

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DEXCOM, INC.,
Petitioner,

v.

WAVEFORM TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2017-01051
Patent 7,529,574 B2

Before BENJAMIN D. M. WOOD, JON B. TORNQUIST, and
ELIZABETH M. ROESEL, *Administrative Patent Judges*.

ROESEL, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

In this *inter partes* review, Patent Owner filed a contingent motion to amend, proposing claims 20–29 as substitutes for claims 9–19 of U.S. Patent No. 7,529,574 B2. Paper 18. In our Final Written Decision, we granted Patent Owner’s motion to amend as to proposed claims 21, 24, and 25 and denied the motion as to proposed claims 20, 22, 23, and 26–29. Paper 48, 73. The time for filing an appeal from the Final Written Decision has expired with no appeal having been filed.

Following issuance of a final written decision in an *inter partes* review, the Director is required to issue a certificate that, among other things, “incorporat[es] in the patent by operation of the certificate any new or amended claim determined to be patentable.” 35 U.S.C. § 318(b). Although proposed claims 21, 24, and 25 have been determined to be patentable, each of them depends from proposed claim 20, which has been determined to be unpatentable. Paper 48, 66–67. To facilitate preparation of an *inter partes* review certificate, proposed claims 21, 24, and 25 must be rewritten in independent form.

In consideration of the foregoing, it is hereby:

ORDERED that, after conferring with Petitioner and no later than August 6, 2019, Patent Owner is authorized to file a paper that presents claims 21, 24, and 25 in independent form for publication in the *inter partes* review certificate. Each of these claims shall be written to include all limitations from proposed substitute independent claim 20. *See* Paper 18, 4–5 (Patent Owner’s motion to amend, including proposed substitute claims 20, 21, 24, and 25). Each of these claims shall be presented in the format provided in the Office Patent Trial Practice Guide, including a parenthetical after the claim number identifying which claim the substitute claim replaces.

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See 77 Fed. Reg. 48,756, 48,766–67 (Aug. 14, 2012). Patent Owner shall state whether or not Petitioner agrees with Patent Owner’s presentation of rewritten claims;

FURTHER ORDERED that, after conferring with Patent Owner and no later than August 13, 2019, Petitioner is authorized to file any comments or objections in response to Patent Owner’s presentation of rewritten claims.

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