

From: [Andrew M. Mason](#)
To: [Trials](#)
Cc: [IPR2023-01409](#); [David Petty](#); [Alexa Johnston](#); [Michael J. Loy](#); [Todd M. Siegel](#); [Derrick W. Toddy](#); [John D. Vandenberg](#); [Stephanie R. Fulk](#)
Subject: IPR2023-01409 DexCom, Inc. v. Abbott Diabetes Care Inc.
Date: Tuesday, January 30, 2024 4:51:50 PM
Attachments: [image001.png](#)
[image002.png](#)

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Dear Honorable Board,

In IPR2023-01409, Petitioner DexCom respectfully requests leave to file a 5-page reply to the arguments for Section 325(d) discretionary denial at pages 1-30 of the Patent Owner Preliminary Response (“POPR”, Paper 6). Petitioner understands that “[a]ny such request must make a showing of good cause.” 37 C.F.R. § 42.108. Good cause exists at least because these POPR arguments 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. No rejections were made during original prosecution. Thus, it was “not reasonable to expect Petitioner to ... predict the arguments that might be made by Patent Owner and preemptively address those arguments in the Petition.” *Masimo Corp. v. Apple Inc.*, IPR2023-00634, Paper 11 at 4 (PTAB Jul. 31, 2023) (allowing reply to the POPR in IPR2023-00634, where “over 600 references were identified during prosecution”); *see also id.*, 6 (denying reply in IPR2023-00635, where petitioner “overlooked that the Examiner applied [an IPR reference] during prosecution”).

Undersigned counsel for Petitioner conferred telephonically and by email with lead counsel for Patent Owner Abbott, which raised arguments against a reply in its Preliminary Response (Paper 6, pages 30-32) and opposes this request.

Should a conference call be necessary, counsel for the parties can be available at the following times:

- January 31, 11am-6pm Eastern
- February 2, noon-6pm Eastern
- February 5, 1-2pm and 2:30-6pm Eastern

Patent Owner’s Position on Petitioner’s Request

If the Board does not reject Petitioner’s request for authorization to file a reply based on the arguments in the POPR, then Patent Owner respectfully requests a conference call to explain why Petitioner lacks good cause for a reply. As Petitioner notes, Patent Owner provided arguments for discretionary denial in the POPR. In contrast, Petitioner, after having used nearly all of its allotted words in the Petition without addressing the second prong of *Advanced Bionics*, makes improperly substantive argument in this email and seeks even more words for argument in a reply. If 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. The *Masimo* decision cited by Petitioner supports denying a reply because, here, 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. Therefore, not only was the issue foreseeable, Petitioner foresaw it. *See Masimo Corp. v. Apple Inc.*, IPR2023-00634, Paper 11 at 5-9 (PTAB Jul. 31, 2023) (**denying** request for pre-institution reply in IPR2023-00635 to address 325(d) because “it was reasonably foreseeable that Patent Owner would present § 325(d) arguments regarding the Petition’s

discussion (or lack thereof) of any alleged error [by the Examiner]" and therefore "the Petition should have addressed the second prong of *Advanced Bionics*"; *compare id.* at 4 (granting request for pre-institution reply in IPR2023-00634 to address 325(d) where POPR unexpectedly argued that certain petition-asserted references are cumulative to other unrelated prosecution-cited references; *see also id.*, Paper 8 at 29-34 (POPR arguing similarities of petition-asserted references to prosecution-cited references)).

Should the Board grant Petitioner's request for a reply, Patent Owner respectfully requests a sur-reply of equal length.

Respectfully submitted,

Andy Mason
Counsel for Petitioner, DexCom, Inc.



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