

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. IPR2024-00841
Patent No. 10,709,364

**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 IPR2024-00841 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 1016, 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, IPR2024-00840, IPR2024-00853, IPR2024-00861, IPR2024-00859, 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 IPR2024-00841, 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

PETITIONER'S EXHIBIT LIST

Exhibit No.	Description of Exhibit
1001	U.S. Patent No. 10,709,364 (“364 patent”)
1002	Declaration of Dr. Anthony Edward George Cass
1003	Prosecution File History of U.S. Patent No. 10,709,364
1004	Gross et al., <i>Device and Method of Calibrating and Testing a Sensor for In Vivo Measurement of an Analyte</i> , U.S. Patent No. 6,275,717 (issued Aug. 14, 2001) (“ Gross ”)
1005	Feldman et al., <i>A Method of Calibrating an Analyte-Measurement Device, and Associated Methods, Devices and Systems</i> , U.S. Patent Appln. Pub. No. 2005/0239154 (Oct. 27, 2005) (“ Feldman ”)
1006	Feldman et al., <i>A Continuous Glucose Sensor Based on Wire Enzyme™ Technology—Results from a 3-Day Trial in Patients with Type 1 Diabetes</i> , Diabetes Technology & Therapeutics, Vol. 5, No. 5, pp. 769-779 (2003) (“ Feldman-2003 ”)
1007	Nishida et al., <i>Development of a ferrocene-mediated needle-type glucose sensor covered with newly designed biocompatible membrane, 2-methacryloyloxyethyl phosphorylcholine -co-n-butyl methacrylate</i> , Medical Progress through Technology, Vol. 21, No. 2., pp. 91-103 (May 1995) (“ Nishida ”)
1008	Velho et al., <i>Strategies for calibrating a subcutaneous glucose sensor</i> , Biomed. Biochim. Acta, Vol. 48, No. 11/12, pp. 957-964 (1989) (“ Velho ”)
1009	Ward et al., <i>A new amperometric glucose microsensor: in vitro and short-term in vivo evaluation</i> , Biosensors & Bioelectronics, Vol. 17, pp. 181-189 (2002) (“ Ward ”)

Exhibit No.	Description of Exhibit
1010	Mastrototaro et al., <i>Glucose Monitor Calibration Methods</i> , U.S. Patent No. 6,424,847 (issued July 23, 2002) (“ Mastrototaro ”)
1011	Say et al., <i>Analyte Monitoring Device and Methods of Use</i> , U.S. Patent No. 6,175,572 (issued Jan. 16, 2001) (“ Say ”)
1012	Heller et al. <i>Implanted Electrochemical Glucose Sensors for the Management of Diabetes</i> , Annu. Rev. Biomed. Eng., Vol. 1, pp. 153-175 (1999) (“ Heller ”)
1013	<i>Biosensors in the Body: Continuous in vivo Monitoring</i> , Ch. 1: An Introduction to in vivo Biosensing: Progress and Problems (David M. Fraser) (pp.1-56), Ch. 2: Electrochemical Sensors for in vivo Glucose Sensing (Milena Koudelka-Hep) (pp. 57-77) (ed. David M. Fraser, John Wiley & Sons Ltd. 1997) (“ Fraser ”)
1014	Scheduling Order, <i>Abbott Diabetes Care Inc. et al. v. DexCom, Inc.</i> , No. 1:23-cv-00239 (D. Del. Sept. 19, 2023)
1015	Declaration of Sylvia D. Hall-Ellis, Ph.D.
1016	Confidential Settlement And Patent License Agreement

Date: January 14, 2025

Respectfully submitted,

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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:

EHunt-PTAB@wolfgreenfield.com
RGiunta-PTAB@wolfgreenfield.com
GNieberg-PTAB@wolfgreenfield.com

Date: January 14, 2025

/Scott C. Weidenfeller/
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