

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROCHE DIABETES CARE, INC.,
Petitioner,

v.

TRIVIDIA HEALTH, INC.,
Patent Owner.

Patent No. 8,128,981

IPR Case No.: IPR2025-00553

**PATENT OWNER'S DISCRETIONARY DENIAL
REQUEST**

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TABLE OF EXHIBITS

Exhibit	Description
2001	October 8, 2024, Scheduling Order from <i>Roche Diabetes Care, Inc. v. Trividia Health, Inc.</i> , Case No. 1:24-cv-00668-GBW (D. Del)
2002	Docket Navigator report of docket entries for <i>Roche Diabetes Care, Inc. v. Trividia Health, Inc.</i> , Case No. 1:24-cv-00668-GBW (D. Del)
2003	April 30, 2025, Markman hearing transcript from <i>Roche Diabetes Care, Inc. v. Trividia Health, Inc.</i> , Case No. 1:24-cv-00668-GBW (D. Del)
2004	June 13, 2025, Stipulation and Order to Extend Time from <i>Roche Diabetes Care, Inc. v. Trividia Health, Inc.</i> , Case No. 1:24-cv-00668-GBW (D. Del)

I. Introduction

Pursuant to the “Interim Processes for PTAB Workload Management Memorandum” issued by Director Stewart on March 26, 2025 (“Stewart Memo”), Trividia Health, Inc. (“Trividia” or “Patent Owner”) hereby requests the Patent Trial and Appeal Board (“PTAB”) exercise its authority to discretionarily deny the Petition filed against U.S. Patent No. 8,128,981 (“the ’981 patent”) by Roche Diabetes Care, Inc. (“Roche” or Petitioner”) under 35 U.S.C. § 314(a). As shown below, the invalidity disputes raised in the Petition are more efficiently resolved in the ongoing, related litigation. Accordingly, discretionary denial is appropriate.

II. Status of the Related Litigation

As indicated in the mandatory notices, the ’981 patent is currently the subject of pending litigation involving Petitioner: *Roche Diabetes Care, Inc. v. Trividia Health, Inc.*, Case No. 1:24-cv-00668-GBW (D. Del). (“the Litigation”). Except for the present *inter partes* review proceeding, Patent Owner is currently unaware of any other pending matters involving the ’981 patent.

The Litigation began in June 2024 when Roche (Petitioner) sued Trividia (Patent Owner) for patent infringement relating to two of Roche’s patents. (Ex. 1004 at 1.) Trividia responded to Roche’s complaint with a counterclaim for patent

infringement of the '981 patent.¹ (*Id.* at 32.) Accordingly, there are three patents at issue in the Litigation, all of which relate to biosensor test strips. While the '981 patent is the subject of an *inter partes* review (the instant proceeding), neither of Roche's patents are the subject of *inter partes* review proceedings or *ex parte* reexaminations.

The Litigation has never been stayed and is proceeding as expected to a scheduled trial date of September 28, 2026. (Ex. 2001 at 28.) Indeed, Patent Owner offered a global stay of the litigation, but Petitioner refused and instead sought only a stay of Trividia's counterclaims. (Ex. 1076 at 21 ("also pending before the Court is Roche's Stay Motion requesting either (1) 'a stay of discovery with respect to Trividia's counterclaims, pending the resolution of Roche's Motion to Dismiss Counterclaims...' or, in the alternative, (2) 'to bifurcate and stay discovery on the counterclaims.'"); 22 ("if Roche was so concerned with the purported burden or impropriety of proceeding with discovery on Trividia's counterclaims, Roche could have stipulated to Trividia's proposed global stay of discovery as to both of the parties' claims.")). Recognizing the gamesmanship of such a ploy, the Court denied Petitioner's request for a stay of the Litigation. (*Id.* at 23 ("At bottom, the Court will

¹ Trividia also counterclaimed for patent infringement of another patent, but Trividia's other patent was ultimately removed from the Litigation.

not stay discovery as to Trividia's counterclaims, while allowing discovery as to Roche's claims to continue, risking the unnecessary duplication of effort by the parties and also the unnecessary expenditure of the Courts' limited resources, especially where Roche has declined a global stay.".) Further, while the Court has indicated it would entertain a global stay of the Litigation (*id.*), the parties have not agreed to such a global stay, and Patent Owner does not plan on agreeing to a global stay of the Litigation.

The parties have also expended significant resources in the Litigation. Initial infringement contentions were exchanged November 22, 2024. (Ex. 1076 at 22; Ex. 2002 at 3.) Further, a Markman hearing was held on April 30, 2025. (Ex. 1004 at 25; Ex. 2002 at 8.) At the Markman hearing, the Court requested briefing on an issue unrelated to the '981 patent (Ex. 2003 at 75:1-76:5), which additional briefing was completed on May 28, 2025. At the Markman hearing, the Court also indicated an intent to issue its Markman Order within 60 days of the completion of the briefing (Ex. 2003 at 111:21-112:6), and the Markman Order was issued on June 6, 2025. (Ex. 2002 at 15.)

The Litigation is also the subject of additional significant work. For instance, the parties recently stipulated to a slightly modified case schedule in which final infringement and final invalidity contentions will be exchanged July 25, 2025 and August 15, 2025, respectively, with fact discovery concluding August 29, 2025.

(See Ex. 2004.) Expert reports and summary judgment motions are scheduled to occur from September 2025 through January 2026. (Ex. 2001 at 26-27.) Patent Owner has not proposed any changes to the scheduled trial date of September 28, 2026, and Patent Owner expects trial to begin on that date.

III. The *Fintiv* Factors Favor Discretionary Denial Under § 314(a)

The Board's decision in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv*"), identifies a non-exclusive list of factors the Board considers when addressing whether a related, parallel district court action provides a basis for discretionary denial under 35 U.S.C. § 314(a). *Fintiv*, Paper 11 at 5–16. For the reasons provided below, a wholistic view of these factors strongly counsels in favor of discretionary denial.

A. Factor 1: Whether the court granted a stay or evidence exists that one may be granted if the proceeding is instituted.

This factor weighs in favor of discretionary denial. As explained above, Petitioner already requested a stay of the Litigation, which was denied. (Ex. 1076 at 2 ("For the reasons described below, the Court denies Roche's Stay Motion."); *see also id.* at 21-22.) Further, it is unlikely that the Court will grant a stay even if this IPR is instituted given the Litigation involves additional patents owned by Roche. Indeed, as the Court noted:

Given that each party is asserting patent infringement claims against the other party (with respect to patents directed to similar

technology), a stay of one of the parties' claims (or bifurcation) may, as Trividia observes, 'result in duplicate efforts for the litigating[] parties' and the Court.

(Ex. 1076 at 22.) As explained previously, unless the parties agree to a global stay of the litigation, the Court has indicated the Litigation will not be stayed. (Ex. 1076 at 23.) Patent Owner has no plans to agree to a global stay of the Litigation. Accordingly, this factor weighs in favor of discretionary denial. *Fintiv* at 7-8.

B. Factor 2: Proximity of the court's trial date to the Board's projected statutory deadline for a final written decision.

This factor weighs in favor of discretionary denial. In the Litigation, the Court has set a trial date of September 28, 2026. (Ex. 2001 at 28.) The IPR institution decision is due October 16, 2025, meaning the Board's final written decision must issue no later than October 16, 2026 to comply with its statutory obligations. Thus, if the present IPR were instituted, the Board's final written decision would occur after the Litigation's scheduled trial date. Accordingly, this factor weighs in favor of discretionary denial. *Fintiv* at 9.

C. Factor 3: Investment in the parallel proceedings by the court and the parties.

This factor weighs against discretionary denial. As the Court noted:

[The parties] have already devoted substantial time and resources to negotiating scheduling and protective orders, serving and responding to discovery requests, producing documents, briefing Roche's MTD

and now its MTS, and serving initial disclosures, Initial Invalidity Contentions and Initial Infringement Contentions.

(Ex. 1076 at 22-23.) Further, as explained above, a Markman hearing occurred on April 30, 2025, and the Markman Order issued on June 6, 2025. Thus, the claims of the '981 patent have already been construed by the district court.

Additional substantial work will also be completed by the parties before the institution decision. As explained above, under the parties' revised case schedule that has been entered by the district court, the parties are still scheduled to exchange final infringement and final invalidity contentions and complete fact discovery before the institution deadline. (*See* Ex. 2004).

Further, if an IPR were instituted, the parties would also be forced to complete simultaneous substantial work in both the IPR and the Litigation. For instance, under the Litigation schedule, opening expert reports, rebuttal expert reports, expert discovery, and summary judgement briefing would be completed during the period from September 2025 through March 2026. (Ex. 2001 at 26-27.) Such work in the Litigation would overlap with the majority of an anticipated IPR trial schedule. The below table provides a comparison of a likely IPR schedule to the current litigation schedule.

Litigation Item	Current Litigation Due Date	Likely IPR Schedule Overlap
Opening Expert Reports	September 30, 2025	Patent Owner's cross-examination of Petitioner's

Litigation Item	Current Litigation Due Date	Likely IPR Schedule Overlap
Rebuttal Expert Reports	October 31, 2025	expert and Patent Owner Response (e.g., due Jan. 8, 2026)
Reply Expert Reports	November 21, 2025	
Expert Discovery Cut-Off	January 9, 2026	Petitioner's cross-examination of Patent Owner's expert and Petitioner Reply (e.g., due April 2, 2026)
Earliest date to file summary judgment without leave	January 20, 2026	
Summary judgment and <i>Daubert</i> motions – Opening briefs	January 30, 2026	
Summary judgment and <i>Daubert</i> motions – Answering briefs	February 27, 2026	Patent Owner's cross-examination of Petitioner's expert and Patent Owner Sur-Reply (e.g., due May 14, 2026)
Summary judgment and <i>Daubert</i> motions – Reply briefs	March 27, 2026	

As shown, if this IPR is instituted, the bulk of the IPR work would occur during periods in which substantial efforts will also be on-going in the Litigation. Thus, instituting the IPR would place an unnecessary burden on both parties.

Finally, Patent Owner filed its counterclaim asserting the '981 patent against Petitioner on July 26, 2024, and provided its initial infringement contentions on November 22, 2024. Yet, Petitioner waited until March 6, 2025 to file its Petition. This delay also weighs in favor of discretionary denial. *Fintiv* at 11-12.

In sum, the parties have expended, and will continue to expend, substantial resources in the Litigation, and Petitioner failed to timely file its Petition after

receiving Patent Owner's counterclaim and infringement contentions. Accordingly, this factor weighs in favor of discretionary denial. *Fintiv* at 9-12.

D. Factor 4: Overlap between issues raised in the petition and the parallel proceeding.

This factor weighs in favor of discretionary denial. Patent Owner acknowledges that Petitioner has stipulated that, “[i]f the Board institutes IPR,” it will “not to pursue, in [the Litigation], the same grounds presented here or any grounds that could have reasonably been raised with respect to the claims challenged in this IPR.” (Petition at 3, citing *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (P.T.A.B. Dec. 1, 2020).) However, Petitioner has failed to stipulate that it will not rely on any system prior art in the Litigation. As noted in the USPTO's recent “*FAQs for Interim Processes for PTAB Workload Management*:"

14. When should a petitioner file a Sotera or Sand stipulation if they wish to do so? What happens if a petitioner files a Sotera or Sand stipulation after the Director issues a decision on discretionary considerations?

A petitioner should file a Sotera or Sand stipulation as soon as practicable, so that a patent owner may address the impact of the stipulation in its discretionary denial brief. The Director will take into account whether the stipulation materially reduces overlap between the proceedings. Where the petitioner is relying on corresponding system art in a co-pending proceeding and/or several

other invalidity theories, a stipulation may not be particularly meaningful because the efficiency gained by any AIA proceeding will be limited.

(See <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management> (emphasis in underlining and italics added).) Accordingly, this factor weighs in favor of discretionary denial.

E. Factor 5: Whether the petitioner and the defendant in the parallel proceedings are the same party.

The parties to this IPR and the Litigation are the same. Accordingly, this factor weighs in favor of discretionary denial. *Fintiv* at 13-14.

F. Factor 6: Other circumstances that impact the Board's discretion, including the merits.

Finally, Patent Owner notes that Factor 6 is in its favor as (a) Petitioner's invalidity case is weak, and (b) the '981 patent issued more than 13 year ago, i.e., Petitioner's IPR challenge is delinquent.

1. Petitioner's Invalidity Case Is Weak

This Petition presents a weak case of invalidity. The Petition offers no anticipation grounds and relies on at least three references for all three of its obviousness grounds. (Petition at 8.)

Further, Petitioner's Ground 1 combination seeks to overhaul Bhullar by (a) using multiple different lasers (a Nd:YAG laser per Boogaard; a CO2 laser per

Angell), when no such teaching exists in Bhullar, and (b) implementing an entirely new positioning system in Bhullar based on Boogaard:

The Bhullar-Boogaard-Angell combination would have implemented Bhullar's manufacturing method with (1) Boogaard's teaching to use an Nd:YAG laser to form kerfs requiring ablation of just the conductive layer of Bhullar's metallized substrate, (2) Boogaard's teaching to use a positioning system to implement movement relative to the test sensor, and (3) Angell's teaching to use a CO2 laser to form kerfs requiring ablation of both the conductive layer and a portion of the insulating base layer of Bhullar's metallized substrate.

(Petition at 26-27.) A POSITA would not have been motivated to completely redesign Bhullar to include an entirely new laser positioning system with multiple laser. Indeed, Bhullar refers the POSITA to an already existing, conventional laser system:

To manufacture biosensor 10 a roll of metallized electrode support material is fed through guide rolls into an ablation/washing and drying station. *A laser system capable of ablating support 12 is known to those of ordinary skill in the art. Non-limiting examples of which include excimer lasers, with the pattern of ablation controlled by mirrors, lenses, and masks. A non-limiting example of such a custom fit system is the LPX-300 or LPX-200 both commercially available from LPKF Laser Electronic GmbH, of Garbsen, Germany.*

(Ex. 1001 at 0043 (emphasis added).) Bhullar does not contemplate or suggest a complete redesign of its system by using an entirely new, multiple laser system, as Petitioner proposes. Accordingly, Petitioner's motivation to combine arguments are substantially flawed. *See* MPEP § 2143.01(IV), citing *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA 1959) (there is no motivation to combine when the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate").

Petitioner's motivation to combine is also lacking in other respects. For instance, it is not enough that "Angell's CO2 laser could be moved with a positioning system and used with scanning techniques to form the larger recess." (Petition at 25 (emphasis added).) Instead, the evidence must support what a POSITA would have been motivated to do. *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 993-94 (Fed. Cir. 2017) ("But that reasoning seems to say no more than that a skilled artisan, once presented with the two references, would have understood that they *could be* combined. And that is not enough: it does not imply a motivation to pick out those two references and combine them to arrive at the claimed invention." (emphasis in original).)

Petitioner's reasonable expectation of success argument is also lacking. Petitioner alleges the references are in the same field of endeavor (Petition at 22, 26), but whether the art is analogous is simply the first step in an obviousness analysis. *Corephotonics, Ltd. v. Apple Inc.*, 84 F.4th 990, 1004 (Fed. Cir. 2023) ("Prior art references are applicable to the obviousness inquiry only when they are analogous to the claims being challenged.") Petitioner also argues a different reference, such as Winata, would lead to success, but fails to explain why a POSITA would expect success when overhauling Bhullar to include an entirely new laser positioning system. (Petition at 21-22, 26.)

Petitioner's Grounds 2-3 suffer from similar defects.² For instance, Petitioner falsely argues "Edelbrock's method uses different lasers to make 'a plurality of laser cuts' in the conductive layer to define electrically isolated conductive components, including electrodes." (Petition at 52, citing Ex. 1032 at 0039-41.) Not true. The portions of Edelbrock cited by Petitioner are reproduced below.

Before attachment to the lid-ribbon strip, the base-ribbon strip 110 of FIG. 3, however, has not fully defined the plurality of conductive leads in the conductive area 120. In other words, the conductive leads of the plurality of electrodes are partially defined. In one process, a

² Ground 3 is based on the Ground 2 references plus Bhullar for dependent claims 35-37. (Petition at 8.)

plurality of laser cuts 114a-c begins the process of defining the plurality of conductive leads in the conductive area 120. In this process, the plurality of electrodes has been partially defined but, as discussed above, are not shown in FIG. 3. The plurality of electrodes is not fully defined until the base-ribbon strip is attached to a second layer, which defines a reaction zone.

One process of defining the electrodes is by cutting the base-ribbon strip. For example, the plurality of electrodes may be defined by using a mask and a laser such as, for example, an Excimer laser or a carbon dioxide-based laser. One example of a mask is a chrome-on-glass mask in which the beam of light is only allowed to pass through selected areas.

According to another method, the plurality of electrodes on the base-ribbon strip 110 is partially formed with a laser using direct writing of the lines. As discussed above, the plurality of electrodes is not fully defined until the base-ribbon strip is attached to a second layer so as to define a reaction zone. In a method using a laser with direct writing of the lines, a laser beam of light is moved so as to partially define the plurality of electrodes. Lasers that produce a beam of energy capable of removing a layer and that can be moved to form a pattern may be used in this method. Non-limiting examples of such lasers are carbon dioxide-based lasers and yttrium-based lasers such as yttrium aluminum garnet (YAG) lasers.

(Ex. 1032 at 0039-41 (emphasis added).)

As shown, Edelman discloses using “a laser,” i.e., one laser, to complete its processing, which laser may be “an Excimer laser or a carbon dioxide-based laser.” Edelman does not teach or suggest a system employing multiple different laser types, as argued by Petitioner.

Petitioner's motivation to combine is also lacking. Again, that “Angell's CO2 laser... could be moved with a positioning system relative to an ablation target,” is irrelevant. (Petition at 63.) What matters is whether a POSITA would have been motivated to make the combination. *Personal Web*, 848 F.3d at 993-94.

Petitioner's reasonable expectation arguments are also lacking for Grounds 2-3. The entirety of Petitioner's reasonable expectation of success arguments for Ground 2 are below:

A POSITA would have had a reasonable expectation of success implementing Edelbrock's laser ablation step using Boogaard's laser milling techniques. Both Boogaard and Edelbrock use laser ablation on the same materials on a micron scale. In particular, Boogaard teaches use of the Nd:YAG laser to ablate gold (EX1035-Boogaard, 57), which is also the first example of a conductive layer mentioned by Edelbrock. EX1032-Edelbrock, [0035] (“The electrodes are formed of conductive materials such as, for example, metallic materials (e.g., gold,...)”).

(Petition at 60.)

A POSITA would have had a reasonable expectation of success adding Angell's CO2 laser as a second laser for implementing the Edelbrock-Boogaard method because Angell, Boogaard, and Edelbrock all use laser ablation on metals at a micron scale.

(Petition at 63.)

Simply because each prior art reference disclose the use of "laser ablation on metals at a micron scale" does not mean there would have been a reasonable expectation of successfully achieving the claimed invention. Petitioner never addresses how a POSITA would have reasonably expected to successfully implement multiple different lasers in Edelbrock's single laser system. Further, Petitioner's analogous art arguments (Petition at 61, 63-64) have no bearing on a reasonable expectation of success. *Corephotonics*, 84 F.4th at 1008.

In sum, all of Petitioner's grounds present a weak and unfounded obviousness challenge, confirming discretionary denial is appropriate.

2. Petitioner's Challenge Is Delinquent

As Director Stewart has recently indicated, "[e]arly challenges to patents favor robust, predictable patent rights and weigh against discretionary denial." *Tesla, Inc. v. Charge Fusion Tech., LLC* (IPR2025-00152), Paper 11 at 3 (June 12, 2025). The opposite situation exists here. The '981 patent issued March 6, 2012, i.e., more than thirteen years ago. Allowing such a late challenge to a patent does

not “favor robust, predictable patent rights,” i.e., a delinquent IPR challenge weighs in favor of discretionary denial. *Tesla, supra*.

IV. Conclusion

In sum, all *Fintiv* factors weigh against discretionary denial. Further, the '981 patent issued

Patent Owner, therefore, requests the PTAB exercise its authority to discretionarily deny this Petition under § 314(a).

Respectfully submitted,
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CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of this paper (*Patent Owner's Discretionary Denial Request*) together with all exhibits identified in the above Table of Exhibits, have been served on Petitioner at the below email addresses:

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CERTIFICATE OF WORD COUNT

Patent Owner hereby certifies that this paper (*Patent Owner's Discretionary Denial Request*) includes 3,359 words, as counted by the word-processing program (Microsoft Word for Office 365) used to generate this paper, excluding the words contained in the Table of Contents, Table of Authorities, List of Exhibits, this Certification and the Certificate of Service.

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