

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DEXCOM, INC.,
Petitioner,

v.

ABBOTT DIABETES CARE INC.,
Patent Owner.

IPR2023-01409
Patent 11,202,591 B2

Before JOHN G. NEW, RYAN H. FLAX, and CYNTHIA M. HARDMAN,
Administrative Patent Judges.

HARDMAN, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On January 30, 2024, Petitioner emailed the Board requesting authorization to file a 5-page reply to Patent Owner’s Preliminary Response (Paper 6), for the purpose of addressing “the arguments for Section 325(d) discretionary denial at pages 1–30 of the Patent Owner Preliminary Response.” *See* Ex. 3001 (email correspondence).

Section 325(d) provides that a petition may be rejected if “the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). The Board analyzes this issue under a two-part framework:

- (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office;
- and (2) if either condition of [the] first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”).

Petitioner stated that good cause exists for a reply at least because Patent Owner’s arguments under Section 325(d) “were not foreseeable given that the prior art references presented by the Petition, and any alleged substantially similar references, were never discussed on the record during original prosecution and only appeared on a 62-page IDS submission that included over 1,000 references.” Ex. 3001. Patent Owner responded that Petitioner’s request should be denied because “[i]f a reply is authorized, it would allow Petitioner to substantially exceed the word count limit to address a foreseeable issue that it should have addressed in the Petition.” *Id.*

Patent Owner argued that its arguments under Section 325(d) in its Preliminary Reply were both foreseeable and actually foreseen by Petitioner, because “the Petition expressly acknowledged that all of the asserted references (or a materially identical counterpart) were cited during prosecution, and Petitioner cited § 325(d) while arguing that was somehow insufficient for discretionary denial.” *Id.*

On February 2, 2024, Administrative Patent Judges New, Flax, and Hardman participated in a conference call with counsel for the parties to discuss Petitioner’s request. A court reporter was present on the call, and a transcript of the call is of record. *See* Ex. 1043.

During the call, Petitioner further argued, among other things, that good cause exists for a reply because Patent Owner’s arguments regarding Section 325(d) were not foreseeable. *See id.* at 6:20–9:20. Petitioner contended Patent Owner’s arguments were not foreseeable because the Examiner did not meaningfully analyze Petitioner’s prior art references during prosecution, and Patent Owner only pointed to the references’ inclusion in an Information Disclosure Statement (“IDS”) signed by the Examiner as proof that the references were presented to the Office. *See id.* at 7:12–8:6.

Patent Owner opposed Petitioner’s request, arguing, among other things, that Petitioner cannot show good cause because Petitioner (1) was aware that the references it cited in the Petition were included in an IDS; (2) actually addressed the first prong of the Section 325(d) analysis described in *Advanced Bionics*, and (3) should have addressed the second prong of the Section 325(d) analysis described in *Advanced Bionics* in its Petition. *See id.* at 13:4–14:3.

Pursuant to 37 C.F.R. § 42.108(c), a petitioner may seek leave to file a reply to the preliminary response, but is required to “make a showing of good cause.” After hearing and considering all of the parties’ arguments presented in the email and during the conference call (*see* Exs. 3001, 1043), we are not persuaded that, under the circumstances, Petitioner has established good cause for authorization to file a reply.

Petitioner was on notice prior to filing its Petition that, by statute, consideration may be given to whether the prior art or arguments presented in the Petition are the same, or substantially the same, as those previously raised during prosecution. 35 U.S.C. § 325(d). Petitioner acknowledged that certain of Petitioner’s asserted prior art references were identified on the face of an IDS submitted to the Office, and Patent Owner’s Preliminary Response confirmed the same. *See* Pet. 5 (Paper 2); Prelim. Resp. 1–22.

Given that *Advanced Bionics* states that for purposes of analyzing Section 325(d), “[p]reviously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent,” and that Petitioner’s statements in the Petition concede that the first prong of *Advanced Bionics* is met here, we find that an analysis of the second *Advanced Bionics* prong concerning Section 325(d) should have been contemplated and could have been addressed by Petitioner in the Petition. *See Advanced Bionics*, Paper 6 at 7–8. Therefore, we deny Petitioner’s request to file a reply to Patent Owner’s Preliminary Response.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s request for additional briefing is *denied*.

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