

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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DEXCOM, INC.,  
Petitioner,

v.

ABBOTT DIABETES CARE INC.,  
Patent Owner.

Case IPR2023-01251  
Patent 11,298,056 B2

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**JOINT MOTION TO TERMINATE  
PROCEEDING UNDER 35 U.S.C. § 317(a)**

**EXHIBIT LIST**

**LIST OF NEWLY FILED EXHIBITS**

Exhibits concurrently filed with Joint Motion To Terminate Proceeding Under  
35 U.S.C. § 317(a):

| <b>No.</b> | <b>Description</b>                                   |
|------------|------------------------------------------------------|
| 1068       | Confidential Settlement And Patent License Agreement |

**LIST OF PREVIOUSLY-FILED EXHIBITS**

Petitioner previously filed the following exhibits:

| <b>No.</b> | <b>Description</b>                                                                                            |
|------------|---------------------------------------------------------------------------------------------------------------|
| 1001       | U.S. Patent No. 11,298,056 (“the ’056 Patent”)                                                                |
| 1002       | Excerpts from Prosecution File History of U.S. Patent Application No. 17/411,154 (“Harper ’154 file history”) |
| 1003       | Excerpts from Prosecution File History of U.S. Patent Application No. 17/245,719 (“Harper ’719 file history”) |
| 1004       | Excerpts from Prosecution File History of U.S. Patent Application No. 16/228,910 (“Harper ’910 file history”) |
| 1005       | Excerpts from Prosecution File History of U.S. Patent Application No. 15/061,774 (“Harper ’774 file history”) |
| 1006       | Excerpts from Prosecution File History of U.S. Patent Application No. 13/925,694 (“Harper ’694 file history”) |
| 1007       | Excerpts from Prosecution File History of U.S. Patent Application No. 12/769,635 (“Harper ’635 file history”) |
| 1008       | Declaration of Brian Gross, dated July 24, 2023 (“Gross Decl.”)                                               |

| No.  | Description                                                                                                            |
|------|------------------------------------------------------------------------------------------------------------------------|
| 1009 | Curriculum Vitae of Brian Gross                                                                                        |
| 1010 | Affidavit of Nathaniel E. Frank-White (“Internet Archive Affidavit”)                                                   |
| 1011 | Exhibits A and B to Affidavit of Nathaniel E. Frank-White (“Paradigm® REAL-Time Archive”)                              |
| 1012 | U.S. Patent Application Publication No. 2009/0085768 to Patel et al. (“ <i>Patel</i> -2009”)                           |
| 1013 | Prosecution File History of U.S. Patent Application No. 12/056,651 (“ <i>Patel</i> -2009 file history”)                |
| 1014 | U.S. Provisional Patent Application No. 60/976,886 (“ <i>Patel</i> -2009 provisional”)                                 |
| 1015 | U.S. Patent Application Publication No. 2008/0119705 to Patel et al. (“ <i>Patel</i> -2008”)                           |
| 1016 | Excerpts from Prosecution File History of U.S. Patent Application No. 11/931,363 (“ <i>Patel</i> -2008 file history”)  |
| 1017 | U.S. Patent No. 6,641,533 to Causey et al. (“ <i>Causey</i> ”)                                                         |
| 1018 | Excerpts from Prosecution File History of U.S. Patent Application No. 09/935,827 (“ <i>Causey</i> file history”)       |
| 1019 | U.S. Patent Application Publication No. 2006/0202859 to Mastrototaro et al. (“ <i>Mastrototaro</i> ”)                  |
| 1020 | U.S. Patent Application 11/322,568 to Mastrototaro (“ <i>Mastrototaro</i> ’568 Application”)                           |
| 1021 | Excerpts from Prosecution File History of U.S. Patent Application No. 11/322,568 (“ <i>Mastrototaro</i> file history”) |
| 1022 | U.S. Patent Application 10/335,256 to Shahmirian et al. (“ <i>Shahmirian</i> ’568 Application”)                        |
| 1023 | U.S. Patent Application Publication No. 2004/0122353 to Shahmirian et al. (“ <i>Shahmirian</i> ”)                      |

| No.  | Description                                                                                                                                                                                                                                      |
|------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 1024 | Excerpts from Prosecution File History of U.S. Patent Application No. 10/335,256 (“Shahmirian ’256 file history”)                                                                                                                                |
| 1025 | Geoffrey McGarraugh, <i>The Chemistry of Commercial Continuous Glucose Monitors</i> , Diabetes Technology & Therapeutics 11.S1 (2009)                                                                                                            |
| 1026 | U.S. Patent Application Publication No. 2004/0193025 to Steil et al.                                                                                                                                                                             |
| 1027 | C. Choleau et al., <i>Calibration of a Subcutaneous Amperometric Glucose Sensor Implanted for 7 Days in Diabetic Patients: Part 2. Superiority of the One-Point Calibration Method</i> , Biosensors and Bioelectronics 17.8 (2002)               |
| 1028 | G. Velho et al., <i>In Vivo Calibration of a Subcutaneous Glucose Sensor for Determination of Subcutaneous Glucose Kinetics</i> , Diabetes, American Diabetes Association 1.3 (1988)                                                             |
| 1029 | John J. Mastrototaro, <i>The MiniMed Continuous Glucose Monitoring System</i> , Diabetes Technology & Therapeutics 2.1 (2000)                                                                                                                    |
| 1030 | U.S. Patent No. 6,424,847 to Mastrototaro et al.                                                                                                                                                                                                 |
| 1031 | V. Poitout et al., <i>A Glucose Monitoring System for on line Estimation in Man of Blood Glucose Concentration Using a Miniaturized Glucose Sensor Implanted in the Subcutaneous Tissue and a Wearable Control Unit</i> , Diabetologia 36 (1993) |
| 1032 | U.S. Patent Application Publication No. 2006/0224109 to Steil et al.                                                                                                                                                                             |
| 1033 | D. Barry Keenan, Ph.D. et al., <i>Delays in Minimally Invasive Continuous Glucose Monitoring Devices: A Review of Current Technology</i> , Journal of Diabetes Science and Technology 3.5 (2009)                                                 |
| 1034 | Unused                                                                                                                                                                                                                                           |
| 1035 | S. Armstrong, <i>Wireless Connectivity for Health and Sports Monitoring: a Review</i> , British Journal of Sports Medicine (2007)                                                                                                                |

| No.  | Description                                                                                                                                                                                                                                                                                                                                                                                                                                                                                           |
|------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 1036 | Alexandros Pantelopoulos & Nikolaos Bourbakis, <i>A Survey on Wearable Biosensor Systems for Health Monitoring</i> , 30th Annual International Conference of the IEEE EMBS Conference (2008)                                                                                                                                                                                                                                                                                                          |
| 1037 | Excerpts from Diabetes Forecast, November 2007                                                                                                                                                                                                                                                                                                                                                                                                                                                        |
| 1038 | Excerpts from Diabetes Forecast, February 2007                                                                                                                                                                                                                                                                                                                                                                                                                                                        |
| 1039 | Bruce Buckingham et al., <i>Real-Time Continuous Glucose Monitoring</i> , Current Opinion in Endocrinology, Diabetes & Obesity 14.4 (2007)                                                                                                                                                                                                                                                                                                                                                            |
| 1040 | Bruce Buckingham, M.D., <i>Clinical Overview of Continuous Glucose Monitoring</i> , Journal of Diabetes Science and Technology 2.2 (2008)                                                                                                                                                                                                                                                                                                                                                             |
| 1041 | U.S. Food and Drug Administration, Center for Drug Evaluation and Research. Paradigm Real Time System, Premarket Approval, dated April 7, 2006. Retrieved from <a href="https://www.accessdata.fda.gov/scripts/cdrh/cfdocs/cfpma/pma.cfm?id=P980022S013">https://www.accessdata.fda.gov/scripts/cdrh/cfdocs/cfpma/pma.cfm?id=P980022S013</a> on July 21, 2023.                                                                                                                                        |
| 1042 | Excerpts from Steven W. Smith, <i>The Scientist and Engineer's Guide to Digital Signal Processing</i> , California Technical Pub. (1997)                                                                                                                                                                                                                                                                                                                                                              |
| 1043 | B.A. Shenoi, <i>Introduction to Digital Signal Processing and Filter Design</i> , John Wiley & Sons (2006)                                                                                                                                                                                                                                                                                                                                                                                            |
| 1044 | Medtronic Inc., News Release: Medtronic Receives FDA Approval for World's First Insulin Pump with Real-Time Continuous Glucose Monitoring, dated April 13, 2006. Retrieved from <a href="https://web.archive.org/web/20060427084431/http://wwwp.medtronic.com:80/Newsroom/NewsReleaseDetails.do?itemId=1144875806140&amp;lang=en_US">https://web.archive.org/web/20060427084431/http://wwwp.medtronic.com:80/Newsroom/NewsReleaseDetails.do?itemId=1144875806140&amp;lang=en_US</a> on July 21, 2023. |
| 1045 | Marc D. Breton Ph.D. et al., <i>Optimum Subcutaneous Glucose Sampling and Fourier Analysis of Continuous Glucose Monitors</i> , Journal of Diabetes Science and Technology 2.3 (2008)                                                                                                                                                                                                                                                                                                                 |

| No.  | Description                                                                                                                                                                                                                                                                                                                                   |
|------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 1046 | Mark R. Burge, MD et al., <i>Continuous Glucose Monitoring: The Future of Diabetes Management</i> , Diabetes Spectrum 21.2 (2008)                                                                                                                                                                                                             |
| 1047 | Adam Heller & Ben Feldman, <i>Electrochemical Glucose Sensors and Their Applications in Diabetes Management</i> , Chem. Rev. 108 (2008)                                                                                                                                                                                                       |
| 1048 | U.S. Patent No. 5,391,250 to Cheney et al.                                                                                                                                                                                                                                                                                                    |
| 1049 | List of Challenged Claims                                                                                                                                                                                                                                                                                                                     |
| 1050 | Eugene Wright, Jr., M.D., et. al., <i>Ambulatory Glucose Profiling</i> , The Journal of Family Practice 64.12 (Supp., 2015)                                                                                                                                                                                                                   |
| 1051 | Excerpt from Wayback Paradigm2                                                                                                                                                                                                                                                                                                                |
| 1052 | Affidavit of Nathaniel E Frank-White, including Exhibit A (“Supplemental Paradigm REAL-Time Archive”)                                                                                                                                                                                                                                         |
| 1053 | Deposition Transcript of Eugene E. Wright Jr., M.D. (July 25, 2024)                                                                                                                                                                                                                                                                           |
| 1054 | Deposition Transcript of Aaron Striegel, Ph.D. (July 24, 2024)                                                                                                                                                                                                                                                                                |
| 1055 | Declaration of Andrew Ahmann M.D. In Support of Dexcom’s Reply, dated September 4, 2024                                                                                                                                                                                                                                                       |
| 1056 | Unused                                                                                                                                                                                                                                                                                                                                        |
| 1057 | Reply Declaration of Brian D. Gross, dated September 6, 2024                                                                                                                                                                                                                                                                                  |
| 1058 | U.S. Food and Drug Administration, Center for Drug Evaluation and Research, Medtronic MiniMed Guardian RT, Premarket Approval P980022/S011, dated July 18, 2005. Retrieved from <a href="https://www.accessdata.fda.gov/cdrh_docs/pdf/P980022S011A.pdf">https://www.accessdata.fda.gov/cdrh_docs/pdf/P980022S011A.pdf</a> on August 26, 2024. |
| 1059 | U.S. Food and Drug Administration, Center for Drug Evaluation and Research, Medtronic MiniMed Guardian RT, Summary of Safety and Effectiveness Data (SSED). Retrieved from <a href="https://www.accessdata.fda.gov/cdrh_docs/pdf/P980022B.pdf">https://www.accessdata.fda.gov/cdrh_docs/pdf/P980022B.pdf</a> on August 26, 2024.              |

| No.  | Description                                                                                                                                                                                                                                 |
|------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 1060 | Unused                                                                                                                                                                                                                                      |
| 1061 | The Juvenile Diabetes Research Foundation Continuous Glucose Monitoring Study Group, <i>Continuous Glucose Monitoring and Intensive Treatment of Type 1 Diabetes</i> , New England Journal of Medicine 359:14 (2008)                        |
| 1062 | Richard M. Bergenstal, M.D., et. al., <i>Effectiveness of Sensor-Augmented Insulin-Pump Therapy in Type 1 Diabetes</i> , New England Journal of Medicine 363:4 (2010)                                                                       |
| 1063 | Howard Wolpert, M.D., <i>Establishing a Continuous Glucose Monitoring Program</i> , Journal of Diabetes Science and Technology, 2:2 (2008)                                                                                                  |
| 1064 | John Mastrototaro, et. al., <i>Accuracy of Real-Time Continuous Glucose Monitoring in the MiniMed Paradigm System</i> , American Diabetes Association 67 <sup>th</sup> Scientific Sessions, Diabetes 56 (Supp. 2007)                        |
| 1065 | Linkedin Profile of Wesley Scott Harper                                                                                                                                                                                                     |
| 1066 | Plaintiff's Opening Claim Construction Brief (ECF 135), <i>Abbott Diabetes Care, Inc., et al. v. Dexcom, Inc.</i> , Case No. 1:21-cv-00977-KAJ (July 13, 2022, D. Del.)                                                                     |
| 1067 | Expert Declaration of Majid Sarrafzadeh, Ph.D. in Support of Abbott's Opening Claim Construction Brief (ECF 137), <i>Abbott Diabetes Care, Inc., et al. v. Dexcom, Inc.</i> , Case No. 1:21-cv-00977-KAJ (July 13, 2022, D. Del.) (excerpt) |

Petitioner DexCom, Inc. (“DexCom”) and Patent Owner Abbott Diabetes Care Inc. (“Abbott”) (collectively “the parties”) jointly move to terminate IPR2023-01251 under 35 U.S.C. § 317(a). The Board authorized the filing of this motion on January 3, 2025.

**I. BACKGROUND AND RELATED IPR PROCEEDINGS**

A joint motion to terminate generally must “(1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26 at 2 (P.T.A.B. July 28, 2014). Each of these background issues is discussed below in turn.

The parties have entered into a Confidential Settlement And Patent License Agreement (the “Settlement Agreement”).<sup>1</sup> This agreement is a true copy of an “agreement or understanding ... including any collateral agreements ... made in

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<sup>1</sup> The parties are filing the Settlement Agreement concurrently with this joint motion as Exhibit 1068, along with a “Joint Request to Treat Settlement Agreement as Business Confidential Information.” Petitioner’s Updated Exhibit List, above, includes this document.

connection with, or in contemplation of, the termination of” this inter partes review. 35 U.S.C. § 317(b). There are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding. The parties both believe that this proceeding should be terminated. No Final Written Decision is expected in this proceeding for approximately one more month.

Patent Owner asserted the patent at issue in this proceeding in *Abbott Diabetes Care Inc. et al. v. DexCom, Inc.*, No. 1:23-cv-00239 (D. Del). The parties have filed a joint stipulation to dismiss the district court litigation. There is no other pending litigation related to the patent at issue in this proceeding.

The following IPRs between the same parties have also been instituted and relate to patents that were asserted in the same district court litigation referenced above: IPR2023-01409 and IPR2024-00521. The parties are moving to terminate or dismiss the IPRs referenced above.

## **II. STATEMENT OF RELIEF REQUESTED**

Under § 317(a), an *inter partes* review “***shall*** be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” The parties jointly request termination of this IPR2023-01251, and the Office has not decided the merits of this IPR proceeding. There are no other

preconditions of § 317(a). Therefore, the parties have met the statutory requirement to terminate the proceeding before the Office has decided the merits of the proceeding, and good cause exists to terminate this proceeding. *See* 35 U.S.C. § 317(a).

### **III. CONCLUSION**

For these reasons, the parties respectfully request termination of this IPR.

Respectfully submitted,

Dated: January 6, 2025

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**CERTIFICATE OF SERVICE  
IN COMPLIANCE WITH 37 C.F.R. § 42.6(E)(4)**

The undersigned certifies that on January 6, 2025, a complete copy of the **JOINT MOTION TO TERMINATE PROCEEDING UNDER 35 U.S.C. § 317(a)** and **EXHIBIT 1068** were served on Patent Owner via electronic mail as follows:

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