

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

**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 IPR2024-00891 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 1033, 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, IPR2024-00853, IPR2024-00861, IPR2024-00859, and IPR2024-00890. 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 IPR2024-00891, 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,

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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. 11,020,031 (“’031 patent”)
1002	Declaration of Dr. Anthony Edward George Cass
1003	Prosecution File History of U.S. Patent No. 11,020,031
1004	Zhang et al., <i>System and Method for Sensor Recalibration</i> , U.S. Patent Application Publication No. 2005/0143636 (published June 30, 2005) (“ Zhang ”)
1005	David A. Gough, <i>Method and Membrane Applicable to Implantable Sensor</i> , U.S. Patent No. 4,650,547 (issued Mar. 17, 1987)
1006	David A. Gough et al, <i>Complete Glucose Monitoring Systems with an Implantable, Telemetered Sensor Module</i> , U.S. Patent No. 4,703,756 (issued Nov. 3, 1987)
1007	Wayne A. Morgan et al., U.S. Patent Application Publication No. 2003/0076082, <i>Implantable Sensor Electrodes and Electronic Circuitry</i> (published Apr. 24, 2003) (“ Morgan ”)
1008	John J. Shin et al., <i>Real Time Self-Adjusting Calibration Algorithm</i> , U.S. Patent Application Publication No. 2005/0004439 (published Jan. 6, 2005) (“ Shin ”)
1009	John J. Mastrototaro et al., <i>Glucose Sensor</i> , U.S. Design Application No. 29/101,218 (U.S. Design Patent D433,755, issued Nov. 14, 2000) (the “ ’218 application ”)
1010	John J. Mastrototaro et al., <i>Glucose Monitor Calibration Methods</i> , U.S. Patent No. 6,424,847 (issued July 23, 2002) (“ Mastrototaro ”)
1011	James Say et al., <i>Analyte Monitoring Device and Methods of Use</i> , U.S. Patent No. 6,175,572 (issued Jan. 16, 2001) (“ Say ”)

Exhibit No.	Description of Exhibit
1012	Benjamin J. Feldman et al., <i>A Method of Calibrating an Analyte-Measurement Device, and Associated Methods, Devices and Systems</i> , U.S. Patent Application Publication No. 2005/0239154 (published Oct. 27, 2005) (“ Feldman ”)
1013	William Peter Van Antwerp et al., <i>Hydrophilic, Swellable Coatings for Biosensors</i> , U.S. Patent No. 5,786,439 (issued July 28, 1998) (“ Van Antwerp ”)
1014	Marc D. Breton et al., <i>Method, System and Computer Program Product for Real-Time Detection of Sensitivity Decline in Analyte Sensors</i> , U.S. Patent Application Publication No. 2008/0172205 (published July 17, 2008) (“ Breton ”)
1015	John P. Willis, <i>Biofouling Self-Compensating Biosensor</i> , U.S. Patent Application Publication No. 2007/0299617 (published Dec. 27, 2007) (“ Willis ”)
1016	Sridhar G. Iyengar et al., <i>Method and Apparatus for Assay of Electrochemical Properties</i> , U.S. Patent Application Publication No. 2005/0069892 (published Mar. 31, 2005) (“ Iyengar ”)
1017	Adam Heller et al., <i>Analyte Monitoring Devices and Methods of Use</i> , U.S. Patent No. 6,560,471 (issued May 6, 2003) (“ Heller-2003 ”)
1018	Leann M. Lesperance et al., <i>Calibration of the Continuous Glucose Monitoring System for Transient Glucose Monitoring</i> , <i>Diabetes Technology & Therapeutics</i> , Vol. 9, No. 2, pp. 183-190 (2007) (“ Lesperance ”)
1019	Eva Dock et al., <i>Multivariate Data Analysis of Dynamic Amperometric Biosensor Responses From Binary Analyte Mixtures—Application of Sensitivity Correction Algorithms</i> , 65 <i>Talanta</i> 298-305 (2005) (“ Dock ”)

Exhibit No.	Description of Exhibit
1020	David M. Fraser, <i>An Introduction to in vivo Biosensing: Progress and Problems</i> , in David M. Fraser, <i>Biosensors in the Body: Continuous In Vivo Monitoring</i> , Ch. 1, pp. 1-56 (John Wiley & Sons Ltd. 1997) (“ Fraser ”)
1021	Milena Koudelka-Hep, <i>Electrochemical Sensors for in vivo Glucose Sensing</i> , in David M. Fraser, <i>Biosensors in the Body: Continuous In Vivo Monitoring</i> , Ch. 2, pp. 57-77 (John Wiley & Sons Ltd. 1997) (“ Koudelka-Hep ”)
1022	Michael Schlosser and Manfred Ziegler, <i>Biocompatibility of Active Implantable Devices</i> , in David M. Fraser, <i>Biosensors in the Body: Continuous In Vivo Monitoring</i> , Ch. 5, pp. 139-170 (John Wiley & Sons Ltd. 1997) (“ Schlosser ”)
1023	George S. Wilson and Yanan Zhang, <i>Introduction to the Glucose Sensing Problem</i> , in David D. Cunningham and Julie A. Stenken, <i>In Vivo Glucose Sensing</i> , Ch. 1, pp. 1-27 (John Wiley & Sons, Inc. 2010) (“ Wilson ”)
1024	Marisha L. Godek and David W. Granger, <i>The Macrophage in Wound Healing Surrounding Implanted Devices</i> , in David D. Cunningham and Julie A. Stenken, <i>In Vivo Glucose Sensing</i> , Ch. 2, pp. 29-58 (John Wiley & Sons, Inc. 2010) (“ Godek ”)
1025	Timothy Henning, <i>Commercially Available Continuous Glucose Monitoring Systems</i> , in David D. Cunningham and Julie A. Stenken, <i>In Vivo Glucose Sensing</i> , Ch. 5, pp. 113-156 (John Wiley & Sons, Inc. 2010) (“ Henning ”)
1026	K. Nishida et al., <i>Development of a ferrocene-mediated needle-type glucose sensor covered with newly designed biocompatible membrane, 2-methacryloyloxyethyl phosphorylcholine -co-n-butyl methacrylate</i> , 21 Medical Progress through Technology 91-103 (1995) (“ Nishida ”)

Exhibit No.	Description of Exhibit
1027	Adam Heller, <i>Implanted Electrochemical Glucose Sensors for the Management of Diabetes</i> , 1 Annu. Rev. Biomed. Eng. 153 (1999) (“ Heller ”)
1028	S.J. Alcock and A.P.F. Turner, <i>Continuous Analyte Monitoring to Aid Clinical Practice</i> , 13 IEEE Engineering in Medicine and Biology 319-325 (1994) (“ Alcock ”)
1029	Megan C. Frost and Mark E. Meyerhoff, <i>Implantable Chemical Sensors For Real-Time Clinical Monitoring: Progress And Challenges</i> , 6 Current Opinion in Chemical Biology 633-641 (2002) (“ Frost ”)
1030	N. Wisniewski et al., <i>Characterization of Implantable Biosensor Membrane Biofouling</i> , 366 Fresenius J Analytical Chemistry 611-621 (2000) (“ Wisniewski ”)
1031	Scheduling order, Sept. 2023, from <i>Abbott Diabetes Care Inc. et al. v. DexCom, Inc.</i> , No. 1:23-cv-00239 (D. Del)
1032	Declaration of Sylvia D. Hall-Ellis, Ph.D.
1033	Confidential Settlement And Patent License Agreement

Date: January 14, 2025

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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:

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GNieberg-PTAB@wolfgreenfield.com

Date: January 14, 2025

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