

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIFESCAN, INC.

Petitioner,

v.

FACET TECHNOLOGIES, LLC

Patent Owner.

Case No. IPR2023-00712

U.S. Patent No. 8,840,635

**PETITIONER'S RANKING AND EXPLANATION FOR
TWO PETITIONS CHALLENGING U.S. PATENT NO. 8,840,635**

I. INTRODUCTION

Pursuant to the Consolidated Trial Practice Guide, LifeScan, Inc. (“Petitioner”) ranks, and explains the need to file, two Petitions challenging Facet Technologies, LLC’s (“Patent Owner”) U.S. Patent No. 8,840,635 (the “’635 patent”).

II. RANKING OF PETITIONS

Petitioner ranks the two Petitions challenging the ’635 patent as follows:

Rank	Petition	Grounds
1	IPR2023-00712	Ground 1: Saikley Anticipates Claims 1-3, 5-8, 14, and 16-18 Ground 2: Saikley and Stout Render Obvious Claims 1-3, 5-8, 14, and 16-18 Ground 3: Saikley and Freestyle Render Obvious Claims 3 and 16 Ground 4: Iio Anticipates Claims 1-3, 5-8, 14, and 16-18 Ground 5: Iio and Peckham Render Obvious Claims 1-3, 5-8, 14, and 16-18 Ground 6: Iio and FreeStyle Render Obvious Claims 3 and 16
2	IPR2023-00713	Ground 1: Coe Anticipates Claim 1 Ground 2: Coe and Sakata Render Obvious Claims 4 and 9-15 Ground 3: Coe, Starnes, and One Touch Booklet Render Obvious Claims 4 and 9-15 Ground 4: Sakata and Morita Render Obvious Claims 1, 4, and 9-15

III. EXPLANATION FOR TWO PETITIONS

As explained below, the Board should institute both petitions.

A. Open-Loop Claims 4, 9-13, and 15 Could Not Have Been Challenged in One Petition

As the above table shows, the two petitions challenge different sets of claims in the '635 Patent and rely on distinct primary references in doing so. The petition filed in IPR2023-00713 challenges claims requiring an “open loop” feature, and the petition filed in IPR2023-00712 does not. Thus, the primary petition (ranked #1) filed in IPR2023-00712 challenges claims 1-3, 5-8, 14, and 16-18 using Saikley and Iio as the primary references, while the second petition (ranked #2) filed in IPR2023-00713 challenges a different set of claims that require the open-loop feature (claims 4, 9-15) using different primary references (Coe and Sakata). Challenging the open-loop claims thus requires using different primary references and different obvious combinations, and fitting all of this in one petition was not feasible.

B. Submitting One Petition Would Risk Negatively Impairing Petitioner's Rights

By submitting only one of the two petitions, Petitioner would have risked surrendering its right to ever challenge the '635 patent's open-loop claims in an IPR proceeding. In particular, with the Board's use of the *Fintiv* factors or other reasons for a potential discretionary denial (including 325(d) and the *General*

Plastics factors), a later-filed IPR petition, even if not barred under 35 U.S.C. 315(e) might still be denied due to non-merits-based (e.g., discretionary) reasons. Thus, to ensure Petitioner had an opportunity to seek PTAB review of all claims, Petitioner needed to file two petitions now. Therefore, Petitioner needed to provide the Board with all of the well- grounded bases for finding the challenged claims of the '635 Patent unpatentable, or risk impairing its ability to ever seek PTAB review of all claims in the '635 Patent. This further weighs in favor of instituting both petitions.

IV. **CONCLUSION**

A single petition was insufficient to thoroughly address all grounds raised—and different sets of claims challenged using different primary references—in the two petitions. As such, Petitioner requests that the Board institute and consolidate both petitions “if it identifies one petition that satisfies petitioner’s burden under 35 U.S.C. § 314(a).” Consolidated Trial Practice Guide, 59-60.

Dated: March 20, 2023

Respectfully Submitted,

/ Michael J. Lyons /
Michael J. Lyons, Reg. No. 37,386

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. 42.6(4) and 42.105, the undersigned hereby certifies that on March 20, 2023, Petitioner's Ranking and Explanation for Two Petitions was sent via Federal Express to the correspondence address of record for the '635 Patent:

GARDNER GROFF &
GREENWALD, PC
1640 Powers Ferry Road
Building 4, Suite 200
Marietta, GA 30067

A courtesy copy of this Petitioner's Ranking and Explanation for Two Petitions (as well as the associated Petition and supporting exhibits) was (were) also served via email on March 20, 2023 on Patent Owner's counsel of record in the district court litigation involving this patent. This includes email copies sent to adiamond@diamondmccarthy.com; julian.cokic@diamondmccarthy.com; damion.robinson@diamondmccarthy.com; jeff.homrig@lw.com; jessica.lam@lw.com; susan.tull@lw.com; ryan.banks@lw.com; madeleine.ball@lw.com; grace.pak@diamondmccarthy.com; and rachel.cohen@lw.com; and bw@witkowlaw.com.

Dated: March 20, 2023

Respectfully Submitted,

/ Michael J. Lyons /

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