Trials@uspto.gov
571-272-7822

Paper 12
Date: January 23, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ABBOTT DIABETES CARE INC.,
Petitioner,

v.

DEXCOM, INC.,
Patent Owner.

IPR2024-00841
Patent 10,709,364 B2

Before JAMES A. TARTAL, JON M. JURGOVAN, and FREDERICK C. LANEY, *Administrative Patent Judges*.

JURGOVAN, *Administrative Patent Judge*.

TERMINATION
Termination Due to Settlement After Institution of Trial
and *Granting* Joint Request to Treat Settlement Agreement
as Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. § 42.74

I. INTRODUCTION

Abbott Diabetes Care Inc. ("Petitioner") and DexCom, Inc. ("Patent Owner") (collectively "the Parties") filed, with our prior authorization, a Joint Motion to Terminate Proceeding seeking to terminate this case based on an agreement the Parties reached concerning settlement. Paper 10 ("Mot." or "Motion"). Along with the Motion, the Parties also filed a copy of a settlement agreement (Ex. 1016, "Settlement Agreement") and a Joint Request to File Settlement Agreement as Business Confidential Information (Paper 11, "Request"). As further explained below, the Motion and Request are each granted.

II. DISCUSSION

Under 35 U.S.C. § 317(a), "[a]n inter partes review instituted under this chapter 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." In the Motion, the Parties represent that they have reached an agreement to resolve all of their present disputes regarding U.S. Patent No. 10,709,364 B2 ("the '364 patent"), that the filed copy of the Settlement Agreement is a true copy, and that "there are no other agreements, oral or written, between the [P]arties made in connection with, or in contemplation of, the termination of this proceeding." Mot. 2.

We instituted trial in the above-identified proceeding. Paper 7. We have not yet decided the merits of this proceeding, and a final written decision has not been entered. Notwithstanding that the proceeding has moved beyond the preliminary stage, the Parties have shown adequately that termination of the proceeding is appropriate. Mot. 1–2. Under these circumstances, we determine that good cause exists to terminate the

proceeding with respect to the Parties.

The Parties also requested that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the '364 patent. Request 1. After reviewing the Settlement Agreement, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Motion is *granted* and IPR2024-00841 is *terminated* with respect to Petitioner and Patent Owner, pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Request is *granted*, and the Settlement Agreement shall be kept separate from the file of U.S. Patent No. 10,709,364 B2 and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

FOR PETITIONER:

Peter Chen
David Garr
Scott Weidenfeller
COVINGTON & BURLING LLP
pchen@cov.com
dgarr@cov.com
sweidenfeller@cov.com

For PATENT OWNER:

Elisabeth H. Hunt
Richard F. Giunta
Gregory S. Nieberg
WOLF GREENFIELD & SACKS, P.C.
ehunt-ptab@wolfgreenfield.com
rgiunta-ptab@wolfgreenfield.com
gnieberg-ptab@wolfgreenfield.com