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. IPR2024-00853
Patent No. 11,213,204

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 IPR2024-00853 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 1012, 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, IPR2024-00841, 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 IPR2024-00853, 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. 11,213,204 (the "'204 patent")
1002	File History for U.S. Patent No. 11,213,204
1003	Declaration of Mr. Lane Desborough
1004	*Curriculum Vitae* of Mr. Lane Desborough
1005	U.S. Patent Pub. No. 2011/0202495 ("Gawlick")
1006	U.S. Patent No. 7,301,463 ("Paterno")
1007	U.S. Patent Pub. No. 2011/0320130 ("Valdes")
1008	U.S. Patent Pub. No. 2011/0178717 ("Goodnow")
1009	U.S. Patent Pub. No. 2008/0154099 ("Aspel")
1010	Joint Claim Construction Chart, Doc. 107, *Abbott Diabetes Care Inc. et al v. DexCom, Inc.*, No. 1:23-cv-00239 (D. Del. Mar. 21, 2024)
1011	DexCom Inc.'s Opening Claim Construction Brief, Doc. 123, *Abbott Diabetes Care Inc. et al v. DexCom, Inc.*, No. 1:23-cv-00239 (D. Del. Apr. 18, 2024)
1012	Confidential Settlement And Patent License Agreement

Date: January 14, 2025

Respectfully submitted,

/Scott C. Weidenfeller/

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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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