

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.

THE UNIVERSITY OF BRITISH COLUMBIA,
Patent Owner.

IPR2025-01422
Patent 10,751,029 B2

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual
Property and Director of the United States Patent and Trademark Office.*

DECISION
Denying Patent Owner's Request for Discretionary Denial

The University of British Columbia (“Patent Owner”) filed a request for discretionary denial (Paper 9, “DD Req.”) in the above-captioned case, and Caption Health, Inc. (“Petitioner”) filed an opposition (Paper 11). With authorization, Petitioner filed a supplemental opposition (Paper 12, “Supp. Opp.”), and Patent Owner filed a supplemental brief (Paper 13, “Supp. Br.”).

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. *See* Paper 14 (“Notice of Decisions on Institution” or “Notice”), 2.

Patent Owner argues in its request for discretionary denial that “Petitioner has taken inconsistent claim construction positions in the co-pending district court proceeding and this IPR,” specifically as to the term “quality assessment value.” DD Req. 5 (citing Ex. 2007). Patent Owner contends that Petitioner’s alleged inconsistent claim construction positions weigh in favor of discretionary denial. *Id.* (citing *Sun Pharms. Indus. Inc. v. Nivagen Pharms., Inc.*, IPR2025-00893, Paper 18 (Director Sept. 19, 2025)).

After Patent Owner filed its request, the Office issued a decision in *Revvo Tech., Inc. v. Cerebrum Sensor Tech., Inc.*, IPR2025-00632, Paper 20 (Director Nov. 3, 2025) (precedential). In *Revvo*, the Office instructed “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.” *Id.* at 3–4. That will “ensure that the Board correctly construes claim terms and to minimize inconsistency in claim construction between forums.” *Id.* at 4.

Petitioner filed an authorized supplemental opposition to address *Revvo*. Supp. Opp. 1. Petitioner explains that it seeks to apply the same plain and ordinary meaning of “quality assessment value” in both

proceedings, but in district court, elaborated on its understanding that the plain and ordinary meaning of the term is “score of diagnostic image quality.” *Id.* at 3–5 (citing Ex. 1039, 1). Nevertheless, “[t]o remove any perceived discrepancy . . . Petitioner consents to use before the Board the same construction that was expressly stated to the district court.” *Id.* at 5.

Under *Revvo*, a petitioner must explain any inconsistent claim construction positions. While it is not entirely clear whether Petitioner sought to advance an inconsistent claim construction position in this proceeding, the Office accepts Petitioner’s “consent” as a stipulation to construe “quality assessment value” herein— and in any other proceeding before the Office that involves Petitioner and the same claim term—as “score of diagnostic image quality,” as Petitioner proposed in district court. Petitioner’s stipulation, therefore, resolves any potential inconsistency in claim construction positions between forums and does not require further explanation under *Revvo*.

While certain arguments are highlighted above, the determination not to exercise discretion to deny institution is based on the complete record and a holistic assessment of all of the evidence in light of the arguments presented. Accordingly, the Petition will be reviewed for merits and non-discretionary considerations.

In consideration of the foregoing, it is:

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

FURTHER ORDERED that neither party shall file a request for rehearing or Director Review of this decision until a Notice of Decision on Institution including this case issues.

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