

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DEXCOM, INC.,
Petitioner,

v.

ABBOTT DIABETES CARE INC.,
Patent Owner.

Case No. IPR2023-01251
Case No. IPR2023-01252
Patent No. 11,298,056

**PATENT OWNER'S RESPONSE TO PETITIONER'S EXPLANATION OF
MATERIAL DIFFERENCES BETWEEN PETITIONS**

The Board should not institute trial on either petition for the reasons explained in the preliminary responses. But to the extent the Board is inclined to institute trial, it should do so only for the petition in IPR2023-01251 (“1251”) and deny institution on the petition in IPR2023-01252 (“1252”). Petitioner ranked the 1251 petition first, and it fails to explain “why the Board should exercise its discretion to institute additional petitions” if it institutes on the 1251 petition, as it is required to do. *Consolidated Trial Practice Guide* at 60 (Nov. 2019) (“CTPG”).

Petitioner first asserts that there will be “no added burden on Patent Owner or the Board” if the Board denies institution of the 1252 petition. 1251 IPR, Paper 2 at 1-2. But that is an argument ***against***, not for, instituting the 1252 petition. Petitioner also argues that it will “have forfeited” its arguments in the 1251 petition if it loses the 1252 IPR. *Id.* at 2. In other words, although Petitioner ranked the 1251 petition first and must view it as the stronger one, it urges the Board to institute on both ***in case it loses on the weaker one***. But Petitioner will not have “forfeited” anything because it will already have lost on the merits of the 1251 petition. Petitioner’s arguments are thus illogical and do not justify instituting two petitions, particularly where the second petition here raises a convoluted and unusual priority challenge.

As the CTPG explains, “one petition should be sufficient to challenge the claims of a patent in most situations,” and multiple petitions “are not necessary in the vast majority of cases.” CTPG at 59. Even when one petition challenges a priority

date, allowing two petitions “should be rare.” *Id.*; see *Square, Inc. v. 4361423 Canada Inc.*, IPR2019-01630, Paper 13 at 9 (P.T.A.B. Apr. 2, 2020) (stating that the CTPG “does not convey that whenever a priority issue is involved, Petitioner is entitled to file two petitions against the same claims of the same patent”).

In those rare situations, the dispute typically involves a well-defined and substantial question about whether an expressly-cited claim limitation is supported by the specification. But that is not the case here. Petitioner’s first-ranked 1251 petition involves no priority dispute. Instead, the alleged priority dispute is raised only in the secondary “backup” 1252 petition. The 1252 petition argues that numerous, fringe “features” not actually recited anywhere in the claims, but allegedly “encompassed” by their “full scope,” lack § 112 support in the 056 Patent’s grandparent application and, thus, those claims are obvious over the published grandparent application. As such, the 1252 IPR would be an unusual outlier proceeding among the already “rare” second trials contemplated by the CTPG.

Indeed, in filing two petitions, Petitioner is simply seeking an extra bite at the apple to spread the risk of losing. If the conventional (and first-ranked) 1251 petition is unsuccessful, Petitioner hopes for institution on its convoluted and unusual § 112 arguments in the backup 1252 petition. That Petitioner is hedging is further illustrated by the diametrically opposite opinions of its expert witnesses. For example, Petitioner’s 1251 expert opines that nearly every aspect of the challenged

claims was well within the skill set of POSITAs **by 2009**. See IPR2023-01251, Ex. 1008 ¶¶ 31-61. But Petitioner’s 1252 expert opines that the grandparent to the 056 Patent, **with a date of 2018**, does not provide sufficient detail necessary for POSITAs to make and use the claimed inventions. See IPR2023-01252, Ex. 1212 ¶¶ 30-57. Thus, Petitioner should not be rewarded with institution on two petitions supported by mutually exclusive evidence.

The 1252 petition also will place a significant burden on the Board and Patent Owner and will not lead to the “efficient administration of the Office, the integrity of the system, and the timely completion of proceedings.” *Comcast Cable Commc’ns, v. Rovi Guides*, IPR2019-01414, Paper 10 at 7 (P.T.A.B. Jan. 31, 2019) (quoting 35 U.S.C. § 316). Petitioner disingenuously argues that the 1252 petition “adds little burden to Patent Owner.” See IPR2023-01251, Paper 2 at 2. The 1252 petition contains 40 pages of meandering arguments about why the scope of the challenged claims allegedly “encompasses” numerous features not recited in the claims, and why those features lack §112 support in the grandparent application. The petition also cites over 40 cases—many inapposite—for support of those arguments. It is not clear exactly what “features” Petitioner contends are unsupported, and, the number of the allegedly unsupported features appears to be somewhere between 20 and 30.

Further, Petitioner will not be unduly prejudiced by rejection of the 1252 Petition because it can raise its § 112 arguments in the concurrent district court

litigation, where the parties and the court will have the time and resources to fully develop and evaluate those arguments. Thus, efficiency concerns favor denying institution on the 1252 petition.

Petitioner’s argument that it was “not practical” to combine the 1251 and 1252 petitions carries no weight. *See* IPR2023-01251, Paper 2 at 3. What Petitioner characterizes as “a thorough discussion” of priority arguments is lengthy because of the meandering way in which the arguments are presented. *See Square*, IPR2019-01630, Paper 13 at 10 (“With regard to the alleged ‘volume of discussion on the priority deficiencies,’ Petitioner ... does not explain why, if review is instituted on multiple grounds ... in IPR2019-01629 where priority is not at issue, a second review ... that involves a priority dispute is necessary.”). Also, that the 1251 and 1252 petitions are based on “different combinations of prior art” does not justify two IPRs. *See id.* (“nowhere [does the CTPG] indicate[] that mere alternative arguments that are different from each other constituted sufficient justification for filing multiple petitions”); *Intel Corp. v. Tela Innovations, Inc.*, IPR2019-01220, Paper 19 at 7-9 (P.T.A.B. Jan. 30, 2020) (“that the grounds rely on different references” does not “establish sufficient differences between the grounds of the two petitions”).

Lastly, Petitioner’s argument that the length and number of the claims warrant two petitions also has no merit. *See* IPR2023-01251, Paper 2 at 3-4. The 1252 petition challenges all claims 1-30, while the 1251 petition challenges the same

claims except 13 and 29. And both petitions contain multiple grounds. Thus, one petition was enough to address all the challenged claims. Further, there is only one independent claim and most dependent claims are short. Thus, there is also nothing “rare” about the length or number of the claims that justifies two petitions. *See Life Spine, Inc. v. Globus Med., Inc.*, IPR2023-00041, Paper 10 at 12 (P.T.A.B. Apr. 20, 2023) (“Petitioner’s argument that ... the ’732 patent has ‘three very lengthy independent claims’ is unavailing. ... Petitioner has not demonstrated anything extraordinary about the length or total number of challenged claims.”).

It is clear that the two petitions seek to circumvent word-count constraints and use the Byzantine 1252 petition as “Plan B” should Petitioner be denied institution on the higher-ranked 1251 petition. That does not constitute a “rare” situation justifying multiple petitions. *Apple Inc. v. Seven Networks, LLC*, IPR2020-00281, Paper 10 at 10 (P.T.A.B. Aug. 14, 2020) (“Petitioner’s arguments ‘simply amount to an expression of Petitioner’s desire to be allowed more words with which to raise more grounds against the same set of claims.’”). Accordingly, should the Board institute trial, it should not do so on the 1252 petition.

Dated: November 10, 2023

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CERTIFICATE OF SERVICE

I hereby certify that the Patent Owner's Response to Petitioner's Explanation of Material Differences Between Petitions was served on this 10th day of November, 2023 by electronic mail to the following:

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