UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ABBOTT DIABETES CARE INC.,
Petitioner,

v.

DEXCOM, INC.,
Patent Owner.

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

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

I. TWO PETITIONS FOR THE '625 PATENT ARE UNNECESSARY

In conjunction with its Petitions in IPR2024-00859 ("Petition 1") and IPR2024-00860 ("Petition 2") challenging U.S. Patent No. 11,510,625 (the "'625 Patent"), Petitioner has submitted an Explanation of Parallel Petitions (the "Explanation"). Paper 3. The Board's November 2019 Consolidated Trial Practice Guide ("TPG") states that "one petition should be sufficient to challenge the claims of a patent in most situations." TPG, 59. "Two or more petitions filed against the same patent . . . may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns." *Id*. While the TPG recognizes that multiple petitions may be necessary in certain limited circumstances, for the reasons explained below, this is not such a case. Petitioner's arguments show its parallel petitions challenging the '625 Patent to be unnecessary and instituting both petitions would be unduly burdensome and inefficient to the Board and Patent Owner.

A. Petitioner Fails To Establish A Need For Multiple Petitions

Petitioner's Explanation first argues that parallel petitions are necessary here because Petition 2 relies on a reference (Rao) for which Petitioner anticipates Patent Owner may dispute the effective filing date. Explanation, 1-2. While parallel petitions may be appropriate in some circumstances "when there is a dispute about priority," (TPG, 59) Petitioner misapprehends the Board's guidance. Petitioner's

position appears to be that an IPR petitioner is automatically entitled to multiple proceedings where the petitioner relies on prior art subject to a potential priority dispute. This is not so. *See Square, Inc. v. 4361423 Canada Inc.*, IPR2019-01626, Paper 14 at 9 (P.T.A.B. Mar. 30, 2020) ("The [TPG] statement does not convey that whenever a priority issue is involved, Petitioner is entitled to file two petitions against the same claims of the same patent."). The TPG instructs that a Petitioner, to aid the Board in determining whether parallel petitions are necessary, should provide "a succinct explanation of the differences between the petitions [and] why the issues addressed by the differences are material." TPG, 59-60. Here, Petitioner makes no comparison between the references relied on in its Petitions 1 and 2, nor does Petitioner attempt to explain why the disclosures of Rao are materially different and not cumulative of the references in Petition 1. Moreover, Petitioner's Explanation specifically ranks its Petition 1 over Petition 2. Had Petitioner considered its Petition 2 to be truly necessary, it should have explained how it presents a materially different challenge to the '625 Patent from the references presented in its preferred Petition 1.[1] Petitioner failed to do so and therefore has not shown that a second petition is

[1] Petitioner's own cited case, *SolarEdge Techs. Ltd. v. SMA Solar Tech. AG*, IPR2019-01224, Paper 10 (Jan. 23, 2020), suggests that institution of parallel petitions is not warranted here. In that case the Board instituted parallel petitions

necessary. Moreover, had Petitioner considered the disclosures of the Petition 2 reference to be stronger in some way, then it would have ranked that petition first. If the Rao petition had been ranked first, then Patent Owner could have stipulated to not challenge Rao's prior art status, thus obviating the other petition. *See Apple Inc. v. Seven Networks*, LLC, IPR2020-00254, Paper 13 at 9 (PTAB July 28, 2020) (finding that "the possibility of [patent owner] antedating the asserted references here does not warrant instituting multiple IPR proceedings" where patent owner stipulated not to attempt to antedate those references). Accordingly, Patent Owner's own ranking shows that the alleged priority dispute does not warrant instituting multiple petitions based on a potential priority dispute.

Petitioner further argues that parallel petitions are justified by the length and number of challenged claims (Explanation, 3), but this argument also falls flat. First, Petitioner cites no cases finding the number of challenged claims (25) to be so great as to require multiple petitions. Moreover, there is substantial overlap between the

---

because the petitioner's Ranking specifically identified material differences between the relied-on prior art. *SolarEdge*, IPR2019-01224, Paper 10 at 10 ("First, we agree with Petitioner that the respective Petitions address the 'two-chambered inverter housing' requirement in materially different ways."). Petitioner has failed to do the same here.

language of the ’625 Patent’s independent and dependent claims, as reflected by the Petition’s reliance throughout on its earlier claim analysis for subsequent claims with similar language. *See e.g.,* Petition, 57-59 (citing to prior claim 1 analysis as satisfying 11 distinct limitations of claim 28 without additional analysis). Therefore, while the Petition challenges 25 claims, Petitioner ignores the substantial overlap in language between the claims, which has lessened Petitioner’s burden in presenting its challenge within the mandated word limits.

Finally, Petitioner’s assertion that multiple petitions are necessary here is contradicted by the fact that its Petition 1 presents grounds based on *three* separate primary references (Pace, Pace 2, and Chae). Explanation, 2. That Petitioner needs a second petition to present grounds based on a fourth primary reference (Rao) shows not that a second petition is necessary, but rather that Petitioner was not judicious in selecting its grounds. Had Petitioner believed that Rao presents a better or materially different challenge than references presented in Petition 1, then Petitioner could have simply omitted one of the three primary references presented in Petition 1 in favor of Rao. Petitioner’s Explanation, again, does not identify any material differences between the references across the two Petitions and therefore fails to demonstrate that Petitioner would have been prejudiced by including its grounds based on Rao in Petition 1 instead of one of the three other primary references presented in that petition.

II. CONCLUSION

For the reasons explained, if the Board institutes one of Petitions 1 or 2, the Board should deny the other one.

Respectfully submitted,

Dated: August 23, 2024

By: /Andrew M. Mason/

Andrew M. Mason, Reg. No. 64,034
andrew.mason@klarquist.com
KLARQUIST SPARKMAN, LLP
One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Tel: 503-595-5300
Fax: 503-595-5301

Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned certifies that on August 23, 2024, a complete copy of **PATENT OWNER'S RESPONSE TO PETITIONER'S EXPLANATION OF PARALLEL PETITIONS CHALLENGING U.S. PATENT NO 11,510,625** was served on counsel for Petitioner via email as follows:

Scott C. Weidenfeller
David A. Garr
Covington & Burling LLP
One City Center
850 Tenth Street NW
Washington, DC 20001
Email: sweidenfeller@cov.com
dgarr@cov.com
Abbott-IPR@cov.com

Peter P. Chen
Covington & Burling LLP
3000 El Camino Real
5 Palo Alto Square, 10th Floor
Palo Alto, CA 94306
Email: pchen@cov.com
Abbott-IPR@cov.com

By: /Andrew M. Mason/
Andrew M. Mason, Reg. No. 64,034
andrew.mason@klarquist.com
KLARQUIST SPARKMAN, LLP
One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Tel: 503-595-5300
Fax: 503-595-5301

Counsel for Patent Owner