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. IPR2024-00859
Patent No. 11,510,625

PETITIONER'S EXPLANATION OF PARALLEL PETITIONS CHALLENGING U.S. PATENT NO. 11,510,625

In accordance with the USPTO's PTAB Trial Practice Guide, Petitioner Abbott Diabetes Care Inc. ("Petitioner") submits this explanation for filing two petitions for inter partes review of U.S. Patent No. 11,510,625 (the "'625 patent") filed in IPR2024-00859 ("Petition 1") and IPR2024-00860 ("Petition 2"). *See* "Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019" ("TPG") at 59-60. Two petitions were required for two reasons.

First, Petition 2 solely includes grounds based on the asserted Rao reference, which is not asserted in Petition 1. DexCom, Inc. ("Patent Owner") may challenge whether Rao is prior art because of a dispute about the effective filing date of the '625 patent. This potential dispute has required Petitioner to make arguments under multiple effective filing dates for the '625 patent. *See id.* at 59.

Second, the petitions challenge the large number of claims asserted by Patent Owner against Petitioner in district court litigation (25 claims, including four independent claims). *See id.*; *see also Microsoft Corp. v. IPA Techs. Inc.*, IPR2019-00810, Paper 12 at 13-14 (Oct. 16, 2019) (determining that multiple petitions were reasonable when a petitioner was "[f]aced with word count limitations and a large number of challenged claims"). Indeed, the claim listing alone for the challenged claims includes 1,178 words. The Board should institute both inter partes reviews.

I. EXPLANATION OF THE MATERIAL DIFFERENCES BETWEEN THE TWO PETITIONS

The petitions challenge the same claims, but over different prior art references:

Petition	Challenged Claims	Ground
Petition 1: IPR2024-00859	1-9, 13-19, 22-30	Ground 1: §§102 or 103 over Pace
	4-5, 14-15, 26-27, 30	Ground 2: §103 over Pace in combination with Lundquist
	1-3, 6-9, 13, 16-19, 22-25, 28-29	Ground 3: §103 over Pace 2
	4-5, 14-15, 26-27, 30	Ground 4: §103 over Pace 2 in combination with Lundquist
	1-3, 6, 9, 13, 16, 22-24	Ground 5: §103 over Chae
Petition 2: IPR2024-00860	1-9, 13-19, 22-30	Ground 1: §103 over Rao
	4-5, 14-15, 26-27, 30	Ground 2: §103 over Rao in combination with Lundquist

The Board should, consistent with previous Board decisions, institute both petitions here. Each petition involves different prior art references, and therefore presents materially different grounds for challenging the patent, even though both petitions challenge all claims of the ’625 patent that Patent Owner has asserted against Petitioner in the district court litigation. *See SolarEdge Techs. Ltd. v. SMA Solar Tech. AG*, IPR2019-01224, Paper 10 at 10 (Jan. 23, 2020). In addition, Petition 2 involves an additional priority issue that is not relevant to the prior art cited in Petition 1. In particular, Rao’s priority date is between the filing dates of the two provisional patent applications to which the ’625 patent claims priority. Petitioner asserts that the challenged claims lack written description support in at least the first

such application, such that the ’625 patent is not entitled to the filing date of the first application. Patent Owner may challenge that assertion.

Moreover, the length and number of challenged claims justify multiple petitions. Patent Owner asserts infringement of 25 claims, including four independent claims, in the district court litigation. The asserted claims are lengthy, including more than 1,000 words in total. Petitioner thus requires additional words to challenge the asserted claims, despite its best efforts to narrow the unpatentability issues presented to the Board. Petitioner does not challenge separate sets of claims in the two petitions, as in *Microsoft*. It does not matter, however, that Petitioner divided the petitions by grounds, instead of claims, particularly when Petitioner incurred additional filing fees by doing so. The large number of claims supports a second petition either way, and Petitioner sought to simplify the presentation of the issues. This minimizes the burden from the second petition on the Board, and it separates the Rao grounds because of their priority issue.

II. RANKING OF THE PETITIONS

Given the overlapping issues raised in the petitions, the Board should institute both inter partes reviews because the burden to address the grounds raised in both petitions would not be substantially greater than that for just Petition 1. In addition, the Board and the parties can obtain efficiencies by holding a single oral

hearing and consolidating depositions in both proceedings. In accordance with the Board's direction that Petitioner should identify "a ranking of the petitions in the order in which it wishes the Board to consider the merits," though, Petitioner ranks Petition 1 first. TPG at 60.

Date: May 9, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6 and 42.105, I hereby certify that on May 9, 2024, I caused a true and correct copy of the foregoing Petitioner's Explanation of Parallel Petitions Challenging U.S. Patent No. 11,510,625 to be served via Priority Mail Express on the Patent Owner at the following correspondence address of record as listed on the USPTO Patent Center:

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