

1 UNITED STATES PATENT AND TRADEMARK OFFICE
2 BEFORE THE PATENT TRIAL AND APPEAL BOARD

4 DEXCOM, INC.

5 Petitioner

6 v.

7 ABBOTT DIABETES CARE INC.

8 Patent Owner

10
11 CASE NO. IPR2023-01409

12 U.S. PATENT NO. 11,202,591

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15 CONFERENCE CALL BEFORE THE PATENT TRIAL AND
16 APPEAL BOARD
17 BEFORE JUDGE CYNTHIA HARDMAN
18 OCTOBER 17, 2024

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22 Reported by: Sandra A. Deschaine, CSR, RPR,
23 CLR, CRA
24

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P R O C E E D I N G S

JUDGE HARDMAN: So I understand that there is a deposition going on, and I believe it's the Patent Owner who has the complaint.

So, Mr. Hansen, if you'd like to begin.

MR. HANSEN: Yeah. So Mr. Mason is deposing our expert Mr. Leinsing, and over the course of the deposition he's asked a lot of questions about the knowledge of a person of ordinary skill in the art beyond the prior art that Dexcom, the Petitioner, has identified in the petition and in their expert declarations, very open-ended questions about what a person of ordinary skill in the art would know well beyond the scope of any prior art that's been identified.

And in the context of that, he solicited testimony about commercial products that were available at different points in time. These commercial products are nowhere

1 mentioned in any of the materials of
2 record. But Dexcom's counsel,
3 Petitioner's counsel insists on
4 continuing to examine the witness about
5 his knowledge of these commercial
6 products.

7 We think that's inappropriate;
8 it's beyond the scope of -- it's not in
9 Mr. Leinsing's declaration. It's beyond
10 the scope of proper cross-examination.
11 It's also beyond the scope of a
12 proceeding such as this where prior art
13 is limited to publications and things
14 such as commercial products are not to
15 be at issue.

16 So we're seeking relief in the
17 form of a protective order that
18 Petitioner's counsel should not examine
19 the witness about commercial products
20 that are not of record, that are beyond
21 the scope of the petition, petitioner's
22 declarations, and Mr. Leinsing's
23 declaration.

24 JUDGE HARDMAN: Can you just

1 repeat that again, please? So you're
2 seeking a protective order to prohibit
3 questions about commercial products that
4 are not mentioned in the expert's
5 declaration. Is that correct?

6 MR. HANSEN: Yes. They're not
7 mentioned in the petition. They're not
8 mentioned in Petitioner's declarations,
9 and they're not mentioned in
10 Mr. Leinsing's declaration. They're
11 not -- let's put it this way: They're
12 not mentioned in any of the pleadings or
13 declarations or anything of record in
14 this IPR.

15 JUDGE HARDMAN: Okay. Do you have
16 anything else to add at this point?

17 MR. HANSEN: Not at this point.

18 JUDGE HARDMAN: Thank you,
19 Counsel. Let me turn it over to
20 Mr. Mason. Please go ahead with your
21 response.

22 MR. MASON: Yes, Your Honor.

23 So the declarant today -- sorry --
24 the witness today was -- I asked

1 questions about the knowledge of a
2 skilled artisan, and in response to a
3 question about what skilled artisans
4 would know about insertion of continuous
5 glucose monitoring sensors, which is the
6 subject of the dispute or subject of the
7 challenged patent here, the witness,
8 unprompted, identified what he
9 characterized as prior art products, and
10 specifically the Abbott Navigator
11 product and the Dexcom product.

12 I sought to ask him questions
13 about whether -- what POSITAs knew about
14 those products and whether skilled
15 artisans knew about those products. And
16 our position is that's -- the knowledge
17 of a POSITA about prior art devices and
18 the knowledge of CGM devices and CGM
19 insertion generally is highly relevant
20 to these issues -- the issues in this
21 IPR because it's the perspective of a
22 POSITA that informs how the prior art is
23 understood.

24 So we're not seeking free-ranging

1 questions on any of these different
2 products, but he identified these as
3 prior art products, and we think it's
4 fair game to ask him whether skilled
5 artisans knew about these products and
6 what they knew about the products,
7 because that reflects the knowledge of a
8 skilled artisan. And it's probably also
9 worth noting that he discusses many
10 other commercial products at length in
11 his declaration, not these ones in
12 question but many other ones.

13 Thank you.

14 MR. HANSEN: So, Judge Hardman, is
15 it appropriate for me to respond?

16 JUDGE HARDMAN: Yes, Mr. Hansen,
17 please respond.

18 MR. HANSEN: So the only
19 commercial products that are identified
20 in Mr. Leinsing's declaration are
21 products that he discusses relevant to
22 the issue of commercial success and
23 objective indicia of nonobviousness.
24 There are no other commercial products

1 mentioned in his declaration, and this
2 product that Mr. Mason wants to examine
3 the witness about is nowhere mentioned
4 in the declaration.

5 As we all know, prior art in these
6 proceedings is limited to paper art, not
7 product art, and -- but these questions
8 that Mr. Mason -- these open-ended
9 questions about any and all prior art,
10 where he's not limiting the questions to
11 paper art but asking open-ended
12 questions that would encompass all types
13 of prior art, I believe that those
14 questions are improper.

15 And in asking such questions, he
16 induced the witness to mention a couple
17 of commercial products. The witness did
18 not say that those commercial products
19 were prior art, but he did mention some
20 commercial products when Mr. Mason
21 insisted on asking broad, open-ended
22 questions that were not limited to paper
23 art. And now it appears that he wants
24 to use this as an opening to try to make

1 at issue product art, which is not
2 appropriate, and there's no issue in
3 this IPR to which these commercial
4 products are relevant.

5 They have not identified these
6 commercial products in any way relevant
7 to any of the issues in this case.

8 Their declarants have not said that
9 these products are relevant to the
10 knowledge of a person of ordinary skill
11 in the art. This is all based on the
12 fact that by asking broad, open-ended,
13 unlimited questions to the witness that
14 were not limited to the prior art at
15 issue, that he was able to get the
16 witness to mention a couple of
17 commercial products.

18 MR. MASON: And, Your Honor, if I
19 may, when you're ready.

20 JUDGE HARDMAN: Is that Mr. Mason?

21 MR. MASON: Yes, this is
22 Mr. Mason. I apologize.

23 JUDGE HARDMAN: Yes. Go ahead.

24 MR. MASON: I mean, first off, I

1 think that mischaracterizes the
2 questions. I don't think any specific
3 question has been identified here by
4 Mr. Hansen. The questions were as to
5 the knowledge of a POSITA; they were
6 not free-ranging as to any and all
7 prior art. I don't even know that I
8 mentioned prior art in my questions as
9 to what a skilled artisan would know in
10 this field. They're all directed to
11 skilled artisan.

12 And the witness discussed a
13 particular product, and I followed up to
14 ask whether that particular product
15 was -- whether a skilled artisan knew of
16 that particular product and that's what
17 led to this dispute.

18 JUDGE HARDMAN: Thank you.

19 Counsel, I think, generally, our
20 depositions should be, you know,
21 directed to the subject matter of the
22 expert's declaration. Now, it does
23 get -- you know, it can get sticky
24 because I'm sure that the declaration

1 talks about the general knowledge of the
2 person of ordinary skill in the art.
3 And in asking questions about that, I
4 can see how sometimes commercial
5 products or other materials that are not
6 specifically mentioned in the
7 declaration can become of record, and
8 that sounds like maybe that has happened
9 here.

10 I do understand that -- it sounds
11 like to me that the witness offered or
12 injected these products in response to
13 perhaps a broad question, but our
14 rules -- we don't have specific rules
15 regarding the scope of the questions.

16 So, you know, I think the panel
17 here is not prepared to make any
18 direction to Petitioner's counsel
19 regarding a more narrow or directed
20 question. I don't think we have enough
21 information at this point to make that
22 kind of ruling.

23 I think, in general, the witness
24 should answer the questions to the best

1 of his ability, and should there be any
2 information of record that -- I think
3 what we should do is just continue the
4 deposition. Counsel on both sides
5 should be mindful of the scope that
6 should be, you know, tethered to the
7 subject matter of the declaration, which
8 I think I already said also includes
9 knowledge of the person of ordinary
10 skill in the art that may go a little
11 bit beyond what is expressly mentioned
12 in the declarations.

13 Now, if there are concerns about
14 injections of prior art products that
15 are not admitted prior art or that are
16 not pertinent here because they were
17 not -- because they are not proper
18 subject matter for an inter partes
19 review, being that they're actual
20 commercial products and not information
21 in printed publications of record.
22 That we can handle later down the line.

23 Patent owner's counsel can
24 approach the Board and ask for

1 authorization to file a motion to strike
2 or perhaps a motion to exclude would be
3 appropriate, depending on when and if
4 the information developed at this
5 deposition makes its way into a paper of
6 record and needs to be addressed at that
7 time.

8 Let me just pause there and see,
9 with that sort of general guidance,
10 Mr. Hansen, do you have any further
11 commentary at this point?

12 MR. HANSEN: Well, I appreciate
13 Your Honor indicating that to the extent
14 Petitioner tries to make these
15 commercial products somehow prior art
16 under consideration, that a motion to
17 strike or to exclude may be appropriate,
18 we'll certainly take that under
19 consideration as the proceedings
20 continue.

21 But this is, in my opinion, well
22 beyond the scope of Mr. Leinsing's
23 declaration. It's well beyond the scope
24 of proper examination, but I understand

1 that Your Honors has had a limited set
2 of information and don't have a complete
3 record of this deposition in front of
4 you, so we'll proceed according with
5 your instructions.

6 JUDGE HARDMAN: Okay. Thank you,
7 Mr. Hansen.

8 I think, then, we can all -- all
9 are in agreement that the deposition
10 will continue to go forward with the
11 general guidelines that we just
12 discussed.

13 Is there anything else that either
14 party would like to add before we
15 adjourn?

16 MR. MASON: The Board's -- this is
17 Andrew Mason, counsel for Petitioner.

18 The Board's guidance makes --
19 makes sense to me, if I understand it.
20 And we will proceed accordingly.

21 One other issue that I just
22 wanted to raise briefly is, just a
23 confirmation that speaking objections
24 are not allowed under PTAB rules.

1 Throughout this deposition counsel for
2 Patent Owner has objected as to form,
3 which is fine, but then has added things
4 such as asked and answered, and other
5 speaking objections. And I would like
6 to confirm with the panel that those
7 types of speaking objections are
8 prohibited.

9 I've raised this with Mr. Hansen.
10 He appears to -- I'm not sure if he
11 disagrees, but he's continued doing it.
12 So I wanted to raise that with the Board
13 right now since we are here so I don't
14 have to call again.

15 MR. HANSEN: So would you like me
16 to respond to that?

17 JUDGE HARDMAN: So let me start
18 with the caveat that our trial practice
19 guide has an Appendix Z, Testimony
20 Guidelines, and we have an express
21 paragraph there that talks about what is
22 a proper objection. Objection should be
23 limited to a single word or term, such
24 as objection, form; objection, hearsay;

1 objection relevance, et cetera, and that
2 beyond that statements suggest as answer
3 to a witness are prohibited.

4 So objection, vague, or objection,
5 take your time answering the question;
6 or objection, read the document before
7 you answer, are off limits. So anything
8 that veers from -- that can veer into
9 coaching is prohibited, and you should
10 stick to a one-word objection that
11 surrounds the Federal Rules of Evidence
12 that makes the question inappropriate.

13 And with that, go ahead,
14 Mr. Hansen, with your response.

15 MR. HANSEN: So thank you for
16 that, reminding us of that. I believe
17 that my objections have been consistent
18 with that guideline and that
19 instruction. They've also been
20 consistent with objections that
21 Mr. Mason made last week at a deposition
22 in a separate IPR between these same
23 parties.

24 But Mr. Mason's concern about this

1 seemed to rise at the start of the
2 deposition, because Mr. Mason was
3 engaging in behavior that I consider
4 highly inappropriate. After the court
5 reporter had sworn the witness, as is
6 her responsibility, he then started the
7 deposition in an attempt -- in an
8 apparent attempt to intimidate the
9 witness by saying: Now, Mr. Leinsing,
10 are you going to tell the truth today?
11 Are you going to give accurate testimony
12 today?

13 He had just sworn under oath that
14 he was going to tell the truth and give
15 accurate testimony. There was no
16 purpose for those questions, other than
17 to intimidate the witness. That, I
18 believe, is highly objectionable and
19 inappropriate.

20 I don't think that any judge that
21 I'm familiar with would allow an
22 attorney, after the witness has been
23 sworn, to then proceed to question the
24 witness about whether or not they intend

1 to tell the truth and whether or not
2 they intend to give accurate testimony.

3 So I did object at that point in
4 time, and I did, in objecting, explain
5 why I thought it was inappropriate, but
6 since that time my objections have been
7 limited to one or two words, and they're
8 not coaching.

9 JUDGE HARDMAN: Okay.

10 MR. MASON: If I may. Anyway, I
11 don't want to belabor this point, Your
12 Honor, but I respectfully disagree.

13 First of all, that was not the
14 only instance in which there were
15 multiple word objections, but I think,
16 as to the specific instance he referred
17 to, since the witness who has been
18 deposed 60 times, all I was doing was
19 confirming that there was nothing that
20 would impair his ability to testify
21 truthfully or impair his ability to
22 testify accurately. And so I was
23 setting that up. I think we're through
24 that, but I think, more importantly, as

1 to the substantive testimony, I just
2 want to make sure there are no talking
3 objections.

4 MR. HANSEN: So to be clear,
5 Mr. Mason --

6 JUDGE HARDMAN: This is Judge
7 Hardman. Let me jump in here.

8 As a general matter, there is no
9 prohibition on the questioning attorney
10 asking questions designed to ensure that
11 the witness intends or will testify
12 truthfully, accurately, and that there's
13 nothing preventing the witness from
14 doing so.

15 Now, of course, I completely
16 understand that the tone that the
17 questioner is asking these questions can
18 make a permitted question feel like it
19 goes over the line. So I'm going to
20 counsel and warn both parties that
21 witness intimidation will not be
22 tolerated. So please watch your tone
23 when you're asking questions; and if
24 there's objection, it must be stated

1 succinctly with one word, as I already
2 said, and anything further than that, if
3 counsel wish to argue about the
4 propriety of objection, should be done
5 outside of the presence of the witness,
6 if needed, so that there's no witness
7 coaching or potential witness coaching
8 or accusations of witness coaching going
9 on, if there needs to be more
10 explanation of an objection.

11 So with that, counsel, please
12 remind yourselves of our testimony
13 guidelines. Objections should be
14 limited to a single word or term. There
15 should be no further explanation or
16 coaching that is part of that, and there
17 should only be further explanation of an
18 objection if the other side asks for it
19 on the record.

20 Now, back to the original dispute
21 that was raised. I want to remind
22 counsel that if you intend to -- if
23 there's a question that you think is
24 improper and that you want later for a

1 motion to strike or motion to exclude,
2 please remember to make your objection
3 on the record so that we have that in
4 front of us at a later time if needed.

5 With that, give me a moment, I'm
6 going to put the parties on hold and
7 confer with the panel.

8 MR. MASON: Thank you.

9 (Pause in proceedings.)

10 JUDGE HARDMAN: Okay. Counsel, we
11 are back. I almost hesitate to do this,
12 before we adjourn, anything else to add?

13 MR. MASON: Nothing from
14 Petitioner, Your Honor.

15 MR. HANSEN: Nothing from Patent
16 Owner.

17 JUDGE HARDMAN: Okay. Thank you,
18 Counsel, and have a good day. We are
19 adjourned.

20 MR. MASON: Thank you for your
21 time today.

22 JUDGE HARDMAN: Oh, I'm sorry.
23 Before we adjourn, when the transcript
24 of this phone conversation is complete,

1 would one of the parties please file it
2 as an exhibit?

3 MR. MASON: Yes, Your Honor. This
4 is Petitioner. We've commissioned the
5 court reporter, so we will try and
6 coordinate with her to get a separate
7 transcript corresponding to this call.

8 JUDGE HARDMAN: Okay.

9 MR. MASON: And then file that.
10 Okay.

11 JUDGE HARDMAN: Okay. Thank you.
12 Goodbye.

13 MR. MASON: Thank you.

14 (Conference call concluded at 11:31 a.m.)
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1 COMMONWEALTH OF MASSACHUSETTS

2 SUFFOLK, SS

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4 I, Sandra A. Deschaine, Registered
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