

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DEXCOM, INC.,
Petitioner,

v.

ABBOTT DIABETES CARE INC.,
Patent Owner.

Case IPR2023-01409
Patent 11,202,591

**JOINT MOTION TO TERMINATE
PROCEEDING UNDER 35 U.S.C. § 317(a)**

EXHIBIT LIST

LIST OF NEWLY FILED EXHIBITS

Exhibits concurrently filed with Joint Motion To Terminate Proceeding Under
35 U.S.C. § 317(a):

No.	Description
1069	Confidential Settlement And Patent License Agreement

LIST OF PREVIOUSLY-FILED EXHIBITS

Petitioner previously filed the following exhibits:

No.	Description
1001	U.S. Patent No. 11,202,591 (“ 591 patent ”)
1002	File History of U.S. Patent No. 11,202,591
1003	Declaration of Dr. Gary D. Fletcher, dated October 10, 2023 (“ Fletcher Decl. ”)
1004	U.S. Publication No. 2008/0097246 (“ Stafford ”)
1005	U.S. Publication No. 2005/0101932 (“ Cote ”)
1006	U.S. Publication No. 2007/0073129 (“ Shah ”)
1007	U.S. Publication No. 2007/0135774 (“ Turner ”)
1008	U.S. Patent No. 6,175,752 (“ Say ”)
1009	U.S. Publication No. 2009/0124979 (“ Raymond ”)
1010	U.S. Publication No. 2006/0095014 (“ Ethelfeld ”)
1011	PCT Publication No. WO2008/155377 (“ Hasted ”)
1012	U.S. Publication No. 2009/0076360 (“ Brister-360 ”)

No.	Description
1013	U.S. Publication No. 2006/0155180 (“ Brister-180 ”)
1014	U.S. Publication No. 2004/0133164 (“ Funderburk-164 ”)
1015	U.S. Patent No. 6,560,471 (“ Heller ”)
1016	U.S. Patent No. 6,579,690 (“ Bonnecaze ”)
1017	U.S. Publication No. 2003/0225373 (“ Bobroff-373 ”)
1018	U.S. Publication No. 2009/0240121 (“ Bickoff ”)
1019	PCT Publication No. WO2008/114223 (“ Pesach ”)
1020	U.S. Publication No. 2004/0002682 (“ Kovelman ”)
1021	U.S. Patent No. 7,381,184 (“ Funderburk ”)
1022	<i>intentionally left blank</i>
1023	<i>intentionally left blank</i>
1024	<i>intentionally left blank</i>
1025	U.S. Publication No. 2008/0319414 (“ Yodfat-414 ”)
1026	U.S. Patent No. 7,207,974 (“ Safabash ”)
1027	U.S. Publication No. 2004/0204687 (“ Mogensen-687 ”)
1028	U.S. Publication No. 2002/0022855 (“ Bobroff-855 ”)
1029	U.S. Patent No. 9,566,384 (“ Gyrn ”)
1030	U.S. Patent No. 8,747,363 (“ Nielsen ”)
1031	U.S. Publication No. 2007/0093754 (“ Mogensen-754 ”)
1032	<i>intentionally left blank</i>
1033	<i>intentionally left blank</i>
1034	Steven W. Smith, <i>The Scientist and Engineer’s Guide to Digital Signal Processing</i> (2nd ed. 1999) (excerpted)

No.	Description
1035	B.A. Shenoi, <i>Introduction to Digital Signal Processing and Filter Design</i> (2006) (excerpted)
1036	U.S. Publication No. 2009/0099521 (“ Gravesen ”)
1037	U.S. Publication No. 2009/0216215 (“ Thalmann ”)
1038	U.S. Publication No. 2008/0255440 (“ Eilersen ”)
1039	Scheduling Order, <i>Abbott Diabetes Care Inc. v. DexCom Inc.</i> , No. 1-23-cv-00239 (D. Del. filed Mar. 3, 2023)
1040	PCT Publication No. WO2008/115409 (“ Brenneman ”)
1041	Statement of Defense (Counterclaim), <i>Dexcom Inc. v. Abbott Diabetes Care Inc.</i> , Case No. 21 O 6562/23 (Munich D. Ct. I), Sept. 1, 2023
1042	U.S. Publication No. 2008/0114280 (“ Stafford-280 ”)
1043	Transcript of Telephone Conference Call dated February 2, 2024
1044	Transcript of Deposition of Karl R. Leinsing, dated October 17, 2024
1045	Second Declaration of Gary D. Fletcher, Ph.D., dated October 25, 2024
1046	Abbott FreeStyle Navigator Continuous Glucose Monitoring System User’s Guide dated May 2008
1047	Neil T. Clancy, <i>et al.</i> , <i>A New Device for Assessing Changes in Skin Viscoelasticity Using Indentation and Optical Measurement</i> , Skin Research and Technology (2010) (“ Clancy ”)
1048	Alvin H. Sacks, Ph.D., <i>et al.</i> , <i>Skin Blood Flow Changes and Tissue Deformations Produced by Cylindrical Indentors</i> , Journal of Rehabilitation Research and Development Vol. 22 No. 3 (July 1985) (“ Sacks ”)
1049	<i>intentionally left blank</i>
1050	Cleo90 Infusion Set Training Guide (from Wayback Machine)

No.	Description
1051	Food and Drug Administration approval of Cleo90 Infusion Set dated October 7, 2004
1052	“Diabetes Patents,” printed on October 21, 2024 from https://www.abbott.com/patents/diabetes-patents.html
1053	Photographs showing patent marking on CLEO90 device
1054	DexCom STS Continuous Glucose Monitoring System User’s Guide (from Wayback Machine)
1055	Declaration of Mung Conway, Paralegal, dated October 25, 2024
1056	Medtronic Guardian REAL-Time Features and Components, from Wayback Machine, available at https://web.archive.org/web/20071025084715/http://www.medtronicdiabetes.com/products/guardian/features.html , https://web.archive.org/web/20071013095355/http://www.medtronicdiabetes.com/products/guardian/components.html
1057	U.S. Publication No. 2004/0186365 (“ Jin ”)
1058	U.S. Patent No. 7,731,691 (“ Cote Patent ”)
1059	Amendment and Response filed January 7, 2008, from Cote File History for U.S. Patent No. 7,731,691
1060	U.S. Patent No. 10,827,954 (“ 954 patent ”)
1061	U.S. Patent No. 11,298,056 (“ 056 patent ”)
1062	“Answers to Frequently Asked Questions,” Freestyle Navigator System, from Wayback Machine, available at
1063	U.S. Patent No. 7,585,287 (“ Bresina Patent ”)
1064	U.S. Publication No. 2005/0283114 (“ Bresina ”)
1065	Code of Federal Regulations (2007) 29 C.F.R. § 1910.1030, Bloodborne pathogens
1066	FDA 510(k) Premarket Notification page for CLEO90

No.	Description
1067	Smiths Medical Cleo90 Infusion Set Product Literature, available at https://web.archive.org/web/20220816002119/https://www.smiths-medical.com/-/media/M/Smiths-medical_com/Files/Import-Files/Product-Literature/IN193873GB-092019_LR.pdf
1068	Conference Call Dated October 17, 2024

Petitioner DexCom, Inc. (“DexCom”) and Patent Owner Abbott Diabetes Care Inc. (“Abbott”) (collectively “the parties”) jointly move to terminate IPR2023-01409 under 35 U.S.C. § 317(a). The Board authorized the filing of this motion on January 3, 2025.

I. BACKGROUND AND RELATED IPR PROCEEDINGS

A joint motion to terminate generally must “(1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26 at 2 (P.T.A.B. July 28, 2014). Each of these background issues is discussed below in turn.

The parties have entered into a Confidential Settlement And Patent License Agreement (the “Settlement Agreement”).¹ This agreement is a true copy of an “agreement or understanding ... including any collateral agreements ... made in

¹ The parties are filing the Settlement Agreement concurrently with this joint motion as Exhibit 1069, along with a “Joint Request to Treat Settlement Agreement as Business Confidential Information.” Petitioner’s Updated Exhibit List, above, includes this document.

connection with, or in contemplation of, the termination of” this inter partes review. 35 U.S.C. § 317(b). There are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding. The parties both believe that this proceeding should be terminated. No Final Written Decision is expected in this proceeding for approximately three more months.

Patent Owner asserted the patent at issue in this proceeding in *Abbott Diabetes Care Inc. et al. v. DexCom, Inc.*, No. 1:23-cv-00239 (D. Del). The parties have filed a joint stipulation to dismiss the district court litigation. There is no other pending litigation related to the patent at issue in this proceeding.

The following IPRs between the same parties have also been instituted and relate to patents that were asserted in the same district court litigation referenced above: IPR2023-01251 and IPR2024-00521. The parties are moving to terminate or dismiss the IPRs referenced above.

II. STATEMENT OF RELIEF REQUESTED

Under § 317(a), an *inter partes* review “***shall*** be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” The parties jointly request termination of this IPR2023-01409, and the Office has not decided the merits of this IPR proceeding. There are no other

preconditions of § 317(a). Therefore, the parties have met the statutory requirement to terminate the proceeding before the Office has decided the merits of the proceeding, and good cause exists to terminate this proceeding. *See* 35 U.S.C. § 317(a).

III. CONCLUSION

For these reasons, the parties respectfully request termination of this IPR.

Respectfully submitted,

Dated: January 3, 2025

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CERTIFICATE OF SERVICE
IN COMPLIANCE WITH 37 C.F.R. § 42.6 (E)(4)

The undersigned certifies that on January 3, 2025, a complete copy of the
JOINT MOTION TO TERMINATE PROCEEDING UNDER 35 U.S.C. §
317(a) was served on counsel for Patent Owner via electronic mail as follows:

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