

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DEXCOM, INC.,
Petitioner,

v.

ABBOTT DIABETES CARE INC.,
Patent Owner.

Case IPR2023-01396
Patent 11,266,335

**PETITIONER'S REQUEST FOR
REHEARING OF DECISION DENYING INSTITUTION**

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Petitioner DexCom, Inc. (“Petitioner”) respectfully requests rehearing of the Decision Denying Institution (Paper 13, “Dec.”) pursuant to 37 C.F.R. § 42.71(d).

The Board’s Decision Denying Institution rests on a single point: whether the prior art teaches or suggests “an on body electronics unit housing comprising a plurality of recesses disposed on a periphery of the on body electronics unit housing.” Dec., 30, 49. The Board did not disagree that other limitations of claim 1 were met, and found that Raymond teaches “a single recess encircling base ... at the periphery of the base.” Dec., 30. The Board misapprehended or overlooked Turner’s teachings and, separately, erred in narrowly construing claim 1 to dismiss Turner. Petitioner provides independent bases for rehearing, each warranting instituting trial.

**I. THE BOARD MISAPPREHENDED THE PETITION’S
USE OF TURNER’S TEACHINGS IN THE COMBINATIONS**

The Petition relied on a simple addition to the Stafford housing of two recesses (a) to avoid rotation, as taught by Turner, and (b) to engage two base-retaining arms in the location where those arms would contact the on-body unit (OBU) as taught by Raymond, i.e., on the outer circumference. Paper 3 (“Pet.”), 24–26, 30–32, 35.

The Board misapprehended the proposed combination as requiring either (i) “substituting multiple recesses [for a single annular ring] in [Raymond’s] base 122 to engage retaining arms 1226” or (ii) “alter[ing] the location of Turner’s rotation-resisting recesses 77 from the upper surface of body 20 to the periphery of

body 20.” Dec., 31; *id.*, 49–50. The Board’s analysis over-complicated the combination to require modifying Raymond’s base or moving Turner’s recesses. Starting instead from the blank slate of Stafford’s OBU housing—which lacks any feature for engaging Raymond’s two base-retaining arms—the obvious choice to both secure a housing to the Raymond inserter and provide the anti-rotation benefit taught by Turner would have been two spaced-apart recesses on the sidewall of the housing, one to engage each of the two arms taught by Raymond. Pet. 30–32, 48.

Importantly, Petitioner did not rely on bodily incorporation of Turner’s recesses in the exact or similar position as depicted in Turner, on the curved “upper surface” (or curved sidewalls) of the OBU. Pet., 33 (“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.”) (quoting *Allied Erecting and Dismantling Co., Inc. v. Genesis Attachments, LLC*, 825 F.3d 1373, 1381 (Fed. Cir. 2016)). Rather, in the combination, the multiple recesses as taught by Turner would have been positioned on a periphery of Stafford’s housing so as to engage or mate with each of the base-retaining feet on each of Raymond’s two base-retaining arms—as their name suggests, these base-retaining feet were already designed to engage and retain the OBU. Pet., 25, 30–31, 33, 43, 48; EX1003, ¶60 (“[A] POSITA would have simply ensured that the on-body electronics unit housing included spaced-apart recesses (in line with Turner’s teachings) that were engageable with the engagement

bosses (similar to Raymond’s base-retaining feet”)”); *see also id.*, ¶¶74–75 (“[I]t would have been an obvious design choice to implement two spaced-apart plural recesses on the housing—one to engage the protrusions on each of the two arms taught by Raymond.”), ¶¶77–78, ¶109 (“A POSITA would have also understood that each of the gripping arms disengages a corresponding recess on the housing”), ¶129 (“[A] POSITA would have been motivated to form the recesses on the sidewalls of the housing instead of the bottom surface of the housing”).

**A. Turner Supplied A Motivation To
Use Two Recesses To Resist Rotation**

“[A]s expressly reflected by Turner, a POSITA would have been motivated to implement similar plural rotation-restricting recesses on the periphery of the housing ... to prevent rotation between the housing as taught by Stafford and the inserter as taught by Raymond.” Pet., 32; *see also* EX1003, ¶86 (“As previously discussed, Turner’s teachings further confirm that a POSITA would have been motivated, with a reasonable expectation of success, to implement Stafford+Raymond with a housing having plural recesses spaced apart from one another so as to be engageable with the inserter, and specifically the corresponding engagement bosses on the tip portions of the gripping arms as taught by Raymond.”), ¶77 (“Turner ... confirms the obviousness of implementing spaced-apart plural recesses on the housing taught by Stafford as expressly reflected by Turner, a POSITA would have been

motivated to implement similar plural rotation-restricting recesses on the periphery of the housing as taught by Stafford”).

The Board did not appear to disagree that Turner provided a motivation to use the design choice of multiple recesses to restrict rotation. *See* Dec., 39 (quoting Turner and describing role of rotation-restricting recesses). Patent Owner also agreed that “the cited Turner recesses serve ... to prevent rotation between Turner’s needle hub and OBU.” Paper 7 (“POPR”), 13 (emphasis omitted).

B. Using Two Recesses On The Sidewall To Secure A Stafford-like Housing To A Raymond-like Inserters Was An Obvious Design Choice, Which Added An Anti-Rotation Benefit

The Board did not disagree that an OBU housing like that disclosed in Stafford would have required adding an engagement feature to secure it to an inserter like the one disclosed in Raymond. *See generally* Dec. To do that, ***only two design choices are supported by the evidence*** of record—a single annular recess/ring or multiple recesses.¹ Only the latter provides Turner’s anti-rotation benefit.

Patent Owner asserted that adding multiple recesses “would add unnecessary complexity to Raymond’s already-complex assembly.” POPR, 55. But Patent Owner

¹ Despite Patent Owner’s unsupported attorney argument, the Board did not appear to disagree that these were the two choices for modifying Stafford’s housing having no recesses. *Compare* POPR, 49–50 *with* Dec., 30–31.

failed to explain—let alone offer evidence to support—how two recesses add any significant complexity when starting from the blank slate of Stafford’s housing lacking any feature for engaging a Raymond-like inserter. Nevertheless, the Board appeared to adopt Patent Owner’s unsupported contention that adding multiple recesses rather than a single annular recess/ring would have allegedly “added needless complexity to the design, without producing a substantial benefit or improvement.” Dec., 30–31; *id.*, 46 (applying Ground 1 reasoning to Ground 2). In rejecting the two-recesses design choice on this basis, the Board misapprehended the combination and overlooked the benefits of such recesses, as taught by Turner.

The Federal Circuit has repeatedly held that an obvious design choice does not need to be an “improvement.” Rather, the design choice only needs to be a “suitable option” to be obvious. *Intel Corp. v. PACT XPP Schweiz AG*, 61 F.4th 1373, 1380–81 (Fed. Cir. 2023) (“That Kabemoto and Bauman address the same problem and that Bauman’s cache was a known way to address that problem is precisely the reason that there’s a motivation to combine under *KSR* and our precedent Intel never had to show that replacing Kabemoto’s secondary cache with Bauman’s secondary cache was an ‘improvement’ in a categorical sense Intel just had to show that Bauman’s secondary cache was a ‘suitable option’”); *PAR Pharm., Inc. v. TWI Pharms., Inc.*, 773 F.3d 1186, 1197–98 (Fed. Cir. 2014) (“Our precedent, however, does not require that the motivation be the *best* option,

only that it be a *suitable* option”) (emphasis in original).

**1. The Board Misapprehended The Actual Combination,
And That Combination Was A “Suitable” Design Choice**

The Board apparently rejected Turner’s recesses as a suitable design choice because “Turner’s rotation-restricting recesses 77 are not located on the peripheral edge of its body 20, such that they can be engaged to hold the on-body housing properly positioned within the device. Instead, they are disclosed as being located upon the upper surface of body 20” Dec., 48. In doing so, the Board may have misunderstood the combination as relying on (1) the addition of Turner’s recesses to Raymond’s base, in the same position disclosed by Turner, and (2) bodily incorporation of Turner’s recesses to be placed on an upper surface without any modification, e.g., in orientation or placement. Dec., 31, 43–45, 48–49.

However, the combination proposed in Ground 2 used the idea of multiple recesses as taught by Turner but positioned those recesses to engage Raymond’s base-retaining arms with base-retaining feet on a periphery—where Raymond’s base-retaining arms and feet were already designed to engage a peripheral edge or sidewall of the OBU. *See* EX1010, FIG. 29; EX1003, ¶60, ¶¶74–75, ¶¶77–78, ¶86, ¶109, ¶129; *see also* Pet., 25, 30–31, 33, 43, 48. This combination in no way required adding Turner’s recesses to an upper surface where no securing or engaging feature is present in Raymond or Stafford. Neither the Board nor Patent Owner addressed

the suitability of the combination proposed in Ground 2. *See generally* Dec.; POPR.

A showing of a substantial benefit or improvement is not required to show that multiple recesses constituted an obvious design choice. *See Intel Corp.*, 61 F.4th at 1380–81; *PAR Pharm., Inc.*, 773 F.3d at 1197–98. Rather, as the Federal Circuit has repeatedly held, Petitioner’s showing that the proposed combination is a “suitable” option is sufficient. *Id.* This is especially so where ***only two design choices are supported by the evidence*** of record—a single annular recess/ring or multiple recesses.² Petitioner’s evidence was un rebutted at this stage. Patent Owner offered ***no evidence*** that a POSITA would have considered any other design for engaging a Stafford-like housing with Raymond-like base-retaining arms already designed to engage at the side of an OBU.

2. Even If The Law Required An Improvement, Turner Teaches One That Was Undisputed: Preventing Rotation

More than a suitable option, the use of two recesses would have provided an anti-rotation benefit, as both Patent Owner and the Board recognized. Dec., 37-40;

² “A POSITA would have recognized that there were only two possibilities for a system having arms with protrusions that engage some type of recess: either the two arms engage different points of a single annular recess or each arm engages its own independent recess.” Pet., 31; EX1003, ¶75 (“a recess for each arm provided a more secure fit between the inserter and on-body unit ... making it the better choice.”).

POPR, 30-31; *see also* Pet., 25, 31–32, 35. Even if using two recesses would have added complexity,³ no record evidence suggests a POSITA would have foregone the anti-rotation benefits taught by Turner, thus limiting unintended rotational movement between the OBU and inserter. *See, e.g., KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) (solutions may be obvious to try “[w]hen there is a design need ... to solve a problem and there are a finite number of identified, predictable solutions”).

The Board should have determined that adding two peripheral recesses to the sidewall of the OBU taught by Stafford was an obvious design choice.

II. THE BOARD ERRED IN ITS APPARENT CLAIM CONSTRUCTIONS

A. The Board Misapprehended The Meaning Of “Periphery,” Resulting In Further Overlooking The Significance Of Turner

Petitioner’s expert opined that Turner’s recesses are in fact disposed “on the periphery” of Turner’s body. EX1003, ¶47. Patent Owner’s attorney argument disagreed that Turner’s recesses are disposed on the periphery. POPR, 30, 34.

³ No record evidence supports that the combination added complexity. The record evidence is that rather than a single molded recess/ring disclosed in Raymond, two molded recesses would simply be added to the blank slate of Stafford’s OBU to receive Raymond’s two base-retaining feet on a periphery. *See, e.g.,* EX1003, ¶60.

Yet, after effectively construing the claims to exclude Turner’s recesses as not being on “*the* periphery” of the body (claim 1 actually recites “recesses disposed on *a* periphery”) (emphasis added), Patent Owner asserted, “[b]ased on the current record, Patent Owner does not believe that any claim terms require construction in order to reach a decision to deny institution.” *Id.*, 32. The Board agreed with Patent Owner’s implied claim construction that Turner’s recesses are not disposed “on a periphery,” and are instead disposed on an “upper surface.” Dec., 48–49. That conclusion flowed from incorrect claim interpretation.

1. The Board Misapprehended The EPO Preliminary Opinion To Construe “Periphery” Too Narrowly

The Board appeared to construe the term “periphery” based in part on a preliminary opinion from the European Patent Office (EPO) that rejected Petitioner’s arguments directed to different claim language: “[a] plurality of recesses circumferentially disposed thereon.” *Id.*, 35–36.

First, the Board misapprehended the significance of the EPO’s preliminary opinion, which was not final. The Board should take judicial notice that the EPO ultimately revoked the patent at issue in the EPO’s preliminary opinion.

Second, the Board misapprehended the relevance of the EPO’s preliminary opinion because the EPO did not discuss peripheral recesses. Rather, as cited by the Board, the EPO’s preliminary opinion discussed “[a] plurality of recesses

circumferentially disposed thereon.” EX2001, ¶18.1, ¶18.5. Indeed, no claim in the EP ’408 patent at issue in the EPO preliminary opinion recites “a periphery,” “peripheral,” or the like. *See* EX2002.

The Board’s apparent interpretation of the EPO’s preliminary opinion as being relevant to construing “on a periphery” seemingly contributed to overlooking the teachings of Turner, infecting the motivation-to-combine analysis. Dec., 36.

2. The Board Resolved An Apparent Claim Construction Dispute Regarding “On A Periphery” At The Institution Stage Without Engaging In Claim Construction Analysis

The Board’s apparent or implied construction required that the claimed “recesses disposed on a periphery” be recesses “on the peripheral edge” of a housing. *See id.*, 48–49. Yet the Board provided no express construction of the term “periphery” and engaged in no claim construction analysis to support its conclusion, instead citing to Figure 17 and a preferred embodiment in the ’335 patent where the recesses are on the “peripheral edge,” while also asserting that the cited embodiment “does not necessarily limit” the claims. *Id.*, 46–47. Absent a construction with a clear dividing line between Turner’s Figure 9 and the ’335 patent’s Figure 17, the Board leaves a POSITA without reasonable certainty about what “on a periphery” covers.

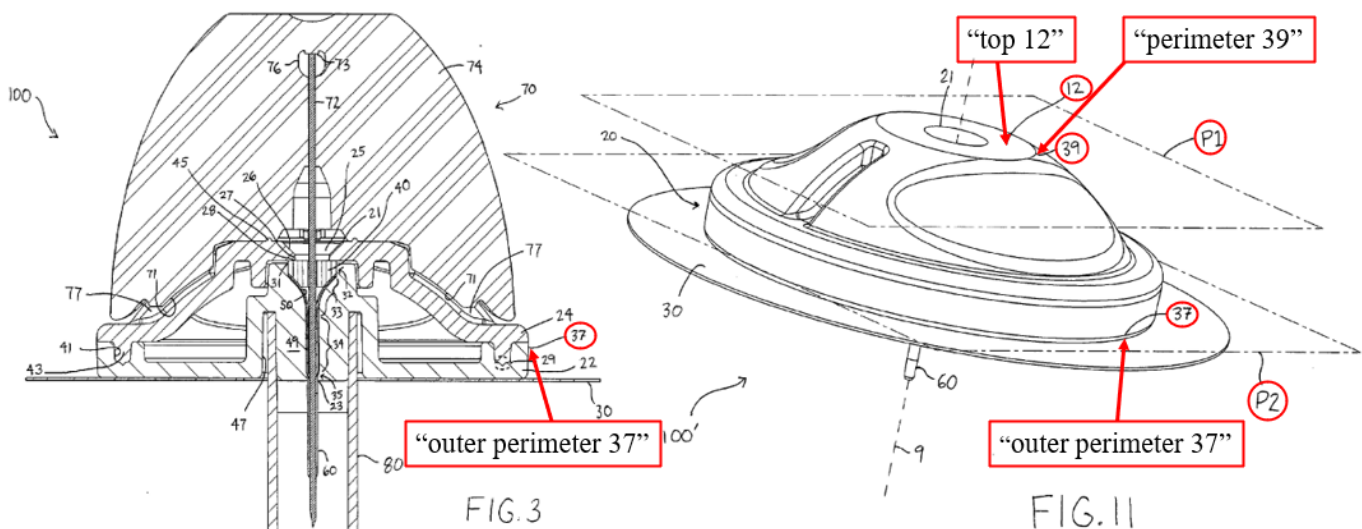
Moreover, the Board overlooked record evidence that establishes that its implied claim construction excluding the location of Turner’s recesses as not being “on a periphery” was wrong, which Petitioner would more fully develop at trial.

Petitioner proffers the following as inconsistent with the apparent construction:

First, the '335 patent does not define “periphery,” or even use the word outside of claim 1. *See* EX1001. Nevertheless, despite the dearth of information about where the claimed “plurality of recesses disposed on a periphery” may be located, the Board appears to have overlooked and accorded no weight to claim 12 of the '335 patent, reciting “wherein each recess of the plurality of recesses is disposed on a side wall” *Id.*, 49:61–63. While the '335 patent ***discloses only*** embodiments with recesses ***in the peripheral edge***, nothing expressly limits “on a periphery” in claim 1 to being “on a side wall” or “on the peripheral edge.” The doctrine of claim differentiation suggests claim 1 is broader than claim 12 and does not require recesses to be “on a side wall” or “on the peripheral edge” of the OBU.

Second, if the Board adheres to its initial indication that the '335 patent's Figure 17 is not limiting, then there is likewise nothing in the patent foreclosing the location of Turner's disclosed recesses from being “on a periphery.” Nothing in the record and no ordinary meaning of “periphery” limits it to the outermost circumferential edge. *See, e.g., Periphery*, MERRIAM-WEBSTER DICTIONARY (last updated May 8, 2024), www.merriam-webster.com/dictionary/periphery (“2: the external boundary or surface of a body ... 3a: the outward bounds of something as distinguished from its internal regions or center”).

Third, nothing in this art so limits the meaning of “periphery” either. From the perspective a POSITA, Petitioner’s expert asserted that the recesses in Turner are in fact “disposed on the periphery.” EX1003, ¶47. Patent Owner offered no evidence in response, just a conclusory and opposite attorney assertion. POPR, 12. Turner itself in fact contrasts an “outer perimeter” with other perimeters or peripheries, such as the “outer perimeter 37 of body 20” at the bottom compared to the smaller “perimeter 39 at top 12.” EX1011, FIGS. 3, 11, [0071], [0104]. Indeed, as shown below, Turner’s Fig. 11 illustrates two planes P1 and P2, which are described as each containing a perimeter. *Id.*, FIG. 11, [0104]. Any number of additional planes between them could be drawn, where each would contain a different perimeter of the Turner embodiment, including planes containing the perimeters in which Turner’s recesses are formed. In other words, Turner’s recesses are “on a perimeter” and “on a periphery” despite not being on the outermost circumferential edge.



Turner, FIGS. 3 and 11 (annotated)

As in Turner, where claim 1 of the '335 patent does not specify an “outermost circumferential” edge as being the claimed “periphery,” there is no basis to read an “outermost circumferential” limitation into the claim to exclude other peripheries of an irregularly shaped three-dimensional object. Independent of the argument in Section I, *supra*, the overly narrow construction of “periphery” appears to have caused the Board to overlook the teachings of Turner and infected the motivation-to-combine analysis. Dec., 49–50.

In any event, while nothing in the '335 patent expressly limits “on a periphery” to being on the outermost circumferential edge, if that is the Board’s construction on which denial of institution is based, that fact should be made express: “on a periphery” as construed by the Board excludes a recess on an upper surface (as in Turner) or on the bottom (as in a Stafford+Raymond+Turner combination), if it is not a recess through the outermost edge of the housing (an example of which is depicted in Figure 17 of the '335 patent).

B. The Board Erred In Reading Into The Claims A “Securing” Function, Further Causing The Board To Overlook Turner

The challenged claims do not require (but may include in their scope) a particular function or purpose for the recesses such as securing the OBU in the inserter. Challenged claim 1 requires a plurality of recesses “detachably engaged with the inserter.” EX1001, 48:64. The specification states that a function of the

gripping arms 3762 is to “maintain[] the proper height location of the on body housing 322.” *Id.*, 44:8–14. However, challenged claim 1 does not require “gripping arms,” much less require that the gripping arms maintain the OBU housing at a particular height or otherwise secure it. *See id.*, 48:53–49:11.

The Board and Patent Owner apparently agreed that Turner teaches a plurality of recesses that detachably engage corresponding protrusions. Dec., 37–40; POPR, 11–14. The Board also appeared to accept that Turner’s recesses detachably engage an insertion device. Dec., 39.

However, Patent Owner led the Board astray, emphasizing not just that recesses configured to secure or hold an OBU to an inserter would have been *sufficient* to satisfy the claims, but that configuring the recesses to perform this securing function was strictly *necessary* to satisfy the claims. POPR, 11–14.

Based on Patent Owner’s arguments reading limitations into the claims that are not required by the claim language, the Board found that Turner does not teach or suggest the claimed plurality of recesses in part because Turner’s recesses on top cannot “be engaged to hold the on-body housing properly positioned within the device,” Dec., 48–49, (despite recesses on top not being Petitioner’s combination).

The Board erred in reading a “securing” function for the recesses into the claims because the Federal Circuit has repeatedly held, “limitations from the specification are not to be read into the claims.” *Comark Comms., Inc. v. Harris*

Corp., 156 F.3d 1182, 1186 (Fed. Cir. 1998). The Board erred here in reading a “securing” purpose of the recesses into the claims where no purpose or function is recited. The record evidence establishes that, in view of *Turner*, a POSITA would have recognized that plural recesses may serve another purpose acknowledged by both Patent Owner and the Board, e.g., restricting rotation. *See Dec.*, 37–40; POPR, 30–31.

Importing a functional “securing” requirement from the specification into the claims appears to have infected the motivation-to-combine analysis, resulting in the Board dismissing *Turner*’s teachings. *Dec.*, 49–50.

III. CONCLUSION

The Board should grant rehearing and institute trial and, in any event, make express any implied claim construction(s) on which its decision is based.

Respectfully submitted,

Dated: May 16, 2024

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

The undersigned certifies that on May 16, 2024, a complete copy of the **Petitioner's Request For Rehearing Of Decision Denying Institution**, was served on counsel for Patent Owner via electronic mail as follows:

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