

Filed: January 31, 2025

Filed on behalf of:

Patent Owner

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AXION BIOSYSTEMS, INC.,

Petitioner,

v.

AGILENT TECHNOLOGIES, INC.,

Patent Owner.

Case No. IPR2024-01467

Patent 11,906,508

**PATENT OWNER AGILENT TECHNOLOGIES, INC.'S
SUR-REPLY SUPPORTING ITS PRELIMINARY RESPONSE**

I. Axion's Reply Exceeds The Limited Scope Authorized By The Board To Address The § 325(d) Issue And Should be Expunged

Axion requested and received authorization from the Board “to file a reply limited to five (5) pages, addressing the § 325(d) issue raised in the POPR,” which analysis Agilent presented on pages 45-55 of the POPR. *See* POPR at 45-55. Rather than complying with the Board’s explicit and narrow authorization, however, Axion uses its Reply to improperly address the *merits* of Agilent’s POPR and revise Axion’s substantive arguments in the Petition. For example, Axion addresses Agilent’s POPR analysis concerning whether “the claims require ‘an impedance analyzer which *sequentially measures* the impedances of multiple wells *one at a time*,’” citing POPR at 3 (emphases in original). Reply at 1-2. Similarly, Axion argues: “PO states: ‘Axion incorrectly argues throughout its Petition’ that the claims are ‘directed to the time required to take *one measurement* of the electrical impedance of *one well*[,.]’” citing POPR at 2 (emphases in original). Reply at 3. As Axion’s citations readily demonstrate, Axion’s arguments are directed to the merits of Agilent’s POPR and are an improper attempted do-over of Axion’s arguments in the Petition. Accordingly, Axion’s Reply goes well beyond the scope authorized by the Board and should be expunged pursuant to 37 CFR § 42.7(a) (“The Board may expunge any paper . . . that is filed contrary to a Board order.”); *accord* Trial Practice Guide at II.I (“The Board is not required to attempt to sort proper from improper portions of the reply.”).

II. Axion’s Reply Fails To Explain Why The Petition Does Not Even Mention § 325(d) When The Primary Reference (Xu-752) Was Listed In The References Cited And Was The *Sole* Reference For Ground 1

The Petition completely overlooked the § 325(d) issue even though Axion admitted that its primary reference Xu-752 was listed in the IDS and the sole reference cited for Ground 1. Pet. at 2. Axion’s Reply fails to explain why Axion did not even mention § 325(d) in the Petition, and Axion has no excuse to attempt to correct its oversight belatedly. As explained above, Axion’s real objective is to revise its arguments on the merits in the guise of addressing the § 325(d) issue.

III. In The Context Of The Arguments Presented By Axion In The Petition, Jones Is Cumulative Of Oka And Yu

In the context of Axion’s arguments presented in the Petition, Jones is cumulative of Oka and Yu with respect to the “millisecond time resolution” and the “an impedance analyzer which measures multiple wells’ impedances at a time” (“Parallel Measurements”) limitations of the ’508 Patent (collectively the “Two Key Limitations”). In its Reply, Axion attempts to newly re-characterize Jones’ disclosures and its expert’s opinions, which revised arguments are unsupported by Jones’ actual disclosure and inconsistent with Axion’s assertions in the Petition.

Parallel Measurements. Axion argues that “[t]he Petition showed that Jones discloses an impedance measurement system with *parallel ADCs* for measuring the respective cell-substrate impedances of multiple wells *simultaneously*.” Reply at 1 (emphases in original). None of the Petition passages cited by Axion support that

new argument. Indeed, to the contrary, as explained in the POPR, Axion did not show that “Jones discloses an impedance analyzer which measures the impedances of multiple wells at the same time.” POPR at 32. For example, Axion argued that “Jones Figure 4 . . . shows eight daughter boards, arranged in parallel.” Pet. at 33. But Figure 4 of Jones merely shows eight daughter boards *physically* arranged in parallel, which is different from the claimed impedance analyzer performing a plurality of *electrical* impedance measurements at the same time. POPR at 23-24. Similarly, Axion cites to its *expert’s opinion*—not the disclosure of Jones itself—to make that new argument. Pet. at 41-42 (citing Ex. 1003 ¶¶ 117-121). But neither the Petition nor the expert declaration assert that Jones’ ADCs, which are arranged *physically* in parallel, result in an impedance analyzer which measures *electrical* impedance in parallel because there is no such disclosure in Jones. See POPR at 36-42. As explained in the POPR, Axion simply argued in the Petition that Jones discloses at least two ADCs on each daughter board and the daughter boards are arranged in parallel to one another. POPR at 51; Pet. at 33. Thus, Axion’s characterization of Jones in the Petition is substantially the same as Oka’s disclosure with respect to multiple ADCs, and hence cumulative. POPR at 51-52.

Millisecond Time Resolution. In its Reply, Axion incorrectly argues that “[t]he Petition cited these portions of Jones for its capability to measure the respective impedances of each and every well of a multiwell plate at a millisecond

time resolution.” Reply at 3. But to the contrary, Axion’s *expert* crafted his own arguments that (for example) “the measurement rate for a single-frequency sampling (rather than a stepped sweep) in Jones for the entire 96-well plate would be significantly less than 1.5 seconds, such that first and second measurements in *each well* are taken at a millisecond time resolution.” Pet. at 35-36 (emphasis added). He also speculated that “measurements of *a given well* are repeated every 136 milliseconds in this example, monitoring of the wells occurs at millisecond time resolution between first and second measurements of *each well*, as required by claim 1.” *Id.* at 54 (emphases added). But as the POPR explains, Jones itself nowhere discloses that limitation as defined in the ’508 Patent. POPR at 16-18.

Axion also argues that the Petition relied on ¶¶ [0003], [0025], [0030], [0038], [0042] of Jones for millisecond time resolution. Reply at 3. But as explained in the POPR, the Petition solely relied on ¶ [0030] of Jones, which is the only disclosure in Jones that discusses scanning time. In the Petition, Axion relied on ¶ [0030] of Jones’ disclosure of a 1.5 second update period for an entire 96-well plate (Pet. at 34), which is slower than the 0.2 second between two adjacent measurements disclosed in Oka. POPR at 52-53. Axion also argued that Jones discloses 68.2 ms/well time for a single well (Pet. at 34), which is again slower than the 50 ms/well time disclosed in Yu. POPR at 53. Thus, Jones is cumulative of Oka and Yu with respect to the “millisecond time resolution” limitation.

IV. The Petition Fails To Identify Any Material Errors By The PTO

In its Reply, Axion argues that “the Petition explained how PO traversed the lone Office Action . . . by arguing that Oka failed to teach numerous claimed limitations that Xu-752 describes.” Reply at 5. But the examiner later agreed with Agilent with respect to Oka and eventually allowed the claims. Axion thus appears to *agree* with Agilent that Oka does not teach certain claim limitations and thus the examiner did not err with respect to Oka. Axion also argues about Xu-752 (Reply at 5), but that portion of the Petition is directed to Ground 1, which is now moot.

Axion further argues that “[t]he Petition also described how the Office made a material error by ignoring that the Office had previously applied Xu-752 in an ancestor application” Reply at 5. But Xu-752 was considered by the examiner and—as Axion admits—does not teach the Two Key Limitations. Thus, Axion fails to explain any error by the examiner in not applying Xu-752 in an office action. Axion also argues that “the Office made a material error by failing to find Jones . . . that teaches key limitations of the ’508 patent claims.” Reply at 5. But as explained in the POPR and reiterated above, Jones is cumulative of other references considered by the examiner and fails to teach the Two Key Limitations. Thus, the absence of Jones during prosecution was not a material error.

Accordingly, Agilent respectfully requests that the Board expunge Axion’s Reply and deny the Petition for *Inter Partes* Review under, *inter alia*, § 325(d).

Respectfully submitted,

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Dated: January 31, 2025

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the **PATENT OWNER**
AGILENT TECHNOLOGIES, INC.’S SUR-REPLY SUPPORTING ITS
PRELIMINARY RESPONSE is being served on January 31, 2025, electronically
via P-TACTS and via electronic mail to the email addresses below:

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