

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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DEXCOM, INC.,  
Petitioner,

v.

ABBOTT DIABETES CARE INC.,  
Patent Owner.

IPR2024-00520  
U.S. Patent No. 11,266,335

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**PETITIONER'S EXPLANATION OF MATERIAL  
DIFFERENCES BETWEEN THE PETITION IN IPR2024-00520 AND  
PREVIOUSLY FILED PETITIONS IN IPR2023-01396 AND IPR2023-01397**

On October 6, 2023, Petitioner filed two petitions for inter partes review, each challenging claims 1-4, 8-9, and 11-27 of U.S. Pat. No. 11,266,335 (the '335 patent). *Petition 1 (IPR2023-01396)* relied on references that are prior art even assuming a March 2010 effective filing date, and *Petition 2 (IPR2023-01397)* relied on an additional reference that qualifies as prior art unless Patent Owner shows earlier conception and diligent reduction to practice. Thereafter, on December 20, 2023, Patent Owner first asserted '335 patent claims 5-7 in related district court litigation.

In response, Petitioner files concurrently with this Paper *Petition 3 (IPR2024-00520)* challenging newly asserted claims 5-7 based on a *subset* of the art/grounds presented in *Petition 1*. Per the November 2019 Consolidated Trial Practice Guide ("TPG"), Petitioner submits this explanation of material differences between *Petition 3* and prior petitions, and why all should be instituted. TPG, 59-60.

Ranking *Petition 3* relative to the other petitions would be inappropriate, as it challenges different claims that were not asserted at the time *Petitions 1* and *2* were filed. *See Mercedes-Benz USA, LLC v. Carucel Invs., L.P.*, IPR2019-01644, Paper 9 at 11 (PTAB Mar. 26, 2020). However, if the Board requires such a ranking, **Petitioner ranks *Petition 3* third**, behind *Petitions 1* and *2*.

#### **I. PETITION 3 NEEDED TO ADDRESS NEWLY ASSERTED CLAIMS**

Patent Owner recently served contentions in the co-pending litigation alleging infringement of 26 of the 27 claims in the '335 patent, including newly asserting

claims 5-7. EX1267 at 2. Petition 3 challenges only these claims 5-7, which were challenged in neither of the previous '335 patent petitions, because Patent Owner first asserted them after those petitions were filed. Thus, Petition 3 is necessary to allow Petitioner to challenge the full set of claims asserted by Patent Owner.

While the PTAB practice guide states that multiple petitions should be “rare,” and it is “unlikely that ... three or more petitions by a petitioner ... will be appropriate” (TPG, 59), this is not the typical case. And, the Board recognizes several clear exceptions to these guidelines that closely align with the facts here.

For example, filing “three or more” petitions may be appropriate where a large number of claims are asserted and different petitions challenge different claims. *See Samsung Elecs. Co., Ltd. v. Hardin*, IPR2022-01328, Paper 13 at 20-23 (PTAB Feb. 8, 2023); *Intel Corp. v. VLSI Technology LLC*, IPR2019-01199, Paper 19 at 10-11 (PTAB Feb. 6, 2020). Patent Owner asserts a total of 26 claims here and Petition 3 challenges only claims that were not challenged in the earlier-filed petitions.

Additionally, later-filed petitions may be particularly warranted where, as here, patent owner newly asserts claims in a co-pending litigation after a first petition is filed. *See, e.g., Mercedes-Benz USA*, Paper 9, at 9-15; *Netflix, Inc. v. Avago Techs. Int’l Sales PTE. Ltd.*, IPR2021-00431, Paper 8, at 3 (PTAB Jun. 25, 2021).

In a similar case, the Board has said it does not consider a later-filed petition a follow-on petition, as the *General Plastic* panel used that term. *See Volkswagen*

*Grp. of Am., Inc. v. Carucel Invs., L.P.*, IPR2019-01573, Paper 7 at 7 (PTAB Jan. 22, 2020) (second petition covering different claims is not a “follow-on petition”).

## II. COMPARING PETITION 3 AND PREVIOUSLY FILED PETITIONS

Differences between Petitions 1 and 2 were previously set forth. IPR2023-01396, Paper 2. As shown below, Petition 3 relies on a subset of Petition 1’s grounds, mirroring without substantive modification its mapping of Grounds 1 and 2 for claims 1 and 2, which are not challenged again therein, in challenging newly asserted dependent claims 5-7, which depend directly or indirectly from claims 1 and 2. Grounds 3-8 from Petition 1 are not presented in Petition 3.

| Petition 1 (IPR2023-01396)        |                            | Petition 3 (IPR2024-00520)            |                   |
|-----------------------------------|----------------------------|---------------------------------------|-------------------|
| Grounds                           | Challenged Claims          | Grounds                               | Challenged Claims |
| Ground 1: Stafford+Raymond        | 1–4, 8–9, 11–15, and 17–27 | <i>Ground 1: (same as Petition 1)</i> | 5-7               |
| Ground 2: Stafford+Raymond+Turner | 1–4, 8–9, 11–15, and 17–27 | <i>Ground 2: (same as Petition 1)</i> | 5-7               |
| Grounds 3-6: +Say                 | 16                         | N/A                                   |                   |
| Grounds 3-6: +Bickoff             | 16                         |                                       |                   |
| Grounds 7-8: +Shah                | 17-18                      |                                       |                   |

## III. THE BOARD SHOULD INSTITUTE ALL THREE PETITIONS

The Board should institute all three petitions for at least four reasons.

*First*, each petition has compelling merits. Stafford (Petitions 1 and 3) and Thomas (Petition 2) each discloses one of the central claimed concepts—an on body glucose monitoring unit having a sensor and associated electronics within an on body

unit. Secondary references Raymond and Turner teach inserter device details claimed by the '335 patent, e.g., gripping arms engaging peripheral recesses of the on body unit. Combined with additional references cited only for dependent claims, these references together demonstrate that each challenged claim is unpatentable.

*Second*, if the Board decides to institute Petition 1, Petition 3 adds only a minimal amount of additional work, relying on a subset of the same art, mapped to the additional limitations of Patent Owner's three newly asserted claims. Petition 2 similarly adds minimal work, relying on a different primary reference but two of the same secondary references and similar principles of combination as Petition 1.

*Third*, Petitioner will be prejudiced if only Petition 1, Petition 2, or both is/are instituted and Petition 3 is discretionarily denied, as it will not be given the opportunity to challenge Patent Owner's newly asserted claims. Petitioner promptly and diligently worked to file this Petition after receiving Patent Owner's new contentions six weeks ago, just before the holidays. Petition 3 includes only three additional dependent claims, and maps the same independent claim (claim 1) upon which they depend based on (a simpler subset of) the *same art and grounds* raised in Petition 1. Thus, it will be efficient for the Board to also decide these added claims.

*Finally*, Patent Owner will not be prejudiced by having Petition 3 considered:  
a) Patent Owner could have asserted claims 5-7 before Petitions 1 and 2 were filed;

b) Petitioner filed Petition 3 before institution decisions on Petitions 1 and 2, so it is not informed by any Board determinations; and c) Petition 3, while filed shortly after receiving the Petition 1 and 2 POPRs, was substantially completed prior to receiving those POPRs, utilizes *without substantive modification* the same art and grounds as Petition 1 to map claims 1 and 2 (because challenged claims 5-7 depend from them), and only adds sections addressing language recited by dependent claims 5-7.

#### IV. CONCLUSION

The Board should institute all three petitions to ensure that Patent Owner is not able to circumvent these petitions' merits or avoid having the patentability of later-asserted claims considered by the Board. All three petitions have compelling merits, and are needed to address Patent Owner's likely dispute in Petition 2 whether Thomas qualifies as prior art and assertion of added claims addressed in Petition 3.

Respectfully submitted,

January 31, 2024

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**CERTIFICATE OF SERVICE**

The undersigned certifies that on January 31, 2024, a copy of the foregoing **Petitioner's Explanation of Material Differences Between The Petition In IPR2024-00520 And Previously Filed Petitions In IPR2023-01396 And IPR2023-01397** was served by Express Mail on the correspondence address of record indicated in the Patent Office's Patent Center system for U.S. Patent No. 11,266,335:

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January 31, 2024

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