

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ABBOTT DIABETES CARE INC.,
Petitioner,

v.

DEXCOM, INC.,
Patent Owner.

Case No. IPR2024-00840

Patent No. 9,119,528

**JOINT MOTION TO TERMINATE PROCEEDING
UNDER 35 U.S.C. § 317(a)**

Petitioner Abbott Diabetes Care Inc. (“Abbott”) and Patent Owner Dexcom, Inc. (“Dexcom”) (collectively “the parties”) jointly request to terminate IPR2024-00840 under 35 U.S.C. § 317(a). The Board authorized the filing of this motion on January 10, 2025.

I. BACKGROUND AND RELATED IPR PROCEEDINGS

A joint motion to terminate generally must “(1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26 at 2 (P.T.A.B. July 28, 2014). Each of these background issues is discussed below in turn.

The parties have entered into a Confidential Settlement And Patent License Agreement (the “Settlement Agreement”).¹ This agreement is a true

¹ The Parties are filing the Settlement Agreement concurrently with this joint motion as Exhibit 1033, along with a “Joint Request to Treat Settlement Agreement as Business Confidential Information.” Petitioner’s Updated

copy of an “agreement or understanding ... including any collateral agreements ... made in connection with, or in contemplation of, the termination of” this inter partes review. 35 U.S.C. § 317(b). There are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding. The parties both believe that this proceeding should be terminated. No Final Written Decision is expected in this proceeding for approximately eleven more months.

Patent Owner asserted the patent at issue in this proceeding in *Abbott Diabetes Care Inc. et al. v. DexCom, Inc.*, No. 1:23-cv-00239 (D. Del). The parties have filed a joint motion to dismiss the district court litigation. There is no other pending litigation related to the patent at issue in this proceeding.

The following IPRs between the same parties have also been instituted and relate to patents that were asserted in the same district court litigation referenced above: IPR2024-00797, IPR2024-00859, IPR2024-00841, IPR2024-00853, IPR2024-00861, IPR2024-00890, and IPR2024-00891. The parties are moving to terminate or dismiss the IPRs referenced above.

II. STATEMENT OF RELIEF REQUESTED

Exhibit List, which includes this document, is appended as Appendix A to this document.

Under § 317(a), an *inter partes* review “***shall*** be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” The Parties jointly request termination of this IPR2024-00840, and the Office has not decided the merits of this IPR proceeding. There are no other preconditions of § 317(a). Therefore, the Parties have met the statutory requirement to terminate the proceeding before the Office has decided the merits of the proceeding, and good cause exists to terminate this proceeding. *See* 35 U.S.C. § 317(a).

III. CONCLUSION

For these reasons, the parties respectfully request termination of this IPR.

Date: January 14, 2025

Respectfully submitted,

/Scott C. Weidenfeller/

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APPENDIX A

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PETITIONER'S UPDATED EXHIBIT LIST

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Exhibit No.	Description of Exhibit
1001	U.S. Patent No. 9,119,528 (the “’528 patent”)
1002	File History for U.S. Patent No. 9,119,528
1003	Declaration of Dr. David Rodbard
1004	Curriculum Vitae of Dr. David Rodbard
1005	U.S. Patent Application Publication No. 2007/0208244 (“Brauker”)
1006	Stefania Guerra et al., <i>A Dynamic Risk Measure from Continuous Glucose Monitoring Data</i> , Diabetes Technology & Therapeutics, 13(8), 843-852 (Aug. 2011) (“Guerra”)
1007	Colleen S. Hughes et al., <i>Hypoglycemia Prevention via Pump Attenuation and Red-Yellow-Green “Traffic” Lights Using Continuous Glucose Monitoring and Insulin Pump Data</i> , Journal of Diabetes Science and Technology, 4(5), 1146-1155 (Sept. 2010) (“Hughes”)
1008	DexCom TM STS TM Continuous Glucose Monitoring System User’s Guide (“STS Guide”)
1009	U.S. Patent No. 6,565,509 (“Say”)
1010	FreeStyle Navigator Continuous Glucose Monitoring System User’s Guide (“Navigator Guide”)
1011	Giovanni Sparacino, et al., <i>Glucose Concentration Can Be Predicted Ahead in Time from Continuous Glucose Monitoring Sensor Time-Series</i> , IEEE Transactions on Biomedical Engineering, 54(5), 931-937 (May 2007) (“Sparacino”)
1012	U.S. Patent No. 10,702,215 (“’215 patent”)
1013	Paul G. Hayter et al., <i>Performance Standards for Continuous Glucose Monitors</i> , Diabetes Technology & Therapeutics, 7(5), 721-726 (2005) (“Hayter”)
1014	Andrea Facchinetti et al., <i>A New Index to Optimally Design and Compare Continuous Glucose Monitoring Glucose</i>

Exhibit No.	Description of Exhibit
	<i>Prediction Algorithms</i> , Diabetes Technology & Therapeutics, 13(2), 111-119 (2011) (“Facchinetti”)
1015	Aaron J. Kowalski, <i>Can We Really Close the Loop and How Soon? Accelerating the Availability of an Artificial Pancreas: A Roadmap to Better Diabetes Outcomes</i> , Diabetes Technology & Therapeutics, 11(1), S-113-S-119 (Sept. 2009) (“Kowalski”)
1016	U.S. Patent No. 5,973,613
1017	Premarket Approval (PMA) Order, FreeStyle Navigator Continuous Glucose Monitoring System (Mar. 12, 2008), https://www.accessdata.fda.gov/cdrh_docs/pdf5/P050020A.pdf
1018	Garry M. Steil et al., <i>Feasibility of Automating Insulin Delivery for the Treatment of Type 1 Diabetes</i> , Diabetes, 55, 3344-3350 (Dec. 2006)
1019	JPMorgan, North America Equity Research, Diabetes Care ADA 2006: Spotlight On Continuous Glucose Monitoring (June 11, 2006)
1020	Bruce Buckingham et al., <i>Prevention of Nocturnal Hypoglycemia Using Predictive Alarm Algorithms and Insulin Pump Suspension</i> , Diabetes Care, 33(5), 1013-1017 (May 2010)
1021	Eyal Dassau et al., <i>Real-Time Hypoglycemia Prediction Suite Using Continuous Glucose Monitoring</i> , Diabetes Care, 33(6), 1249-1254 (June 2010)
1022	Boris P. Kovatchev et al., <i>Symmetrization of the Blood Glucose Measurement Scale and Its Applications</i> , Diabetes Care, 20(11), 1655-1658 (Nov. 1997)
1023	David C. Klonoff et al., <i>Innovations in Technology for the Treatment of Diabetes: Clinical Development of the Artificial Pancreas (as Autonomous System)</i> , Journal of Diabetes Science and Technology, 5(3), 804-826 (May 2011)
1024	U.S. Patent No. 8,160,669

Exhibit No.	Description of Exhibit
1025	B. Wayne Bequette, <i>Continuous Glucose Monitoring: Real-Time Algorithms for Calibration, Filtering, and Alarms</i> , Journal of Diabetes Science and Technology, 4(2), 404-418 (Mar. 2010)
1026	Cesar C. Palerm et al., <i>Hypoglycemia Prediction and Detection Using Optimal Estimation</i> , Diabetes Technology & Therapeutics, 7(1), 3-14 (2005)
1027	Declaration of Sylvia D. Hall-Ellis, Ph.D.
1028	Approved Judgment, In the High Court of Justice, Business and Property Courts of England and Wales, Intellectual Property List (ChD) Patents Court, [2024] EWHC 36 (Pat)
1029	European Patent No. 2,914,159
1030	<i>Abbott Diabetes Care Inc. et al v. DexCom, Inc.</i> , No. 1:23-cv-00239, Dkt. 54 (D. Del. Sept. 19, 2023) (“Scheduling Order”)
1031	Stuart A. Weinzierl et al., <i>Fully Automated Closed-Loop Insulin Delivery Versus Semiautomated Hybrid Control in Pediatric Patients With Type 1 Diabetes Using an Artificial Pancreas</i> , Diabetes Care, 31(5), 934-939 (May 2008)
1032	Helen R. Murphy et al., <i>Closed-Loop Insulin Delivery During Pregnancy Complicated by Type 1 Diabetes</i> , Diabetes Care, 34, 406-411 (Feb. 2011)
1033	Confidential Settlement And Patent License Agreement

Date: January 14, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that the foregoing Joint Motion to Terminate the Proceedings served by electronic mail on the following counsel of record for Patent Owner:

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GNieberg-PTAB@wolfgreenfield.com

Date: January 14, 2025

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