

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DEXCOM, INC.,
Petitioner,

v.

ABBOTT DIABETES CARE INC.,
Patent Owner.

IPR2023-01251
IPR2023-01252
U.S. Patent No.: 11,298,056
Issued: April 12, 2022

Title: METHODS AND SYSTEMS FOR EARLY SIGNAL ATTENUATION
DETECTION AND PROCESSING

**PETITIONER'S EXPLANATION OF
MATERIAL DIFFERENCES BETWEEN PETITIONS**

Petitioner concurrently is filing two petitions for *inter partes* review of U.S. Patent No. 11,298,056 (the '056 patent). *Petition 1 (IPR2023-01251)* assumes that all claims have an effective filing date in 2009, while *Petition 2 (IPR2023-01252)* argues that no claim has an effective filing date before 2021. Pursuant to the PTAB Consolidated Trial Practice Guide November 2019 (“TPG”), Petitioner submits this explanation of the material differences between these two Petitions and why both should be instituted. *See* TPG, 59-60. *Petitioner ranks Petition 1 first.*

While mostly challenging the same claims, the two petitions are fundamentally different because they are based on different presumed effective filing dates of the claims: April 2009 for Petition 1 and April 2021 for Petition 2. This difference justifies two petitions. *See* TPG at 59 (“[T]he Board recognizes that there may be circumstances in which more than one petition may be necessary, including, for example, ... when there is a dispute about priority date requiring arguments under multiple prior art references.”). Thus, even if the Board institutes IPR on Petition 1, it should also consider and institute on Petition 2.

Petitioner expects Patent Owner to argue that the claims are entitled to an effective filing date in 2009 not 2021 as asserted in Petition 2. If, in its Institution analysis, the Board agrees with Patent Owner that each claim is entitled to be backdated before 2021, then no IPR will be instituted on Petition 2, in which case there will not be parallel IPR proceedings and no added burden on Patent Owner or

the Board after the Institution Decision. On the other hand, if the Board finds at the Institution stage that Patent Owner fails to satisfy its burden of production to show an effective filing date earlier than 2021 and thus institutes IPR, it is possible that the Board at the Final Written Decision stage, or the Board's reviewing Court on appeal, later may find otherwise. In that case, at least the primary reference asserted in Petition 2, published July 2019, would not qualify as prior art and Petition 2 would fail. In that case, without Petition 1, Petitioner would have forfeited the opportunity to have the Board and its reviewing Court evaluate the patentability of the '056 claims assuming a 2009 effective filing date.

Petition 2 adds little burden to Patent Owner because all four prior art references asserted therein are Patent Owner's references and, more importantly, Patent Owner is highly unlikely to deny unpatentability over those references of any claim that it cannot backdate before 2021. In short, Patent Owner is not expected to argue that the '056 patent's claims are non-obvious over what is essentially the content of the patent's specification (with the exception of the as-filed claims being different). Thus, the only added burden on Patent Owner is to meet its burden of production to backdate the claims before 2021. Presumably Patent Owner has already compared the claims of the '056 patent to the disclosures of the ancestor applications when it asserted the benefit of the filing dates of those ancestor applications. While the Board will need to compare the Petition 2 prior art to the

claims, the burden of doing this should be less than normal because the prior art includes essentially the substance of the written description and drawings of the '056 patent. Therefore often the prior art has a verbatim disclosure of a claim element, and the Board will most likely *not* need to evaluate arguments by the Patent Owner attempting to distinguish the claims from the asserted references.

While the effective filing date of the claims is a dispositive threshold issue in Petition 2, it is immaterial to Petition 1, which relies exclusively on publications that qualify as prior art even if the claims are backdated to April 2009.

It was not practical to combine these two petitions into one. Being based on different effective filing dates, they are based on entirely different combinations of prior art. Also, Petition 2 reasonably includes a thorough discussion of the governing law on written description and enablement, which informs the Patent Owner's burdens of production to show entitlement to an earlier filing date—none of this matters in Petition 1. Petition 2 also reasonably includes a discussion of the claims' "full scope" and a comparison of that full scope to the disclosures of the 2018 ancestor patent application—neither of which matters in Petition 1.

Moreover, the length and number of claims further warrants multiple petitions. For example, independent claim 1 alone of the '056 patent includes 487 words and numerous features presented across several clauses, which presents a difficulty in covering both non-ancestral-based prior art grounds (Petition 1) and

arguments regarding a lack of full-scope written description and enablement support, and associated ancestral-based prior art grounds (Petition 2), within a single petition. In district court, Patent Owner's complaint expressly asserts infringement of "at least claim 1" and discusses claims 3-11 and 13-17 and 19. Patent Owner has not limited the asserted claims and thus currently is presumed to assert all 30 claims.

For at least these reasons, the Board therefore should exercise its discretion to institute both Petitions. The burden on the Board to address Petition 2 in addition to Petition 1 is not great, and Petition 2 addresses a lack of full-scope written description and enablement support not addressed by Petition 1. The Board has instituted trial on multiple parallel petitions in similar situations. *See, e.g., Google LLC v. Hafeman*, IPR2022-01190, Paper No. 16 at 11-12 (P.T.A.B. Jan. 31, 2023) (instituting IPR proceedings on two petitions asserting, as here, different prior art combinations, one petition assuming the earliest possible effective filing date for the claims and one challenging that effective filing date and asserting intervening prior art); *Pacific Biosciences of Cal., Inc., v. Personal Genomics Taiwan, Inc.*, No. IPR2020-01200, Paper No. 15 at 8-10 (P.T.A.B. Jan. 19, 2021) (permitting two petitions despite some claim overlap between the petitions); *Medtronic Inc. et al. v. Teleflex Innovations S.A.R.L.*, No. IPR2020-00136, Paper No. 20 at 37-40 (P.T.A.B. June 26, 2020); *Microsoft Corp. v. IPA Techs, Inc.*, No. IPR2019-00835, Paper No. 9 at 21 (P.T.A.B. Oct. 23, 2019) (three petitions).

Pursuant to the guidance of the TPG, Petitioner provides the following table illustrating the primary differences between first-ranked Petition 1 and second-ranked Petition 2:

	Petition 1 (IPR2023-01251)	Petition 2 (IPR2023-01252)
Earliest Possible Effective Filing Date of Any Challenged Claim	April 29, 2009	April 30, 2021
Explains lack of entitlement to priority date based on failure to support full scope of claims under Section 112, and related case law.	No	Yes
Relies on third party prior art publications	Yes	No
Relies on Patent Owner's own publications.	No	Yes
Relies on patent publications to which the challenged claims allege priority	No	Yes
Challenged Claims	1-12, 14-28, and 30	1-30

Respectfully submitted,

August 1, 2023

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

The undersigned certifies that the **Petitioner's Explanation Of Material Differences Between Petitions** was served on August 1, 2023, via **Federal Express** on the Patent Owner at the following address of record as listed on the USPTO Patent Center:

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