

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. IPR2024-00521

U.S. Patent No. 11,298,056

PATENT OWNER'S PRELIMINARY RESPONSE

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TABLE OF EXHIBITS

Exhibit No.	Description
2001	March 3, 2023 Complaint for Patent Infringement, <i>Abbott Diabetes Care Inc., v. DexCom Inc.</i> , No. 23-239-KAJ (D. Del. Mar. 3, 2023)
2002	Notice of Opposition to a European Patent No EP 3 069 279 B1 (July 26, 2021)
2003	Joint Claim Construction Chart, <i>Abbott Diabetes Care Inc., v. DexCom Inc.</i> , No. 23-239-KAJ (D. Del. Mar. 21, 2023)
2004	July 28, 2023 E-mail from DexCom (Hoeschen) to Abbott with proposed Scheduling Order for Case No. 23-239 (D. Del.)

I. INTRODUCTION

Patent Owner Abbott Diabetes Care Inc. submits this Preliminary Response to the Petition filed by DexCom, Inc. (“Petitioner”) requesting *inter partes* review of two dependent claims of U.S. Patent No. 11,298,056 (the “056 Patent”)—namely, claims 13 and 29 (the “Challenged Claims”). Petitioner previously filed two petitions against the 056 patent. See IPR2023-01251 (“Petition 1”) and IPR2023-01252 (“Petition 2”).

Petitioner’s third petition (“Petition 3” or “Petition”) is a “follow-on” petition to which *General Plastic* applies. Petitioner could have challenged claims 13 and 29 in Petition 1 and did challenge claims 13 and 29 in Petition 2, for which the Board denied institution. Petitioner’s piecemeal approach wastes Board and Patent Owner resources.

Petitioner has admitted that, when it filed the first two petitions, it “presumed” that Patent Owner would “assert all 30 [056] claims,” including claims 13 and 29, in the underlying litigation. IPR2023-01251, Paper 2 at 4. Petitioner also acknowledges that Petition 3 largely tracks Petition 1, relying on the same primary references and making substantially the same arguments. Given those admissions, Petitioner has no excuse for omitting claims 13 and 29 from Petition 1, particularly because it included the claims in Petition 2. Notably, in its explanations of material differences comparing Petition 1 and Petition 2, Petitioner ranked Petition 1 first, even though

it did not challenge all claims. IPR2023-01251, Paper 2 at 1. Petitioner now challenges the two claims it chose not to challenge in Petition 1, on substantially the same grounds asserted against other claims in Petition 1, its first ranked petition. This is exactly what *General Plastic* prohibits.

Critically, Petitioner waited to file its third petition until after the institution decisions for its first two petitions. *General Plastic* “addresses whether [Petitioner] had access to a Board decision or a preliminary response concerning its first petition, such that [Petitioner] would have been in a *position to gain a benefit* from having that information before filing its second petition.” *Apple Inc. v. Uniloc, 2017 LLC*, IPR2020-00854, Paper 9 at 10 (P.T.A.B. Oct. 28, 2020) (“*Apple I*”) (emphasis added). Petitioner cannot dispute that, by waiting to file its third petition, it had access to the institution decisions for the first two petitions and placed itself in a *position to gain a benefit*.

Petitioner nevertheless represents that it did not take advantage of the situation it created by waiting to file its third petition. *See, e.g.*, Pet. at 11. Petitioner’s approach would place the Board in the impossible position of applying *General Plastic* based on the unverifiable representations of the Petitioner. The proper *General Plastic* analysis looks at whether, due to Petitioner’s delay, it had access to the institution decisions and thereby put itself in a *position to benefit*, regardless of

its after-the-fact representations about whether it then took advantage of the situation it created.

As explained in greater detail below, the *General Plastic* factors weigh overwhelmingly against institution. The Board should exercise its discretion under 35 U.S.C. § 314(a) and deny institution for Petitioner's third petition against the 056 patent.

II. THE BOARD SHOULD DENY INSTITUTION UNDER 35 U.S.C. § 314(a)

A. Background

On August 1, 2023, Petitioner filed two IPR petitions challenging the 056 Patent. *See* IPR2023-01251, Paper 3 and IPR2023-01252, Paper 3. Specifically, Petition 1 challenged claims 1-12, 14-28, and 30 of the 056 Patent, while Petition 2 challenged all claims 1-30. *See id.* On November 10, 2023, Patent Owner filed a Preliminary Response to each of these two IPR petitions. *See* IPR2023-01251, Paper 7; IPR2023-01252, Paper 7. The Board issued its institution decisions for both Petitions on February 5, 2024, granting institution for Petition 1, and denying institution for Petition 2. *See* IPR2023-01251, Paper 11; IPR2023-01252, Paper 9.

On February 9, 2024, over six months after Petitioner filed Petitions 1 and 2, three months after Patent Owner filed its Preliminary Responses to those Petitions, and four days after the Board issued its institution decisions for both prior Petitions, Petitioner filed the current petition, again challenging the 056 Patent. Petition 3

challenges dependent claim 13 on the identical Ground 1 that was asserted in Petition 1. See Paper 2, Explanation of Material Differences, at 1. Petitioner also challenges claim 29 using the Ground 1 combination plus an additional, new prior art reference not used in either Petition 1 or 2. *Id.* As discussed below, Petitioner knew of this additional prior art reference well before Petitioner filed Petitions 1 and 2. See *infra* § II.B.4. Each of Petitions 1 and 2 challenged claim 1 of the 056 Patent, from which claims 13 and 29 depend. See IPR2023-01251, Paper 3; IPR2023-01252, Paper 3. Additionally, Petition 2, which was denied institution, explicitly challenged claims 13 and 29. See IPR2023-01252, Paper 3.

B. *General Plastic* Factors

Under § 314(a) and 37 C.F.R. § 42.108(a), the Director has discretion to deny institution of an IPR petition. *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at § II.B.4.i. (P.T.A.B. Sept. 6, 2017) (“*General Plastic*”). In exercising its discretion to deny institution for follow-on petitions (like the petition filed here), the Board considers seven non-exhaustive factors:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition;

4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and
7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

General Plastic, IPR2016-01357, Paper 19 at 8-10. As explained below, at least six of the seven *General Plastic* factors weigh in favor of denying institution, and the seventh is neutral. The Board should thus deny institution of this petition under 35 U.S.C. § 314(a).

1. Factor 1: Whether the Same Petitioner Previously Filed a Petition Directed to the Same Claims of the Same Patent

General Plastic factor 1 weighs against institution. The same petitioner, DexCom, Inc., filed Petition 3 challenging the same 056 Patent that was previously challenged in Petitions 1 and 2. The claims challenged here in Petition 3, claims 13 and 29, were previously challenged in Petition 2, which was not instituted by the Board. See IPR2023-01252, Paper 9 at 14-15. Petitioner attempts to now render unpatentable the same Challenged Claims using prior art known to Petitioner when it filed Petition 2 (and Petition 1).

Additionally, Petition 1 challenged claim 1, upon which claims 13 and 29 depend. Challenges to dependent claims “necessarily invoke a challenge to” the claims from which such claims depend. *See Apple, Inc. v. Immersion Corp.*, IPR2017-01369, Paper 7 at 10 (P.T.A.B. Nov. 21, 2017) (“*Apple II*”). In *Apple II*, only dependent claims (3-9) were challenged in a second petition, while claims 1 (independent) and 2 had been challenged in a first petition. *See id.* Given the necessary overlap of dependent claims with the claims from which they depend, such a petition “overwhelmingly challenges claims covering essentially the same scope as the claims challenged in the First Petition.” *id.* at 10-11. The same is true here. Independent claim 1, which necessarily requires analysis here, was also at issue in Petitions 1 and 2.

In sum, Petitioner has already filed an unsuccessful petition, Petition 2, challenging the exact same Challenged Claims as in the present Petition. Petitioner has also challenged, in Petitions 1 and 2, the independent claim from which the Challenged Claims depend.

Factor 1 weighs against institution.

2. Factor 2 : Whether at the Time of Filing of the First Petition the Petitioner Knew of the Prior Art Asserted in the Second Petition

General Plastic factor 2 weighs against institution. Petitioner admits, as it must, that it “‘knew of the prior art asserted’ in [Petition 3] when Petitioner filed Petition 1.” Pet. at 9.

Despite this, Petitioner asserts that “Petition 1 did not challenge claims 13 and 29” (while ignoring that Petition 2 *did in fact* challenge those claims) and that Petitioner “reasonably did not anticipate Patent Owner asserting those claims” in a related district court litigation. Pet. at 9-10. But that explanation is irrelevant to factor 2, which is focused on Petitioner’s knowledge of the prior art in the follow-on Petition when it filed the first Petition, and which is indisputably present here. And Petitioner’s statement that it reasonably did not anticipate claims 13 and 29 being asserted is refuted below in connection with factor 5.

Thus, factor 2 weighs against institution.

3. Factor 3: Whether at the Time of Filing of the Second Petition the Petitioner Already Received the Patent Owner’s Preliminary Response to the First Petition or Received the Board’s Decision on Whether to Institute Review in the First Petition

General Plastic factor 3 weighs against institution. When the present Petition 3 was filed, Petitioner had already received the Preliminary Responses to Petitions 1 and 2 *and* the institution decisions from the Board. See IPR2023-01251, Paper 7

(Patent Owner’s Preliminary Response, filed November 10, 2023), Paper 11 (Decision Granting Institution of *Inter Partes* Review, Entered February 5, 2024); IPR2023-01252, Paper 7 (Patent Owner’s Preliminary Response, filed November 10, 2023), Paper 9 (Decision Denying Institution of *Inter Partes* Review, Entered February 5, 2024). Petitioner therefore gained a strategic advantage by waiting to file Petition 3. Petitioner gained that advantage at the expense of Board and Patent Owner resources expended in connection with Petitioner’s third petition.

Petitioner now represents that the “grounds and argument presented by Petition 3 are not informed by the Board decisions or Patent Owner arguments in the first two IPRs.” Pet. at 11. But *General Plastics* does not place the Board in the impossible situation of relying on Petitioner’s unverifiable representations about whether it took advantage of the situation it created. Rather, “the third *General Plastic* factor addresses whether [Petitioner] had *access* to a Board decision or a preliminary response concerning its first petition, such that [Petitioner] would have been *in a position to gain a benefit* from having that information before filing its second petition.” *Apple I*, IPR2020-00854, Paper 9 at 10 (emphasis added). Petitioner cannot deny that it had “access” and was “in a position to gain a benefit.” That is the proper inquiry, regardless of Petitioner’s representations about whether it actually took advantage. See *General Plastic*, IPR2016-01357, Paper 19 at 17 (explaining that “factor 3 is directed to Petitioner’s *potential benefit* from receiving

and having the *opportunity* to study Patent Owner’s Preliminary Response, as well as our institution decisions on the first-filed petitions, prior to its filing of follow on petitions.”) (emphasis added). Thus, Petitioner’s styling of Petition 3 as essentially a copycat of Petition 1 is of no moment because, by waiting until after the Patent Owner’s Preliminary Response and the institution decision, Petitioner had the opportunity to study the arguments and decisions before filing Petition 3. And the price for Petitioner’s strategic advantage is the wasteful expenditure of finite Board resources, which should not be permitted under *General Plastic*.

Factor 3 weighs against institution.

4. Factor 4: The Length of Time that Elapsed Between the Time the Petitioner Learned of the Prior Art Asserted in the Second Petition and the Filing of the Second Petition

General Plastic factor 4 weighs against institution. Petitioner admits that it knew of all of the prior art asserted in Petition 3 when it filed Petitions 1 and 2. *See* Pet. at 9. Two of the prior art references in Petition 3, including the primary reference, were used in Petition 1, specifically Patel-2009 (Ex. 1212) and Paradigm® REAL-Time (Ex. 1211). And Petitioner knew of the additional prior art reference, Goldsmith (Ex. 1251), at least as early as July 27, 2021. On that date, a third party, Roche Diabetes Care GmbH, filed a European notice of opposition against Petitioner’s EP 3069279 B1 Patent, asserting Goldsmith as one of the references. Ex. 2002 at 3 (identifying US 2007/0093786 A1 (Goldsmith) as

evidence). Having knowledge of Goldsmith since mid-2021, Petitioner certainly could have brought a challenge against claims 13 and 29 of the 056 patent much sooner, including at least as of the date of filing of Petitions 1 and 2.

Moreover, Petitioner's arguments miss the mark. Petitioner asserts that it acted "diligently" and filed Petition 3 seven weeks after Patent Owner served an infringement claim chart in the underlying litigation (discussed in greater detail below in connection with factor 5). This is irrelevant to *General Plastic* factor 4. See Pet. at 11. Regardless of whether almost two months is diligent, factor 4 considers the length of time elapsed between the time Petitioner learned of the prior art and the filing of Petition 3. The timing of identifying asserted claims in the litigation is irrelevant to that inquiry. In any event, Petitioner's assertions regarding factor 4 are refuted below in connection with factor 5.

Thus, factor 4 weighs against institution.

5. Factor 5: Whether the Petitioner Provides Adequate Explanation for the Time Elapsed Between the Filings of Multiple Petitions Directed to the Same Claims of the Same Patent

General Plastic factor 5 weighs against institution. Petitioner repeatedly attempts to explain its failure to include claims 13 and 29 in Petition 1 (even though they were included in Petition 2) by arguing that they were "newly asserted" in the litigation after Petitions 1 and 2 were filed. See, e.g., Pet. at 8, 12, 15; see also Paper 2 at 2, 4, 5. But that same label applies to all 27 originally challenged dependent

claims in Petition 1, and in any event does not justify why Petitioner selectively omitted claims 13 and 29 for Petition 1. That omission remains unjustified, among other reasons, because Petitioner has admitted that when it filed Petition 1 it “presumed” that Patent Owner would “assert all 30 claims,” including claims 13 and 29, in the underlying litigation. *See* IPR2023-01251, Paper 2 at 4. Thus, Petitioner provides no adequate reason why it did not include claims 13 and 29 in its earlier petition.

The underlying lawsuit was filed in March 2023. Ex. 2001. In the Complaint, DexCom (the Petitioner here) was accused of infringing “at least claim 1 of the ’056 patent.” Ex. 2001 at 52. Thereafter, the parties exchanged proposed schedules for that litigation. On July 28, in its draft Scheduling Order, DexCom accepted Abbott’s (Patent Owner here) proposed date of December 20, 2023 for serving infringement claim charts (and identifying “the asserted claims”). Ex. 2004 at 1, 6, 16. Thereafter, on August 1, Petitioner filed Petitions 1 and 2, knowing that infringement charts in the underlying litigation had not yet been served and would not be served for more than four months. Nevertheless, at that time, Petitioner “presumed” that Patent Owner would “assert all 30 claims” from the 056 Patent. *See* IPR2023-01251, Paper 2 at 4. The Scheduling Order in that litigation was entered in September 2023 and did in fact set the date for serving initial claim charts (and identifying “the asserted claims”) as December 20, 2023. Ex. 1253 at 5. Thus, when Petitioner filed Petitions

1 and 2, Petitioner was fully aware that Patent Owner would later identify the asserted claims in its infringement charts, and indeed presumed that Patent Owner would assert all 30 claims from the 056 Patent.

Petitioner also argues that Patent Owner, in asserting claims 13 and 29, is using “unforeseen” claim constructions that it did not anticipate. *See, e.g.*, Pet. at 10, 11, 13, 15; *see also* Paper 2 at 2, 4, 5. This argument fails for at least two reasons.

First, Petitioner’s “unforeseen” argument disregards that, when it filed the first two petitions, Petitioner (1) “presumed” that Patent Owner would “assert all 30 [056] claims,” including claims 13 and 29, in the underlying litigation, IPR2023-01251, Paper 2 at 4, and (2) did in fact challenge claims 13 and 29 in its Petition 2. Those facts alone defeat Petitioner’s “unforeseen” argument. If Petitioner could not have anticipated the now Challenged Claims being asserted, it would not have challenged those claims in Petition 2.

Second, Petitioner’s “unforeseen” argument is contradicted by its conduct in the underlying litigation. Petitioner argues that claims 13 and 29 are asserted only because of “unforeseen apparent claim interpretations,” based on two claim terms, “sensor misposition error” in claim 13 and “secondary receiver unit ... configured to receive processed sensor data from the data processing and transmitter unit” in claim 29. Pet. at 10-11. However, in the underlying litigation, Patent Owner simply applies the plain and ordinary meaning to both terms. Ex. 2003 at 11-12. That cannot

be “unforeseen,” as Petitioner argues. More specifically, claim construction briefing in the underlying litigation is currently ongoing. For claim 29, neither party sought construction of the “... receive processed sensor data ...” term. *Id.* For claim 13, the proper construction of “sensor misposition error” is being briefed by the parties. The construction advanced by Patent Owner is simply the “[p]lain and ordinary meaning,” while it is actually the Petitioner that is proposing a different, narrower construction. *Id.* at 12.

Therefore, Petitioner’s assertion that it could not foresee Patent Owner asserting claims 13 and 29 based on unforeseen claim constructions does not explain the months-long delay in filing Petition 3.

In connection with other factors (2 and 4), Petitioner asserts that it acted diligently by filing Petition 3 about seven weeks after it learned of the asserted claims in the infringement charts served December 20, 2023. Pet. at 11. But all dependent claims, including claims 13 and 29, were challenged in Petition 2, which was filed simultaneously with Petition 1. Thus, this argument does not justify why Petitioner omitted claims 13 and 29 from its Petition 1. Moreover, when it filed Petitions 1 and 2, Petitioner “presumed” that Patent Owner would assert all 30 claims of the 056 Patent. *See* IPR2023-01251, Paper 2 at 4.

Further, the timing of filing Petitions 1 and 2 (and Petition 3) was entirely up to Petitioner. Petitioner knew that Patent Owner would have to serve an infringement

chart identifying its asserted claims in December, yet chose to file Petitions 1 and 2 in August. Petitioner could have waited until the asserted claims in the underlying litigation were identified before filing the Petitions—without any waiver of rights, and without filing unnecessary follow-on petitions.¹

Petitioner also argues that later-filed petitions “have routinely been instituted where a patent owner newly asserts claims after a first petition is filed.” Paper 2 at 2. But the decisions that Petitioner cites in support are inapposite. In *Mercedes-Benz USA, LLC v. Carucel Invs., L.P.*, the patent owner had previously identified one set of asserted claims, then after the first petition for review, added two more asserted claims. *See Mercedes-Benz USA, LLC v. Carucel Invs., L.P.*, IPR2019-01644, Paper 3 at 3-4 (P.T.A.B. Sept. 23, 2019) (claim set 1 served March 13, 2019; petition 1 filed July 31; claim set 2 added as asserted claims on August 15). Here, the asserted claims were not required to be identified until December 20. Four and one-half months before that due date, Petitioner filed Petitions 1 and 2—at which time “at least claim 1 of the ’056 patent” was asserted. *See Ex. 2001* at 52. Petitioner was aware that additional asserted claims could be identified later. In *Netflix, Inc. v.*

¹ Under 35 U.S.C. § 315(b), Petitioner could have filed Petitions 1, 2 and 3 any time before early March 2024 (one year from service of the March 3, 2023 Complaint). (Ex. 2001 (complaint).)

Avago Techs., Int’l Sales PTE. Ltd., the petitioner’s assertions regarding the timing of asserted claims were unchallenged. See *Netflix*, IPR2021-00431, Paper 8, at 3 (P.T.A.B. Jun. 25, 2021) (explaining that the patent owner in *Netflix* did “not address or rebut Petitioner’s arguments regarding multiple petitions”).

Finally, considering that Petitioner 3 relies on the same obviousness position as Petition 1 for independent claim 1, Petition 3 is directed to only two (relatively short) dependent claims. For this issue, Petitioner merely argues that it “acted diligently” in preparing Petition 3. Pet. at 11. Petitioner offers no explanation for why it took almost two months to file a petition for only two dependent claims, where all prior art references used were already known well in advance of the December 20 identification of asserted claims.

General Plastic factor 5 weighs against institution.

6. Factor 6: The Finite Resources of the Board

General Plastic factor 6 also weighs against institution. The finite resources of the Board should not be wasted by the Petitioner. Nothing prevented Petitioner from challenging claims 13 and 29 in Petition 1, especially considering that it did challenge those claims in Petition 2, and all prior art used in Petition 3 was already known.

Through Petition 3, Petitioner seeks to gain an unfair advantage by dedicating an entire petition to just two dependent claims. For example, because Petitioner

isolated claims 13 and 29 in a third petition, it was able to dedicate 23 pages to its challenge of just two dependent claims (13 and 29), not including the necessary analysis of independent claim 1. *See* Pet. at iii, 59-83. Had Petitioner properly included claims 13 and 29 in Petition 1, it would have been forced to make decisions required by all petitioners—to condense its argument for all claims within the 14,000 word limit. In Petition 1, Petitioner used all but 79 of its word limit. *See* IPR2023-01251, Paper 3 at 117. Twenty-three pages is far more than 79 words. Petitioner’s attempt to skirt the word limit is an additional drain on the Board’s finite resources.

Moreover, due to the over six-month time gap in the filing of Petition 1 and Petition 3, it is not feasible to consolidate the cases into a single IPR proceeding, as recognized by Petitioner. Pet. at 13 (“[I]t may not be possible to consolidate the cases into a single IPR proceeding.”). Indeed, as of the filing of this Patent Owner’s Preliminary Response, the IPR2023-01251 proceeding, spawned from Petition 1, has progressed to the point that Patent Owner has already filed its Patent Owner Response. IPR2023-01251, Paper 20. The requirement of a second, separate IPR proceeding in the event the present Petition is instituted would be an unnecessary drain on the finite resources of the Board.

The lone case cited by Petitioner, *Cirrus Design Corp. v. Fleming*, is unhelpful to Petitioner. There, as here, factor 6 weighed against institution. *See Cirrus Design Corp. v. Fleming*, IPR2020-00762, Paper 19 at 15 (P.T.A.B. Oct. 1, 2020). And as

in *Cirrus Design*, the timing of the follow-on petition here (with a seven month gap) makes separate trials inevitable. *See id.* at 15. The “[o]ther [c]onsiderations” present in *Cirrus Design* are simply not present here. *See id.* at 15-16. Among other things, unlike in *Cirrus Design*, there were not two separate identifications of asserted claims by Patent Owner here. *See id.* In this action, all asserted claims, aside from independent claim 1 which was identified in the Complaint, were identified at once, with the December 20, 2023 initial infringement contentions.

General Plastic factor 6 weighs against institution.

7. Factor 7: The Requirement Under 35 U.S.C. § 316(a)(11) to Issue a Final Determination Not Later Than 1 Year After the Date on Which the Director Notices Institution of Review

General Plastic factor 7 is neutral. The Board is required under 35 U.S.C. § 316(a)(11) to issue a final determination not later than one year after institution. As discussed above, in the event the present Petition is instituted, it would not be feasible to join the proceeding with IPR2023-01251. As such, the IPR2024-00521 proceeding would have to be on its own schedule.

Therefore, factor 7 is neutral.

C. Petition 3 Is Properly Considered a Follow-On Petition Under *General Plastic*

Petitioner argues that Petition 3 is not a follow-on petition under *General Plastic* because it addresses additional elements compared to Petition 1 (*i.e.*, the particular elements of dependent claims 13 and 29). *See* Pet. at 9. But this argument

is invalid here, as claims 13 and 29 were challenged in Petition 2. Moreover, the lone decision that Petitioner cites for support, *Volkswagen Group of Am., Inc. v. Carucel Investments, L.P.*, is inapposite. See IPR2019-01573, Paper 7 at 4, 5 (P.T.A.B. Jan. 22, 2020). First, in *Volkswagen*, unlike here, the follow-on petition involved a different set of claims (claims 56-59) and, importantly, a different independent claim (claim 56) than in the original petition. See *Volkswagen*, IPR2019-01573, Paper 7 at 4, 5 (P.T.A.B. Jan. 22, 2020). Second, unlike the Petitioner here, the petitioner in *Volkswagen* “did not wait around to see Patent Owner’s preliminary response to attempt to gain an advantage.” See *id.* at 8. Third, even though the *Volkswagen* panel said it was “not persuaded” the petition there was not “truly” a follow-on petition, it still analyzed the petition under *General Plastic*. See *id.* at 6-8.

Regardless, even when separate sets of claims are at issue, other panels have analyzed petitions as follow-on petitions under *General Plastic*, and exercised their discretion to deny institution. See, e.g., *Apple, Inc. v. Immersion Corp.*, IPR2017-01368, Paper 8 (P.T.A.B. Nov. 7, 2017) (denying follow-on petition that sought review of different claim set of same patent, where the petitioner could not adequately explain why it did not include follow-on-petitioned claims in its first petition) (“*Apple III*”); See also *Apple II*, IPR2017-01369, Paper 7 at 10-11, 15.

Petition 3 is a follow-on petition to which *General Plastic* applies.

III. CONCLUSION

For at least the foregoing reasons, the Board should deny institution.

Date: May 29, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that the Patent Owner's Preliminary Response to Petition for *Inter Partes* Review Pursuant to 37 C.F.R. § 42.107 in connection with *Inter Partes* Review Case IPR2024-00521 was served on this 29th day of May, 2024 by electronic mail to the following:

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned attorney for the Patent Owner declares that this Patent Owner's Preliminary Response has a total of 4,375 words, according to Microsoft Word® word count tool, excluding the parts of the Response exempted by 37 C.F.R. § 42.24(a)(1).

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