

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.

IPR2024-00521  
U.S. Patent No. 11,298,056  
Issued: April 12, 2022

Title: METHODS AND SYSTEMS FOR EARLY SIGNAL ATTENUATION  
DETECTION AND PROCESSING

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**PETITIONER'S EXPLANATION OF MATERIAL DIFFERENCES  
BETWEEN THE PETITION IN IPR 2024-00521 AND THE  
PREVIOUSLY INSTITUTED PETITION IN IPR2023-01251**

On August 1, 2023, Petitioner filed two petitions for *inter partes* review of U.S. Patent No. 11,298,056 (the '056 patent). *Petition 1 (IPR2023-01251)* assumes a 2009 effective filing date and challenges claims 1-12, 14-28, and 30, while *Petition 2 (IPR2023-01252)* argued a later effective filing date, and challenged claims 1-30. Institution was recently granted on *Petition 1*, but the Board exercised its discretion and denied as to *Petition 2*, leaving claims 13 and 29 unchallenged.

On December 20, 2023, Patent Owner first formally asserted '056 patent claims 13 and 29 in district court (EX1250 at 2), relying upon unforeseen claim interpretations. In response, Petitioner now files *Petition 3 (IPR2024-00521)*, challenging only dependent claims 13 and 29. Ground 1 uses the same combination presented and maps the claim 1 elements in the same manner as *Petition 1* Ground 1 and shows how that combination satisfies claim 13 under Patent Owner's apparent litigation construction. *Petition 3* Ground 2 shows how claim 29 is obvious based on the Ground 1 combination plus one additional, new prior art reference (Goldsmith).

**I. PETITION 3 CHALLENGES TWO CLAIMS RECENTLY  
ASSERTED BASED ON UNFORESEEN CLAIM CONSTRUCTIONS**

*Petition 3* challenges only dependent claims 13 and 29. In view of word count limits, *Petition 1* did not challenge these claims as, *inter alia*, Patent Owner had not yet formally asserted them or offered its apparent claim interpretations, which Petitioner could not have reasonably foreseen. *Petition 3* is necessary for the Board

to efficiently address, in one forum, all of Patent Owner's asserted claims. While the PTAB practice guide says multiple petitions should be "rare" (TPG, 59), the Board recognizes several exceptions that align with the facts here.

*First*, Patent Owner asserts a total of 25 claims. The TPG itself recognizes that "more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation ...." *Id.* In fact, the Board has found filing even "three or more" petitions appropriate to challenge different subsets of a large number of asserted 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).

*Second*, Petition 3 challenges only recently asserted claims. Later petitions have routinely been instituted where a patent owner newly asserts claims after a first petition is filed. *See, e.g., Mercedes-Benz USA, LLC v. Carucel Invs., L.P.*, IPR2019-01644, Paper 9, at 9-15 (PTAB Mar. 26, 2020); *Netflix, Inc. v. Avago Techs. Int'l Sales PTE. Ltd.*, IPR2021-00431, Paper 8, at 3 (PTAB Jun. 25, 2021). And, Patent Owner's apparent constructions for claims 13 and 29 (discussed in Petition Section VI) are contrary to the plain meaning and were unforeseeable.

*Third*, the timing of Petition 3 is not unreasonable. In a similar circumstance, the Board found that a delay of seven months in filing a second petition on claims not challenged in a first petition was "not unreasonable" and declined to exercise

discretion. *Cirrus Design Corp. v. Fleming*, IPR2020-00762, Paper 19 at 14 (PTAB Oct. 1, 2020). Some claims challenged in Cirrus’s second petition were asserted shortly *before* its first petition was filed. *Id.* at 12. Here, claims 13 and 29 were not asserted until well over 4 months *after* Petition 1 was filed, and Petitioner diligently prepared Petition 3 to challenge those claims, filing it less than 7 weeks later.

## II. COMPARING PETITION 3 AND PETITION 1

A relative ranking between Petitions 1 and 3 is inappropriate. These petitions challenge different claims. *See Mercedes-Benz*, Paper 9, at 11 (PTAB Mar. 26, 2020). This table shows how Petition 3 builds off Petition 1 Ground 1 to challenge claim 13 (Ground 1) and adds one reference to challenge claim 29 (Ground 2):

| Petition 1 (IPR2023-01251)                |                                   | Petition 3 (IPR2024-00521)                            |        |
|-------------------------------------------|-----------------------------------|-------------------------------------------------------|--------|
| Grounds                                   | Claims                            | Grounds                                               | Claims |
| 1: Patel-2009, Paradigm® REAL-Time        | 1-3, 5-8, 11-12, 17-24, 26-28, 30 | 1: Patel-2009, Paradigm® REAL-Time                    | 13     |
|                                           |                                   | 2: Patel-2009, Paradigm® REAL-Time + <i>Goldsmith</i> | 29     |
| 2: Ground 1 + Causey                      | 4, 9-10, 15-16, 25                | N/A                                                   |        |
| 3: Patel-2008 and incorporated references | 1-12, 14-18, 20-28, 30            |                                                       |        |

To the extent a ranking is required Petitioner ranks Petition 3 second.

## III. THE BOARD SHOULD INSTITUTE PETITION 3

The Board should institute Petition 3 for at least three reasons.

*First*, the Board having already instituted Petition 1, Petition 3 adds only minimal work because it (i) relies on the same Ground 1 presented in Petition 1 with a mapping of claim 13 that satisfies Patent Owner’s litigation constructions and (ii) adds a single additional reference for claim 29. Given that Petitions 1 and 3 present largely overlapping prior art grounds and assume the same effective filing date, the most efficient use of Board and Party resources is for the Board to address all of these grounds and claims, rather than have the Board address the Petition 1 claims and the court the Petition 3 claims.

*Second*, claims 13 and 29 were not formally asserted when Petition 1 was filed, nor had Patent Owner offered its unforeseen interpretation of them that it first presented over 4 months later. When filing Petition 1, Petitioner noted that Patent Owner was asserting “at least claim 1” but that “Patent Owner has not limited the asserted claims and thus currently is presumed to assert all 30 claims.” *E.g.*, IPR2023-01251, Paper 2 at 4. However, given word count limits, the apparent lack of an infringement theory, and Patent Owner’s unforeseeable claim constructions, Petition 1 did not challenge claims 13 and 29. While all claims—including 13 and 29—were previously challenged in Petition 2, the Board exercised its discretion not to institute Petition 2 and did not consider the difference in challenged claims in reaching its decision. IPR2023-01252, Paper 9 at 14, n.6. Moreover, Petition 2 relied on a priority challenge and mapping the claims to the ’056 patent’s grandparent

application, and thus did not present any word count issues. Denying Petition 3 would deny Petitioner the opportunity to challenge newly asserted claims 13 and 29.

*Third*, Patent Owner will not be prejudiced by having Petition 3 considered. Patent Owner could have formally asserted claims 13 and 29 before Petition 1 was filed, or otherwise communicated its apparent constructions of those terms. Though filed after institution of Petition 1, Petition 3 was substantially complete before that institution (and filed on the institution decision's due date) and its grounds are not informed by Patent Owner's POPRs or the Board's decisions. Rather, Petition 3 utilizes unmodified one of Petition 1's grounds to map claim 1 features and then uses the same combination to show the obviousness of dependent claim 13 and one additional reference to show the obviousness of dependent claim 13.

#### **IV. CONCLUSION**

The Board should institute Petition 3 to ensure that Patent Owner is not able to avoid having the unpatentability of later-asserted claims considered by the Board. Both Petition 1 and Petition 3 have compelling merits, and both are needed to address all asserted claims, and to address Patent Owner's unforeseen interpretations of newly-asserted claims 13 and 29.

Respectfully submitted,

February 9, 2024

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

The undersigned certifies that on February 9, 2024 a complete copy of **Petitioner's Explanation Of Material Differences Between The Petition In IPR2024-00521 And The Previously Instituted Petition In IPR2023-01251** was served via **Express Mail** on the Patent Owner at the following address of record as listed on the USPTO Patent Center:

One LLP - ADC  
Alana Fredericks  
23 Corporate Plaza, Suite 150  
Newport Beach, CA 92660

Counsel for Petitioner further certifies that a courtesy copy of **Petitioner's Explanation Of Material Differences Between The Petition In IPR2024-00521 And The Previously Instituted Petition In IPR2023-01251** was served on Patent Owner's counsel of record in IPR2023-01251, at the following email addresses:

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