

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 No. IPR2024-00425

Patent No. 7,969,307 B2

PATENT OWNER'S SURREPLY TO PETITIONER'S REPLY

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EXHIBIT LIST

PATENT OWNER'S EXHIBITS	
Exhibit No.	Description
2001	Declaration of William Bandy, Ph.D.
2002	Declaration of John P. Peeters, Ph.D.
2003	Feb. 1, 2005 email from John Melngailis, Bates numbered GEN-AB-0003666 in <i>Gentag, Inc. v. Abbott Laboratories</i> , No. 1:23-cv-00310 (N.D. Ill.)
2004	May 6, 2003 handwritten notes by John Peeters, Bates numbered GEN-AB-00001440 in <i>Gentag, Inc. v. Abbott Laboratories</i> , No. 1:23-cv-00310 (N.D. Ill.)
2005	May 7, 2003 letter from John Peeters, Bates numbered GEN-AB-0001441-1442 in <i>Gentag, Inc. v. Abbott Laboratories</i> , No. 1:23-cv-00310 (N.D. Ill.)
2006	Aug. 19, 2003 email from John Peeters, Bates numbered GEN-AB-00002974-2977 in <i>Gentag, Inc. v. Abbott Laboratories</i> , No. 1:23-cv-00310 (N.D. Ill.)
2007	Defendants' Reply Claim Construction Brief, <i>Gentag, Inc. v. Abbott Laboratories</i> , Case No. 1:23-cv-310 (N.D. Ill. May 24, 2024), ECF No. 87

I. THE BOARD SHOULD DENY INSTITUTION UNDER § 325(d)

A. Petitioner's Claim Construction Argument is Improper.

Petitioner requested—and the Board granted—a reply “to address Patent Owner’s arguments relating to: (i) discretionary denial under 325(d), and (ii) the prior art status of Bandy....” EX-3001. Other than a throwaway reference to the Petition, however, Section I.A of Petitioner’s Reply is unrelated to Patent Owner’s discretionary-denial argument and beyond the scope permitted by the Board. Reply at 2. Petitioner argues against discretionary denial because Patent Owner’s argument allegedly “is based on a new claim construction....” *Id.* But Patent Owner’s POPR contains no such thing. POPR at 39-43. Instead, Patent Owner’s argument is limited—as it should be—to what was before the examiner during prosecution and does not include any reference to the “authentication” limitation raised in the Reply. *Id.* Petitioner’s bait-and-switch is revealed by the cites in the Reply, none of which are to the discretionary denial section of the POPR. Reply at 2 (citing POPR at 17, 25).

The Board should ignore and/or strike at least Section I.A of the Reply, which goes beyond the scope allowed by the Board.

B. Petitioner's Improper Claim Construction Argument is Wrong.

To the extent the Board considers I.A of the Reply, Petitioner’s argument fails. As recognized by Petitioner, Patent Owner did not contest, for the purposes of the POPR, Petitioner’s proposed claim constructions. Reply at 2 (citing POPR at 17).

While Petitioner proposed a construction of a long phrase from claim 1, that construction did not relate to the “authentication” portion of the phrase. For “authentication,” Petitioner’s proposed construction simply repeats the claim language, merely replacing “said” with “a.” *Compare* ’307 Pat., claim 1 (“wherein the remote server authenticates said unique sensor ID associated with said unique wireless device ID”) *with* Petition at 6 (“wherein the remote server authenticates a unique sensor ID associated with a unique wireless device ID”).

Now, in response to Patent Owner’s argument why Bandy does not meet the plain and ordinary language of “authenticates ... with,” (POPR at 25), Petitioner seeks to modify its own proposed construction to place a particular meaning on “authenticates ... with.” *See* Reply at 2. But that argument—that the limitation “does not require the ‘wireless device ID’ to be used in authentication” (*id.*)—was not raised in the Petition. Thus, the “authenticates ... with” language should be given its plain and ordinary meaning.

Petitioner’s Reply is seemingly intended, at least in part, to bolster an argument it is making in the district-court litigation. Even though Patent Owner Gentag did not propose a claim construction in its POPR, Petitioner encourages the Board to act as if it did. Petitioner has informed the district court that “[s]hould the Board adopt Gentag’s construction, Abbott intends to further amend its construction to require that the remote server authenticate not only the ‘unique sensor ID,’ but

also the ‘unique wireless device ID.’” EX-2007 at 3 n.2. In other words, Petitioner seeks to fix its mistake made in claim-construction proceedings in district court by engaging in a form of litigation arbitrage. It seeks an opinion from the Board on a claim-construction issue never raised in the Petition or the POPR—or in the district court, for that matter—that it will presumably seek to use in the district court. The Board should reject Petitioner’s invitation and recognize that, at least at the institution stage, “authenticates ... with” should be given its plain and ordinary meaning.

C. Petitioner’s Argument Regarding Beck is Irrelevant.

What point Petitioner is trying to make in Section I.B of its Reply is unclear. Patent Owner never asserted that Beck or Heller were before the Patent Office during prosecution. But it is also undisputed that Lovejoy *was* presented to the Patent Office, as Petitioner admits in its Reply. Reply at 3 (“Lovejoy was presented to the Office.”). Petitioner further admits that “Lovejoy is referenced in the ’307 specification in relation to its disclosure of geolocation.” *Id.* And Petitioner relies solely on Lovejoy in connection with that very limitation. Petition at 60-61. Therefore, the very reference Petitioner asserts in connection with the “geolocation means” was before the examiner related to “geolocation.” For purposes of discretionary denial, the fact that Petitioner is using a different reference (Beck) for other limitations is irrelevant.

II. BANDY IS NOT PRIOR ART

As confirmed by declarations from Bandy's two named inventors (EX-2001 & EX-2002), the portions of Bandy upon which Petitioner relies were all contributed by Dr. Peeters. While Petitioner asserts—without citation to legal authority—that “there is a reasonable likelihood that Dr. Bandy contributed to the portions of Bandy relied on in the Petition” and “it is reasonable to expect that [Dr. Bandy] contributed to the portions of the '803 patent [Bandy] relied on in the Petition” (Reply at 4, 6), this is not the correct legal standard. Indeed, the Board has previously denied institution where it was “not persuaded that Petitioner can establish that [the prior art reference in question] qualifies as prior art under §102(a)” and where it was “unlikely that Petitioner can demonstrate that [an individual's] contribution to [the reference at issue] constitutes the work of another.” *Miltenyi Biomedicine GmbH v. Tr. of the Univ. of Pa.*, IPR2022-00853, Paper 11, 32-33 (Oct. 11, 2022).

A. Bandy Himself Confirms that He Did Not Contribute to the Portions of the Reference upon which Petitioner Relies.

Petitioner's argument hinges on the flawed premise that a person should qualify as an inventor if his background provides him with sufficient experience such that he *could have* contributed to the claims. That is not the law. As both Dr. Bandy and Dr. Peeters confirm in their declarations, Dr. Bandy *did not* contribute to the portions of Bandy cited in the Petition. Whether Dr. Bandy *could have* contributed

more is irrelevant. Even if Bandy had the experience necessary to contribute more, that doesn't mean that he did, and his declaration is explicit that he did not.

Moreover, Petitioner's argument fails even to establish that Bandy had the necessary experience to contribute to the portions of Bandy cited in the Petition, much less contradict Dr. Bandy's declaration. Petitioner's sole citation is to a *different* patent (U.S. Patent No. 7,844,505) on which Bandy is the *second of two* named inventors, and then argues—with no evidence—that *everything* in that patent was within Dr. Bandy's expertise. In addition, while Petitioner suggests the '505 patent is directed to RFID tags transmitting sensor data to a tag reader via wireless communication, Petitioner does not assert that patent as prior art in its Petition. Petitioner's argument that the '505 patent “shows that Dr. Bandy contributed (or is reasonably likely to have contributed) to the portions of Bandy relied on by Abbott” (Reply at 6) is thus unsupported by Petitioner's own submission.

B. Petitioner's Attempt to Discredit the Declarations Fails.

Petitioner argues that the declarations “grossly misstate Dr. Bandy's experience” based on its characterization of the '505 patent. *Id.* But this is not a case in which only one of the named inventors offered a declaration; *Dr. Bandy himself* details his experience and his contributions via declaration (which is corroborated by the declaration of Dr. Peeters). Petitioner offers no explanation as to why Dr.

Bandy would lie about his own experience or why his declaration (which is in no way self-serving) should otherwise be discredited.

Moreover, Petitioner's sole response to Dr. Peeters' declaration is to vaguely argue that it relates only to "a subset of features." *Id.* But Dr. Peeters' declaration literally walks through *each and every* citation to Bandy in the Petition. Dr. Peeters further provides documentary evidence corroborating his declaration. Petitioner does not offer a single case or other legal authority requiring more.

C. It Is Well Within the Board's Authority to Deny Institution Based on the Corroborated Declarations of the Two Named Inventors.

As Petitioner concedes, the Board has previously denied institution where a patent owner offered corroborated declarations regarding inventorship. Petitioner attempts to distinguish *Miltenyi Biomedicine* on the grounds that the inventor declaration there was corroborated by an article. Reply at 7. In so doing, Petitioner ignores the fact that the declarations of Dr. Bandy and Dr. Peeters both corroborate each other *and are corroborated by the documentary evidence*. See, e.g., EX-2001-EX-2006. Petitioner fails to explain what additional evidence could possibly be required. Regardless, it is well within the Board's authority to accept the corroborated declarations of the named inventors and disqualify Bandy as prior art.

While Petitioner argues that the declarations of Dr. Bandy and Dr. Peeters raise "questions of fact" precluding institution (Reply at 4), the cases cited by Petitioner are wholly inapposite. In *MaxLinear, Inc. v. Cresta Tech. Corp.*, the Board declined

to disqualify a prior-art reference because it had “not heard sufficiently Petitioner’s response to this information, nor reviewed relevant evidence that may be developed during the trial.” IPR2015-00594, Paper 13 at 9-10 (Aug. 21, 2015). Unlike here, the Petitioner in *MaxLinear* did not file a reply to patent owner’s preliminary response. And, unlike here, the patent owner in *MaxLinear* did not file corroborated declarations from the named inventors of the reference at issue. Thus, unlike in *MaxLinear*, the Board *has* sufficiently heard Petitioner’s response, and Petitioner has pointed to no additional evidence to be developed.

Similarly, in *Nelson Prods., Inc. v. Bal Seal Eng’g, Inc.*, the Board declined to disqualify a prior-art reference on the record before it, which consisted of a single declaration, without corroboration. IPR2014-00572, Paper 10 at 12 (Sept. 29, 2014) (“Patent Owner offered the Poon Declaration, but nothing further, and notably, no declaration by Peter J. Balsells was submitted.”). Here, conversely, Dr. Bandy submitted a corroborating declaration. Further, the Petitioner in *Nelson* did not file a reply to patent owner’s preliminary response. Where, as here, all named inventors have provided declarations—and Petitioner has been fully heard through its reply to the evidence—disqualification of the reference in question is proper.

Dated: May 30, 2024

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Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that I caused to be served a true and correct copy of the foregoing: PATENT OWNER's SURREPLY TO PETITIONER'S REPLY and accompanying exhibits by email to the electronic service addresses for Petitioner on the date indicated below:

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