

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. IPR2023-01397
U.S. Patent No. 11,266,335

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

Petitioner concurrently files two petitions for inter partes review of U.S. Patent No. 11,266,335 (the '335 patent). **Petition 1 (IPR2023-01396)** is based on prior art publications that qualify as prior art even if, *arguendo*, the claims were entitled to claim priority to the earliest March 2010 provisional, while **Petition 2 (IPR2023-01397)** is based on one later publication (Thomas, EX1109) that qualifies as prior art unless Patent Owner antedates it by showing earlier conception and diligent reduction to practice (which Petitioner contends Patent Owner will be unable to show). Pursuant to the November 2019 Consolidated Trial Practice Guide ("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.

**I. TWO PETITIONS ARE NEEDED TO
ADDRESS AN ANTICIPATED PRIOR ART STATUS DISPUTE**

Each petition challenges the same claims of the '335 patent: independent claim 1 and dependent claims 2–4, 8–9, and 11–27. Petition 1 ("the Stafford-based petition") relies on Stafford (EX1009), along with Raymond (EX1010) and four additional references, to render obvious all challenged claims. Petition 2 ("the Thomas-based petition") relies on Thomas (EX1109), along with Raymond (EX1110) and just one other reference, to render obvious all challenged claims.

Two petitions are necessary because Patent Owner will likely dispute the prior art status of the Thomas reference presented as Exhibit EX1109. Petitioner believes Patent Owner will dispute Thomas's prior art status because during prosecution, Patent Owner disputed the prior art status of a different reference having a Pre-AIA § 102(a) publication date seven days earlier than Thomas's. Specifically, during prosecution of the '335 patent, Applicants swore behind U.S. Patent Publication No. 2010/0198034 ("Thomas-034") to disqualify it as prior art under 37 CFR § 1.131. Because Thomas-034's § 102(a) publication date is seven days earlier than Thomas's publication date (August 5, 2010 vs. August 12, 2010), Patent Owner will likely seek to disqualify Thomas as prior art by attempting to swear behind it.

This kind of dispute (about prior art status) is precisely the kind of dispute that the TPG and Board have said warrants two petitions. *See* TPG, 59–61; *Medtronic, Inc. v. Teleflex Innovations S.A.R.L.*, IPR2020-00136, Paper 20 at 39 (PTAB June 26, 2020) (a dispute about prior art is “precisely one of the circumstances ... in which more than one petition may be necessary”); *see also* *10X Genomics, Inc. v. Bio-Rad Labs., Inc.*, IPR2020-00088, Paper 8 at 47 (PTAB Apr. 27, 2020) (noting that more than one petition may be necessary where there is a priority date dispute).

II. THE BOARD SHOULD INSTITUTE BOTH PETITIONS

The Board should institute both petitions for at least four reasons.

First, each petition has compelling merits. As explained in the petitions, the

Stafford and Thomas references each discloses one of the central claimed concepts—an on body glucose monitoring unit having a glucose sensor and associated sensor electronics within an on-body unit. The main secondary references relied on in each petition—Raymond (EX1010 / EX1110) and Turner (EX1011 / EX1111)—teach inserter device details claimed by the '335 patent, such as gripping arms that engage recesses on the periphery of the on body unit. When Stafford and Thomas are each combined with these secondary references, these combinations and the other references relied on herein render unpatentable each challenged claim.

Second, instituting only the Thomas-based petition (IPR2023-01397) risks prejudicing Petitioner. Specifically, if only the Thomas-based Petition 2 is instituted and Patent Owner waits until after institution to dispute the prior art status of Thomas—and is successful in doing so—Petitioner's meritorious Stafford-based Petition 1 would never be fully considered by the Board.

Third, if Patent Owner fails to establish an earlier conception date and diligence in reducing the alleged invention to practice—as Petition 2 contends—then only three prior art references render all claims obvious because Thomas expressly teaches or discloses many features recited in the dependent claims. Petition 1, on the other hand, relies on six prior art references, in various combinations, in order to render obvious the various permutations of the dependent claims of the '335 patent. Thus, while Petition 1 presents meritorious obviousness arguments,

Petition 2 presents simpler and less numerous combinations.

Fourth, if the Board decides to institute the Stafford-based petition, the Thomas-based petition (IPR2023-01397) adds only a minimal amount of additional work. The Thomas-based petition relies on a different primary reference but otherwise relies on two of the secondary references (Raymond and Turner) and similar principles of combination.

III. DIFFERENCES BETWEEN THE PETITIONS

The petitions rely on different primary references and Petition 1 relies on three additional secondary references (Say, Bickoff, and Shah) not raised / relied on in Petition 2. Differences are highlighted in the following summary table:

Petition 1 (IPR2023-01396)		Petition 2 (IPR2023-01397)	
Challenged Claims	§ 103 Combination	Challenged Claims	§ 103 Combination
1–4, 8–9, 11–15, and 17–27	Stafford+Raymond	1–4, 8–9, 11–27	Thomas+Raymond
1–4, 8–9, 11–15, and 17–27	Stafford+Raymond+Turner	1–4, 8–9, 11–27	Thomas+Raymond+Turner
16	Stafford+Raymond+Say	N/A	
16	Stafford+Raymond+Say + Turner		
16	Stafford+Raymond+Bickoff		
16	Stafford+Raymond+Bickoff+Turner	N/A	
17–18	Stafford+Raymond+Shah		

17-18	Stafford+Raymond+ Shah+Turner	
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IV. CONCLUSION

The Board should institute both petitions to ensure that Patent Owner is not able to circumvent the petitions through a procedural ploy. Both petitions have compelling merits and are needed to address Patent Owner's likely prior art dispute. If the Board elects to institute only one of the petitions, Petitioner ranks Petition 1 (IPR2023-01396) first.

Respectfully submitted,

Dated: October 6, 2023

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CERTIFICATE OF SERVICE

The undersigned certifies that on October 6, 2023, a copy of the foregoing **Petitioner's Explanation of Material Differences Between Petitions** was served by Express Mail on the correspondence addresss of record indicated in the Patent Office's Patent Center system for U.S. Patent No. 11,266,335:

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