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Paper No. __

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. IPR2024-00891
Patent No. 11,020,031

PATENT OWNER'S RESPONSE TO PETITIONER'S EXPLANATION OF PARALLEL PETITIONS

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I. INTRODUCTION

"[O]ne petition should be sufficient to challenge the claims of a patent" in "the vast majority of cases." PTAB Consolidated Trial Practice Guide (Nov. 2019) ("TPG") at 59. This is not one of the "rare" cases where two petitions "may be needed"—the number of challenged claims is not "large," there is significant overlap in the claim language of the challenged claims across the petitions, and Petitioner ("Abbott") does not allege any "dispute about priority date." *Id.*

Here, Abbott filed two petitions solely in order to present multiple grounds—one ground based on Zhang ***and*** one ground based on Shin—for every challenged claim. Paper 3 ("Expl."), 1-2. But "[t]here is no entitlement to assert … more than one ground … against each challenged claim." *Global Tel*Link Corp. v. HLFIP Holding, Inc.*, IPR2021-00445, Paper 14 at 18 (June 22, 2021). Where, as here, Petitioner has failed to show "that it could not fit a single ground against the asserted claims into a single petition, … Petitioner has not shown that it was necessary to distribute its challenges across [two] petitions." *Fantasia Trading LLC v. Cognipower, LLC*, IPR2021-00068, Paper 22 at 12-13 (May 12, 2021).

The Board should exercise its discretion to deny institution of Abbott's second petition.

II. THE NUMBER OF CHALLENGED CLAIM IS NOT LARGE, ESPECIALLY BECAUSE THERE IS SIGNIFICANT OVERLAP AMONG CLAIM LIMITATIONS

Abbott's sole alleged justification for filing multiple petitions is the "length and number of challenged claims." Expl., 2. Abbott's two petitions "challenge[] 40 claims, including five independent claims," which Abbott argues "are lengthy and recite more than 2,000 words in total." *Id*. However, Abbott chose to split the challenged claims over two petitions not because there are too many claims to address in one petition, but because Abbott wanted to pursue Zhang-based ***and*** Shin-based grounds against every claim.

Forty claims is not *per se* a large number that justifies multiple petitions. *See Fantasia*, IPR2021-00068, Paper 22 at 9-13 (finding petitioner failed to "demonstrate[] a need for multiple petitions" where 53 claims (including four independent claims) were asserted in litigation); *Fantasia Trading LLC v. CogniPower, LLC*, IPR2021-00072, Paper 20 at 9 (May 12, 2021) (59 claims); *Comcast Cable Commc'ns, LLC v. Rovi Guides, Inc.*, IPR2020-00796, Paper 8 at 10-11 (Oct. 21, 2020) (56 claims); *Apple Inc. v. SEVEN Networks, LLC*, IPR2020-00254, Paper 13 at 9-10 (Jul. 28, 2020) (50 claims).

This case is unlike the only decision Abbott cites – *Microsoft Corp. v. IPA Techs. Inc.*, IPR2019-00810, Paper 12 (Oct. 16, 2019) (cited Expl., 1) – where the

petitioner faced the prospect of "***89 claims***" being asserted ***and***, unlike here, there were also disputes over "priority dates." *Id.* at 14.

Abbott notes that it is challenging five independent claims but does not address the fact that the independent claims have significant overlap, which undercuts Abbott's argument that the number of claims required two petitions. *Global Tel*Link*, IPR2021-00445, Paper 14 at 17 ("disagree[ing] that the distinct elements within each independent claim" constitute "a need for Petitioner to file multiple petitions to challenge the claims" where "there is overlap in the elements of [the] independent claims"). Indeed, Abbott's petitions treat independent claims 14, 35, and 42 like they treat dependent claims: by presenting no new analysis for limitations shared with independent claims 1 and 23, and only presenting analysis for any differing limitations. -00890 Petition, 49-52, 68-71; -00891 Petition, 45-53, 54-56, 69-74, 75-77. Moreover, Abbott's mapping of the independent claims challenged in the -00890 Petition (claims 1 and 14) shares significant overlap with that of independent claims challenged in the -00891 Petition (claims 35 and 23, respectively). *Compare* -00890 Petition, 4 (claim 1) *with* -00891 Petition, 6-7 (claim 35) *and* -00890 Petition, 6 (claim 14) *with* -00891 Petition, 4 (claim 23). Because of the significant overlap in claim limitations within and across Abbott's Petitions, the number of claims challenged here does not necessitate two petitions.

III. ABBOTT DOES NOT EVEN ALLEGE THAT IT COULD NOT HAVE ADDRESSED ALL CHALLENGED CLAIMS IN ONE PETITION WITH FEWER GROUNDS

"The determinative question for instituting on more than one petition is whether Petitioner has shown a ***need*** for two petitions." *Infinera Corp. v. Oyster Optics, LLC*, IPR2020-00326, Paper 12 at 12 (June 26, 2020) (emphasis added). While Abbott's "petitions in the two proceedings challenge different claims, [Abbott] chose that claim allocation without persuasively explaining the 'need' to do so." *Id*. Abbott has "not address[ed] why it could not have, in one petition, presented one ground of unpatentability for each challenged claim," and has not "explain[ed] why it needs to challenge" the claims "under more than one ground," and thus "has not persuasively explained why it needs two petitions." *Id*. at 13 (denying institution).

Abbott asserts that it made "its best efforts to narrow the unpatentability issues presented to the Board" (Expl., 2), but that plainly is not true, given that Abbott doubled the amount of work for the Board and for Patent Owner by presenting two grounds per claim. "There is no entitlement to assert … more than one ground of unpatentability against each challenged claim," and this "is not a circumstance … in which the prior art references applied to each independent claim are substantially different." *Global Tel*Link*, IPR2021-00445, Paper 14 at 17-18. Rather, both petitions use the "same prior art references"—both Zhang and

Shin—against every challenged claim (Expl., 1-2), and Abbott's Paper never alleges any material differences between the Zhang and Shin grounds, and fails to establish "why it is necessary to assert multiple petitions that rely on multiple grounds when a single petition could have been presented to challenge the claims." *Fantasia*, IPR2021-00068, Paper 22 at 13. Two petitions' worth of grounds "place a substantial and ***unnecessary*** burden on the Board and the patent owner." TPG, 59 (emphasis added). "The key question is whether multiple alleged grounds are ***necessary***," and Abbott did not even attempt to make that showing. *Global Tel*Link*, IPR2021-00445, Paper 14 at 14 (emphasis added).

Abbott's filing of multiple petitions "could have been avoided had [a single] petition been directed to grounds that rely on one primary prior art reference"—either Zhang or Shin. *Fantasia*, IPR2021-00068, Paper 22 at 12. Abbott's failure to show otherwise warrants discretionary denial. *Id*. at 11-13.

IV. ABBOTT'S SECOND PETITION SHOULD BE DENIED

For the above reasons, the Board should exercise its discretion to deny institution of Abbott's second-ranked petition under §314(a).

Respectfully submitted,
DexCom, Inc.

Date: 2024-09-18

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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (e)(4)

I certify that on September 18, 2024, I will cause a copy of the foregoing document, including any exhibits filed therewith, to be served via electronic mail, as previously consented to by Petitioner, upon the following:

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