

Filed on behalf of: Abbott Laboratories and Abbott Diabetes Care Inc.

Entered: May 24, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ABBOTT LABORATORIES and
ABBOTT DIABETES CARE INC.,
Petitioner,

v.

ALTIVERA, LLC,
Patent Owner.

Case IPR2024-00425
Patent 7,969,307 B2

**PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

TABLE OF CONTENTS

I.	The Board Should Not Exercise Discretion Under § 325(d).....	1
A.	Grounds 1 and 2: The Petition showed that the Examiner erred by failing to substantively consider Bandy	1
B.	Ground 3: Beck was not disclosed during prosecution and discloses the limitation that the Examiner found patentable	2
II.	Bandy Is Prior Art Under 35 U.S.C. 102(e)	3
A.	There is a reasonable likelihood that Dr. Bandy contributed to the portions of Bandy relied on in the Petition	4
B.	PO's Declarations Do Not Resolve The Dispute	6
C.	PO's Cases Are Inapposite	6
III.	Conclusion	7

TABLE OF AUTHORITIES**Page(s)****CASES**

<i>Advanced Bionics, LLC v. Med-El Elektromedizinische Gerate GmbH,</i> IPR2019-01469, Paper 6 (Feb. 13, 2020)	1
<i>Fusion Orthopedics, LLC v. Extremity Med., LLC,</i> IPR2023-00894, Paper 15 (Nov. 17, 2023)	1
<i>In re Katz,</i> 687 F.2d 450 (C.C.P.A. 1982)	7
<i>LSI Corp. v. Regents of the Univ. of Minn.,</i> IPR2017-1068, Paper 58 (Apr. 14, 2021)	7
<i>MaxLinear, Inc. v. Cresta Tech. Corp.,</i> IPR2015-00594, Paper 13 (Aug. 21, 2015)	4
<i>Miltenyi Biomedicine GmbH v. Tr. of the Univ. of Pa.,</i> IPR2022-00853, Paper 11 (Oct. 11, 2022)	7
<i>Nelson Prods., Inc. v. Bal Seal Eng'g, Inc.,</i> IPR2014-00572, Paper 10 (Sept. 29, 2014)	4
<i>R.J. Reynolds Vapor Co. v. Altria Client Servs. LLC,</i> IPR2021-00793, Paper 7 (Oct. 27, 2021)	7
<i>Sanofi-Aventis U.S. LLC v. Immunex Corp.,</i> IPR2017-01879, Paper 88 (Feb. 14, 2019)	7
<i>Trend Micro Inc. v. CUPP Computing AS,</i> IPR2021-00813, Paper 7 (Oct. 25, 2021)	2

STATUTES

35 U.S.C. § 102(e)	3, 4
35 U.S.C. § 325(d)	1, 2, 3

Exhibit List

Ex.	Description
1001	U.S. Patent No. 7,969,307 B2 (“’307 patent”)
1002	File History of U.S. Patent No. 7,969,307 B2 (“’307 FH”)
1003	Declaration of Majid Sarrafzadeh (“Sarrafzadeh Decl.”)
1004	<i>Curriculum Vitae</i> of Majid Sarrafzadeh
1005	U.S. Patent No. 7,148,803 B2 (“Bandy”)
1006	U.S. Utility Patent Application Transmittal for U.S. Patent No. 7,148,803 B2 (“As-Filed Bandy Application”)
1007	U.S. Patent Application Publication No. US 2002/0178126 A1 (“Beck”)
1008	RESERVED
1009	U.S. Patent No. 6,031,454 (“Lovejoy”)
1010	Assignment of U.S. Patent Application No. 10/761,362 from Peeters to Altivera L.L.C., executed Dec. 2, 2005
1011	Assignment of U.S. Patent Application No. 10/761,362 from Peeters to Altivera, LLC, executed Feb. 10, 2006
1012	Assignment of U.S. Patent Application No. 10/761,362 from Bandy to Symbol Technologies, Inc., executed Feb. 11, 2006
1013	RESERVED
1014	Gentag’s Response to Abbott’s Initial Invalidity Contentions: Response to Exhibit 1 Regarding Invalidity Based on U.S. Patent No. 7,148,803 “Radio frequency identification (RFID) based sensor networks” (“Bandy”), <i>Gentag, Inc. v. Abbott Laboratories</i> , No. 1:23-cv-00310 (N.D. Ill. Aug. 15, 2023) (“Gentag Invalidity Resp.”)

Ex.	Description
1015	U.S. Patent No. 6,987,965 B2 (“Ng”)
1016	World Intellectual Property Organization, International Publication No. WO 02/058537 A2 (“Heller”)
1017	Third Report & Order, <i>In re Revision of the Comm’n’s Rules to Ensure Compatibility with Enhanced 911 Emergency Calling Sys.</i> , CC Docket No. 94-102, 14 FCC Rcd. 17388, 1999 WL 795989 (FCC adopted Sept. 15, 1999; released Oct. 6, 1999), http://standards.fcc.gov/gov_affairs/fcc_filings/documents/e911rand.pdf (“FCC Report”)
1018	U.S. Patent No. 6,002,344 (“Bandy-344”)
1019	U.S. Patent No. 7,797,367 B1 (“Gelvin”)
1020	U.S. Patent No. 6,416,471 B1 (“Kumar”)
1021	U.S. Patent No. 6,978,182 B2 (“Mazar”)
1022	U.S. Patent No. 6,720,887 B1 (“Zunti”)
1023	U.S. Patent Application Publication No. 2003/0229723 A1 (“Kangas”)
1024	U.S. Patent Application Publication No. 2002/0165443 A1 (“Mori”)
1025	RESERVED
1026	NEWTON’S TELECOM DICTIONARY (18th ed. 2002) (excerpted)
1027	U.S. Patent No. 7,446,646 B2 (“Huomo”)
1028	U.S. Patent No. 6,989,750 B2 (“Shanks”)
1029	U.S. Patent No. 7,844,505 B1 (“’505 patent”)

I. The Board Should Not Exercise Discretion Under § 325(d)

Discretionary denial is not warranted here. Patent Owner (“PO”) does not dispute that Beck—the primary reference in Ground 3—was not before the Office during prosecution. Nor does PO dispute that Heller, a secondary reference in Grounds 2 and 3, was not previously presented to the Office. That alone demonstrates “325(d) is not sufficiently implicated,” and the Board need not conduct further analysis. *Fusion Orthopedics, LLC v. Extremity Med., LLC*, IPR2023-00894, Paper 15 at 34-35 (Nov. 17, 2023).

Further, as discussed below, the *Advanced Bionics* factors show that even without these new references, discretionary denial is not warranted based on Bandy (Grounds 1 and 2) or Lovejoy (secondary reference for Ground 3).

A. Grounds 1 and 2: The Petition showed that the Examiner erred by failing to substantively consider Bandy

Acknowledging that the Examiner did not substantively discuss Bandy during prosecution, PO asserts that Petitioner (“Abbott”) failed to identify any error by the Examiner. POPR at 39. Not so. The Petition shows that the Examiner erred in failing to appreciate Bandy’s disclosure, including its disclosure of the only limitation that the Examiner found lacking in the prior art—“wherein the remote server authenticates said unique sensor ID ... and communicates to said wireless device ... software related to the unique sensor ID.” Pet. 4-5, 30-31.

Advanced Bionics, LLC v. Med-El Elektromedizinische Gerate GmbH, IPR2019-

01469, Paper 6 at 8-9 nn.9-10 (Feb. 13, 2020) (precedential) (error to “overlook[] specific teachings of the relevant prior art [that] impact patentability of the challenged claims.”).

Although PO disputes that Bandy discloses this limitation, its argument does not support application of § 325(d) because it is based on a new claim construction that would improperly read limitations into the claims. Specifically, PO argues that authentication must be “based on at least [] the ‘unique sensor ID’ and the ‘unique wireless device ID.’” POPR at 25. PO, however, adopts Abbott’s claim construction—which does not require the “wireless device ID” to be used in authentication—and does not explain where it gets the requirement that the “wireless device ID” be used for authentication. POPR at 17. PO makes the same argument with Beck, which was not before the Patent Office before.

Nevertheless, the absence of any discussion of Bandy during prosecution—regardless of its discussion in the body of the ’307 application—weighs heavily against discretionary denial. *Trend Micro Inc. v. CUPP Computing AS*, IPR2021-00813, Paper 7 at 23 (Oct. 25, 2021).

B. Ground 3: Beck was not disclosed during prosecution and discloses the limitation that the Examiner found patentable

It is undisputed that neither Beck nor Heller were disclosed to the office during prosecution. That ends the *Advanced Bionics* inquiry as to those references. But the use of Lovejoy in Ground 3 does not warrant discretionary denial.

Although Lovejoy was presented to the Office, it was not substantively discussed, nor was it presented or considered in combination with Beck and Heller. Lovejoy is referenced in the '307 specification in relation to its disclosure of geolocation. But Abbott relies on **Beck**—not Lovejoy—for disclosure of the limitation that allegedly was missing from the prior art and led to allowance—“wherein the remote server authenticates said unique sensor ID ... and communicates to said wireless device ... software related to the unique sensor ID.” Petition at 62-65. Again, PO's arguments to the contrary do not favor application of § 325(d) for at least the same reasons as noted above for Bandy. Again, PO's only argument for why Beck does not disclose this limitation is that Beck does not disclose that its “unique wireless ID” is “used in authentication.” POPR 38. Again, that argument fails in light of PO's adoption of Abbott's claim construction and its failure to otherwise explain its basis.

The Board should not deny institution under § 325(d) at least because the Petition uses new art and showed the Examiner erred by not considering Bandy.

II. Bandy Is Prior Art Under 35 U.S.C. 102(e)

The Board should institute trial because Bandy is prior art “by another” under 35 U.S.C. § 102(e). Bandy lists a different inventive entity—William R. Bandy and John P. Peeters—from that of the '307 Patent, which lists John P. Peeters as its sole inventor. Although PO relies on declarations from Drs. Bandy

and Peeters regarding their alleged respective contributions to Bandy, at best those declarations raise questions of fact, which at this point of the proceeding favors institution. Indeed, prior panels have declined to disqualify prior art under §102(e) until after petitioners had an opportunity to cross-examine declarants and the record is fully developed. *See, e.g., MaxLinear, Inc. v. Cresta Tech. Corp.*, IPR2015-00594, Paper 13 at 9-10 (Aug. 21, 2015) (declining to disqualify prior art under § 102(e) without “relevant evidence that may be developed at trial”); *see also Nelson Prods., Inc. v. Bal Seal Eng'g, Inc.*, IPR2014-00572, Paper 10 at 11-12 (Sept. 29, 2014) (declining to disqualify reference before cross-examination of declarant).

A. There is a reasonable likelihood that Dr. Bandy contributed to the portions of Bandy relied on in the Petition

Contrary to PO's contentions, there is a reasonable likelihood that Dr. Bandy contributed to the portions of Bandy relied on in the Petition. PO contends that Dr. Bandy did not make an inventive contribution to those portions. POPR at 21. And that his contributions “related to specific features for enhancing RFID systems, ... as well as a method for rapid reading of multiple tags” (*id.* (citing Bandy Decl. ¶8), allegedly because “Dr. Bandy did not have any background in medical devices, biomarkers, or diagnostic sensors.” *Id.* (citing Bandy Decl. ¶9); Peeters Decl. ¶¶10, 18-19. Dr. Bandy's experience, however, was not so limited. In fact, he had significant experience directly related to the portions of Bandy cited by Abbott.

Dr. Bandy's other patents demonstrate his experience and reveal inaccuracies in PO's declarations. For example, Dr. Bandy is a named inventor on U.S. Patent No. 7,844,505 ("the '505 patent"), entitled "Automated Real-Time Distributed Tag Reader Network" and filed more than three years before the alleged conception date of the '307 patent. Ex. 1029, cover. The '505 patent demonstrates that Dr. Bandy's experience included, RFID tags that "contain[] one or more sensors," and transmit sensor data to the tag reader. '505 patent at 7:9-13. The '505 patent further describes that such sensors can include "a gas sensor that detects the presence of chemicals," (*id.* at 7:13-14), a temperature sensor (*id.* at 7:18-19), "and a biochemical sensor" (*id.* at 7:34). As another example, relating to the software download functionality in Bandy (Bandy at 10:33-51), Dr. Bandy explains that portable readers can wirelessly communicate with a computer, and be used in various applications with different tags and sensors by expanding application specific functionality through PCMCIA cards and wireless translation information download. *See* '505 patent at 7:62-67, 36:45-46, 37:1-6, and 38:53-57. The '505 patent further explains that tags can be affixed to a person (*id.* at 28:42-43) for use in applications like "home healthcare monitoring" (*id.* at 28:48-55). Finally, the location of both the tag and the reader can be determined through GPS and non-GPS means. *Id.* at 28:41-44 (non-GPS), *id.* at 38:63-65 (GPS).

The significant overlap between Dr. Bandy's experience and the Bandy

reference shows that Dr. Bandy contributed (or is reasonably likely to have contributed) to the portions of Bandy relied on by Abbott.

B. PO's Declarations Do Not Resolve The Dispute

PO's declarations do not demonstrate that the portions of Bandy relied on in the Petition were contributed solely by Dr. Peeters. In the Bandy declaration, Dr. Bandy describes his experience and states that his contributions were "related to specific, nuanced features for enhancing RFID systems," and that "Dr. Peeters contributed the remainder of the '803 Patent." Ex. 2001 ¶¶ 4, 8-9. Dr. Peeters offers a similar account in his declaration. *See, e.g.*, Peeters Decl. ¶¶ 18-19. But as shown above, the declarations grossly misstate Dr. Bandy's experience.

Further, the documents relied on by Dr. Peeters do not establish that he was the sole contributor of the portions of Bandy relied on in the Petition. At best, those exhibits reflect a mostly one-sided, high-level description of ongoing discussions between Drs. Peeters and Bandy about a subset of features. Exs. 2003-2006. They do not establish that Dr. Bandy did not contribute to the portions of the '803 patent relied on by the Petition. *Id*

Given Dr. Bandy's experience as described above, it is reasonable to expect that he contributed to the portions of the '803 patent relied on in the Petition.

C. PO's Cases Are Inapposite

PO urges the Board to deny institution and decide Bandy's prior art status

without the benefit of a fully developed record. Its cited cases do not support that relief. *First*, both *LSI Corp. v. Regents of the Univ. of Minn.*, IPR2017-1068, Paper 58, (Apr. 14, 2021) and *Sanofi-Aventis U.S. LLC v. Immunex Corp.*, IPR2017-01879, Paper 88 (Feb. 14, 2019) determined prior art status after institution.

Second, the cases PO cites where the Board denied institution are distinguishable. In *Miltenyi Biomedicine GmbH v. Tr. of the Univ. of Pa.*, IPR2022-00853, Paper 11 (Oct. 11, 2022), the Board did not deny institution based solely on declarations as PO contends. POPR at 22. There, the prior art reference was an article and included a description of the authors' contributions, which the Board found consistent with the submitted declaration. *Id.* at 32.

R.J. Reynolds Vapor Co. v. Altria Client Servs. LLC, IPR2021-00793, Paper 7, (Oct. 27, 2021) is even further afield. There, the prior art and the challenged patent both listed the same sole inventor whose name appeared differently on each due to different Chinese-to-English romanization methods. *Id.* at 4-5.

And *In re Katz*, 687 F.2d 450, (C.C.P.A. 1982) did not hold that a declaration disclaiming inventive contribution ends the inquiry in all cases. *Id.* at 455 (observing that such a declaration would have obviated the rejection in that case because the Board requested such a declaration); POPR at 23.

III. Conclusion

For the reasons set forth above, the Board should institute trial.

Respectfully submitted,

Dated: May 24, 2024

By: / S. Giri Pathmanaban /

S. Giri Pathmanaban (Reg. No. 75,986)

giri.pathmanaban@lw.com

Latham & Watkins LLP

300 Colorado Street, Suite 2400

Austin, TX 78701-3295

Telephone: 737.910.7300

Fax: 737.910.7301

Counsel for Petitioner

*Abbott Laboratories and Abbott Diabetes
Care Inc.*

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 24th day of May, 2024, a true and correct copy of the foregoing **Petitioner's Reply to Patent Owner's Preliminary Response and Exhibit 1029** were served by electronic mail on Petitioner's lead and backup counsel at the following email addresses:

David Pekarek Krohn
PERKINS COIE LLP
33 East Main Street, Suite 201
Madison, WI 53703-3095
Telephone: (608) 663-7460
Fax: (608) 663-7499
pekarekkrohn-ptab@perkinscoie.com
Gentag-IPR@perkinscoie.com

Rodger Carreyn
PERKINS COIE LLP
33 East Main Street, Suite 201
Madison, WI 53703-3095
Telephone: (608) 663-7460
Fax: (608) 663-7499
carreyn-ptab@perkinscoie.com

Christopher G. Hanewicz
PERKINS COIE LLP
33 East Main Street, Suite 201
Madison, WI 53703-3095
Telephone: (608) 663-7460
Fax: (608) 663-7499
CHanewicz@perkinscoie.com

By: / S. Giri Pathmanaban /

S. Giri Pathmanaban (Reg. No. 75,986)
giri.pathmanaban@lw.com
Latham & Watkins LLP
300 Colorado Street, Suite 2400
Austin, TX 78701-3295
Telephone: 737.910.7300
Fax: 737.910.7301

*Counsel for Petitioner
Abbott Laboratories and Abbott Diabetes
Care Inc.*