

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DEXCOM, INC.,
Petitioner,

v.

ABBOTT DIABETES CARE INC.,
Patent Owner.

Case No. IPR2024-00520

U.S. Patent No. 11,266,335

**PATENT OWNER'S AUTHORIZED SUR-REPLY TO PETITIONER'S
REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE**

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<i>L’Oréal USA, Inc. v. Univ. of Mass.</i> 2018 WL 4278992 (PTAB Sept. 7, 2018).....	1, 5
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TABLE OF EXHIBITS

Exhibit No.	Description
2001	EPO Summons and Preliminary Opinion for Opposition Re EP 3 766 408 B1 (20195922.8) (Sept. 21, 2023)
2002	European Patent No. 3 766 408 B1
2003	European Patent No. 3 928 688 B1
2004	Cambridge Dictionary of American English (2000) (excerpt)
2005	March 13, 2024 Telephonic Hearing Transcript

The Board has already denied institution of Petitioner’s prior two petitions directed to U.S. 11,266,335 (“335”). Petitioner’s third petition merely repeats Petitioner’s already-rejected arguments. Knowing this, Petitioner tries to salvage its 335 IPRs via its POPR reply. However, as explained below, Petitioner’s reply arguments fail both procedurally and substantively for multiple reasons. In making them, Petitioner ignores its own prior arguments, Patent Owner’s (“PO”) prior arguments, the facts, and the law. Petitioner also repeatedly mischaracterizes the positions of PO and the Board. Petitioner’s third 335 petition should be rejected for at least the same reasons as the prior two.

I. PETITIONER’S ARGUMENTS FAIL PROCEDURALLY AND INVITE CONFLICTING BOARD DECISIONS

First, nearly all of Petitioner’s new reply arguments are untimely and improper because Petitioner could have raised them in its Petition. POPR replies (if even authorized) cannot raise foreseeable arguments that could have been raised in the Petition. *L’Oréal USA, Inc. v. Univ. of Mass.*, 2018 WL 4278992, *5 n.4 (PTAB Sept. 7, 2018); *Matterport, Inc. v. Appliance Comp. III, Inc.*, 2021 WL 6340164, *9-10 (PTAB Nov. 19, 2021) (rejecting POPR reply arguments as untimely). Thus, in its reply request, Petitioner assured the Board that its reply arguments would be directed to “unanticipated” PO positions. (5/22/24 Pet. email.) But that is inaccurate. Petitioner unquestionably knew PO’s arguments at the time of its Petition here. That is because PO’s POPR arguments here are *identical* to its POPR arguments in

IPR2023-01396, which were filed two weeks *before* Petitioner filed its Petition in this IPR. (See, e.g., POPR at 1; 01396 POPR (filed on 1/18/24); 00520 Pet. (filed on 1/31/24).) Thus, Petitioner’s reply is directed to fully anticipated—indeed, known—PO positions, but for a few brief comments on post-Petition events (i.e., a recent EPO decision and Petitioner’s recent 01396 rehearing request). Petitioner’s reply arguments should be rejected for this reason alone.

Second, many of Petitioner’s reply arguments are unauthorized. Petitioner told the Board that its reply would be directed to four specific issues (i.e., bodily incorporation, “on a periphery,” its 01396 rehearing request, and an EPO opinion). (5/22/24 Pet. email.) But Petitioner’s reply goes well beyond those four issues. For example, it argues about alleged motivation provided by Turner, design choice, and whether the 335 claims have a “securing” function. (Reply at 3-4, 7.) The Board should hold Petitioner to its word and disregard these unauthorized arguments.

Third, in seeking a POPR reply here and rehearing in the related 01396 IPR, Petitioner takes conflicting positions. In both IPRs, Petitioner admittedly made the same arguments in its petitions. (Pet. at 9.) Similarly, Petitioner raised the same arguments in its reply here and in its 01396 rehearing request. (Compare Reply to 01396 Paper 14.) But to justify its reply request, Petitioner told the Board that its reply arguments are *new* (otherwise a reply would not be needed). At the same time, to justify its 01396 rehearing request, Petitioner told the Board that these arguments

were *old* and “misapprehended” by the Board. Both assertions cannot be true (given that Petitioner’s 01396 and 00520 petitions make the same arguments).

Finally, Petitioner invites inconsistent decisions, which Petitioner itself says should be avoided. (Reply at 7.) Specifically, in denying the prior two 335 petitions (IPR2023-01396, -01397), the Board adopted the same reasoning. ***Petitioner did not challenge the Board’s 01397 institution decision.*** Yet Petitioner now asks the Board to issue a decision that conflicts with the Board’s unchallenged findings.

II. PETITIONER’S ARGUMENTS FAIL SUBSTANTIVELY

Petitioner’s reply arguments also fail substantively for many reasons.

First, Petitioner goes beyond the scope of its reply request and accuses PO here, and the Board in the 01396 IPR, of reading a “securing” limitation into the claims. (Reply at 7.) But it is Petitioner—not PO or the Board—that introduced the “securing” issue. PO and the Board merely refuted Petitioner’s primary—and flawed—argument that a POSITA would add multiple recesses (like Turner’s) to secure the OBU. (POPR at 42-44, 56-59; 01396 Inst. Dec. (Paper 13) at 30-31, 49-51.) Petitioner’s new argument is particularly surprising given that Petitioner and its expert previously described the challenged claims as being directed to “inserters configured to *secure* an on body unit therein” (POPR at 60.) Moreover, Petitioner ignores the 335 claim language which says the recesses are for “*detachably* engag[ing] with the inserter.” (*Id.*) Notably, Turner’s recesses (on which Petitioner’s

reply is based) do not “detachably” engage with anything, let alone an inserter. As the Board correctly found in the 01396 IPR, Turner’s recesses “are substantially different” from the 335 recesses and “serve an entirely different purpose.” (01396 Paper 13 at 48.) For this reason alone, Turner’s recesses cannot meet the 335 claims.

Second, Petitioner’s reply fundamentally rests on another beyond-the-scope argument (i.e., “design choice”), but this in turn rests on numerous inaccuracies. For example, Petitioner repeatedly alleges that there are only two choices in the record for securing an OBU to an inserter: one recess or multiple recesses. (Reply at 1, 3, 4.) But that is incorrect. **None** of Petitioner’s references teaches using multiple recesses for securing. The only “choices” in the record are an annular rim (Raymond) or friction fit with the needle (Turner). (POPR at 43-44, 57-58.) Thus, if a POSITA were looking to Raymond or Turner for OBU “securing” teachings, using multiple recesses would not even be one of the “design choices” (without using hindsight).

Petitioner further alleges that PO did not identify Turner’s needle friction fit or any other “securing” choices. (Reply at 4.) This too is incorrect—PO identified several choices (which Petitioner does not contest). (POPR at 50-51, 57-58.) In short, Petitioner’s “design choice” argument—and cited law—is misplaced.

Third, in its POPR, PO showed that Raymond’s existing design already secures the OBU and therefore adding recesses would unnecessarily add complexity to the insertion assembly. In reply, Petitioner alleges that “PO failed to explain” how

adding recesses adds complexity. (Reply at 4.) Again, that is incorrect. (POPR at 44 (providing an example of added complexity).) PO also cited controlling law on this point, which Petitioner never refutes. (*Id.* at 43-44.) Petitioner cannot overcome PO's arguments by misstating or not addressing them.

Fourth, Petitioner's arguments fail because Turner teaches (by necessity) upper-surface recesses, not "peripheral" recesses as claimed. (*Id.* at 53-54.) Petitioner alleges that PO here—and the Board in 01396—applied an incorrect "implied" construction of "periphery." (Reply at 4-5.) But it is Petitioner who is incorrect. Critically, both parties agreed that the ordinary meaning of "periphery" should be applied "in view of the specification." (Pet. at. 18.) That is exactly what PO and the Board did. Indeed, PO and the Board repeatedly cited 335 specification support when assessing the "periphery" limitation. (*See, e.g.*, POPR at 3-4; 01396 Paper 13 at 46-48, 27-28, 7-9.) In contrast, in the Petition, Petitioner merely assumed its own implied meaning with no analysis or reference to the specification.

Petitioner now wants a "do over" with **new** claim construction arguments and evidence on reply, which is improper, especially when Petitioner was aware of PO's alleged "implied" construction before it filed its Petition. *L'Oréal USA, supra*; *Cisco Sys., Inc. v. Oyster Optics, LLC*, 2019 WL 328734, *10 (PTAB Jan. 24, 2019) ("A reply is not an opportunity to start anew ... or remedy [claim construction] omissions in a petition."). Petitioner's untimely assertions are not only legally improper, but

Petitioner’s primary argument is inaccurate. Petitioner alleges that PO here—and the Board in 01396—relied on the EPO’s preliminary opinion in assessing “periphery.” (Reply at 5; 01396 Paper 14 (Rehearing Req.) at 9-10.) But neither PO nor the Board referenced the EPO’s opinion when assessing the “periphery” limitation. (*See, e.g.*, POPR at 4-5, 53-55; 01396 Paper 13 at 46-49.) Rather, PO and the Board merely referenced the EPO’s analysis of Petitioner’s cited art as corroborating the rejection of Petitioner’s prior art analysis herein. (POPR at 8-9, 12-13, 16-17, 41-42, 49-50, 58-59; 01396 Paper 13 at 35-36.)

Cherry-picking a 2024 online dictionary, Petitioner also argues that outer “edge” is not an ordinary meaning of “periphery.” (Reply at 6.) But dictionaries available on the priority date refute Petitioner. (*See, e.g.*, Ex. 2004, Cambridge Dict. of Am. Engl. (2000) (defining “periphery” as “the outer edge of an area”).) Even the first definition from Petitioner’s favored dictionary is consistent with PO’s and the Board’s analysis (i.e., “the perimeter of a circle or other closed curve”).

Fifth, Petitioner relies heavily on Turner’s alleged “anti-rotation” teachings (which do not address the 335 claimed inventions). (POPR at 60.) Petitioner’s “anti-rotation” arguments fail for multiple reasons. (*Id.* at 59-65.) For example, to justify its combination, Petitioner alleges that Turner teaches preventing rotation between an *insertor* and *OBV*. (Reply at 3, 4.) That is inaccurate. Indeed, Turner does not even have a separate insertor. (POPR at 61.) As explained in PO’s unrefuted POPR

arguments, Turner at most teaches preventing rotation between a *needle hub and OBU* (which Petitioner’s combination notably does not try to do because it would not meet the 335 claims). (*Id.* at 59-65.)

Further, Petitioner never shows that Raymond’s existing design does not already prevent OBU rotation (thus no need for Turner). PO’s POPR showed that it would (which Petitioner does not contest). (*Id.* at 63-64.)

Finally, even assuming Raymond does not already prevent rotation between its needle hub and OBU, Turner’s design is not compatible with the relied-upon Raymond inserter. That is because Turner’s design, with vertically-extending needle hub protrusions and upper-surface OBU recesses, requires the needle hub and OBU to be adjacent components to work. (*Id.* at 64-65.) But those components are *not* adjacent in Raymond’s inserter. (*Id.* (illustrating Turner’s design versus Raymond).) These facts are unrefuted. Simply put, using hindsight, Petitioner ignores the location, orientation, purpose, and function of Turner’s recesses—and self-servingly places them on the periphery of the Stafford + Raymond OBU housing.

Finally, Petitioner accuses PO of “omitt[ing]” the EPO’s recent revocation of PO’s related EP patent, but as Petitioner admits, *that decision had nothing to do with prior art* (it was based on an unrelated EPO legal doctrine). (Reply at 5.) Relevant here, the EPO never changed its factual assessment of Petitioner’s cited prior art that corroborates PO’s and the Board’s independent prior art analyses.

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Respectfully submitted,

/Michael C. Carrozza /

Michael C. Carrozza

Registration No. 66,980

McANDREWS, HELD & MALLOY

500 West Madison St., Suite 3400

Chicago, IL 60661

Telephone: (312) 775-8000

CERTIFICATE OF SERVICE

I hereby certify that the Patent Owner's Authorized Sur-Reply To Petitioner's Reply To Patent Owner's Preliminary Response in connection with *Inter Partes* Review Case IPR2024-00520 was served on this 11th day of June, 2024 by electronic mail to the following:

Lead Counsel	Back-Up Counsel
Andrew M. Mason andrew.mason@klarquist.com	Alexa M. Johnston alexa.johnston@klarquist.com Michael J. Loy michael.loy@klarquist.com Todd M. Siegel todd.siegel@klarquist.com Derrick W. Toddy derrick.toddy@klarquist.com John D. Vandenberg john.vandenberg@klarquist.com
KLARQUIST SPARKMAN, LLP 121 SW Salmon Street, Suite 1600 Portland, Oregon, 97204 503-595-5300 (phone) 503-595-5301 (fax)	

Dated: June 11, 2024

/Michael C. Carrozza/

Michael C. Carrozza, Reg. No. 66,980

CUSTOMER NUMBER: 23446