

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. IPR2023-01396

Case No. IPR2023-01397

U.S. Patent No. 11,266,335

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

The Board should not institute trial on either petition filed in IPR2023-01396 (“1396”) and IPR2023-01397 (“1397”) because both petitions lack merit for the reasons explained in the Preliminary Responses. Regardless, Petitioner has not demonstrated that the 1397 petition should also be granted if the 1396 petition is granted. Petitioner ranked the 1396 petition first, and it fails to meet its burden of explaining “why the Board should exercise its discretion to institute” the *second-ranked* 1397 petition if the Board institutes on the *first-ranked* 1396 petition. Petitioner thus fails to show that this is one of the “rare” situations in which the Board should institute trial on two petitions challenging the same claims. *See Consolidated Trial Practice Guide* at 59-60 (Nov. 2019) (“CTPG”).

Petitioner attempts to defend its two-petition strategy by suggesting that it needs to challenge the prior art status of Thomas-005 in the 1397 IPR, directly contrary to Patent Owner’s successful arguments on that issue during prosecution of the 335 Patent. As explained in the 1397 Patent Owner Preliminary Response, this argument lacks merit, and it should not be reconsidered under 35 U.S.C. § 325(d). Furthermore, it certainly does not justify a second, follow-on, petition.

During prosecution of the 335 Patent, Patent Owner swore behind a related reference—Thomas-034—which has an *earlier* prior art date than Petitioner’s Thomas-005. Patent Owner submitted a comprehensive declaration under 37 C.F.R. § 1.131 by which the Examiner found that the inventions of the Challenged Claims

antedate Thomas-034 (and, as such, necessarily antedate Thomas-005). The Examiner agreed that certain figures from the inventors' reduction-to-practice evidence disclosed the claimed invention, including a "plurality of recesses disposed on a periphery of the on body electronics unit housing" and how those recesses "detachably engage[] with the inserter." The Examiner also found that the inventors' evidence showed reasonably continuous diligence throughout the critical period.

Petitioner disagrees with the Examiner's determination but provides only a cursory analysis of only a subset of the priority evidence that the Examiner considered in reaching the conclusion that the Challenged Claims antedate Thomas-034. Petitioner's incomplete and insufficient showing cannot justify instituting trial based on a petition that should be denied under 35 U.S.C. § 325(d), much less a petition that Petitioner itself ranks below the 1396 petition.

Petitioner cites *Medtronic* and *10X Genomics* for the notion that, in rare cases, two petitions ***might*** be warranted when there is a priority dispute. IPR2023-01396, Paper 2 at 2. Neither case supports Petitioner. While the Petitioners in both cases filed two petitions, they ranked their petitions with potential priority disputes first and reserved their second-ranked petitions as backups in case the primary references in the first-ranked petitioners were antedated. *See Medtronic v. Teleflex Innovations*, IPR2020-00136, Paper 20 at 37-38 (P.T.A.B. June 26, 2020); *10X Genomics v. Bio-Rad Labs.*, IPR2020-00088, Paper 8 at 46-47 (P.T.A.B. Apr. 27, 2020).

Petitioner takes the opposite approach. Unlike in *Medtronic* and *10X Genomics*, Petitioner did not rank the 1397 petition (with the alleged priority “dispute”) first and argue that institution on the 1396 petition is necessary for when Patent Owner proves (again) that Thomas-005 is not prior art. Instead, the second-ranked, 1397 petition **is the backup**. Thus, the rationale for why the Board instituted two trials in those cases does not apply here.

Petitioner purports to provide “four reasons” why the Board should exercise discretion and institute trial on both petitions. None is valid.

First, Petitioner claims both petitions have “compelling merits.” IPR2023-01396, Paper 2 at 2-3. But that is not a standard for instituting multiple petitions, especially where one should be denied under 35 U.S.C. § 325(d). *See* CTPG at 59. Indeed, Petitioner argues that Stafford (1396 primary reference) and Thomas-005 (1397 primary reference) are essentially interchangeable because both disclose the same features of an “on-body unit.” *Id.* at 2. For purposes of its petitions, however, Petitioner does not identify any difference between Stafford and Thomas-005, much less a material one, that warrants institution on both petitions. Petitioner also concedes that both primary references are combined with the same “main secondary references”—Raymond and Turner. *Id.* at 2-3. Thus, Petitioner has not justified the need for two petitions for merits reasons either. *CommScope Tech. v. Dali Wireless*, IPR2020-01409, Paper 10 at 7 (P.T.A.B. Feb. 10, 2021) (denying second petition

and explaining that, “[e]ven though Patent Owner attempts to remove Lemson as prior art [in the second-ranked petition],” “Petitioner does not explain why the differences between the prior art applied in the two petitions are material”).

Second, Petitioner argues that, “if only the Thomas-based [1397 Petition] 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 [alleged] meritorious Stafford-based [1396 Petition] would never be fully considered by the Board.” IPR2023-01396, Paper 2 at 3. This is not a valid concern because Patent Owner has disputed that Thomas-005 is not prior art in its Preliminary Response. It is not waiting until “after institution.”

Third, Petitioner claims that if Thomas-005 is shown to be prior art, “then only three prior art references render all claims obvious.” *Id.* Petitioner argues that “[the 1396 Petition], on the other hand, relies on six prior art references,” and that, “while [the 1396 Petition] presents meritorious obviousness arguments, [the 1397 Petition] presents simpler and less numerous combinations.” *Id.* This argument makes no sense. If the Board were to institute two trials, and in the unlikely event Thomas-005 is found to be prior art, then **nine** references will be at issue, not three or six. Thus, whether one petition is “simpler” or not is irrelevant because Petitioner advocates for institution on both petitions. And despite claiming that the Thomas-based 1397 Petition is “simpler,” it is noteworthy that Petitioner ranked it second.

Finally, Petitioner argues that the 1397 Petition “adds only a minimal amount of additional work” because it “relies on a different primary reference but otherwise relies on two of the secondary references (Raymond and Turner) and similar principles of combination.” *Id.* at 3-4. If that were true, it merely confirms that the two petitions are largely duplicative. That is even more of a reason not to institute on the second petition, especially because Petitioner failed to identify any differences between the references relevant to the petitions. *CommScope*, IPR2020-01409, Paper 10 at 7.

Accordingly, Petitioner failed to explain how resurrecting a settled issue qualifies as a “rare” situation that warrants trial on two petitions. As such, the Board should not institute trial on the lower-ranked 1397 petition, even if it denies institution on the 1396 for the reasons argued in the Preliminary Response.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that Patent Owner's Response To Petitioner's Explanation Of Material Differences Between Petitions was served on this 18th day of January, 2024 by electronic mail to the following:

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