel of record for Petitioner:

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