

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AXION BIOSYSTEMS, INC.,
Petitioner

v.

AGILENT TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2024-01467

U.S. Patent No. 11,906,508

PETITIONER'S MOTION TO STRIKE

Petitioner Axion BioSystems, Inc. (“Axion”) moves to strike Exhibits 2024-2037 filed with the Sur-Reply of Patent Owner Agilent Technologies, Inc. (“Agilent”). Axion also moves to strike all discussion of Exhibits 2024-2037 and quotations therefrom in the Sur-Reply.

I. Background

On October 16, 2025, Agilent filed Exhibits 2024-2037 with its Sur-Reply to Axion’s Reply. Paper 21. Axion timely objected to these exhibits (Paper 22) and on October 21, 2025 requested that Agilent withdraw them. Agilent declined, which led Axion to request permission to file this Motion on October 22, 2025. On November 5, 2025, the Board authorized this Motion. Oral argument is scheduled for December 12, 2025. Paper 25 at 1.

II. The Board Should Strike Exhibits 2024-2037.

The Board should strike Exhibits 2024-2037 because Agilent’s submission of them violates 37 C.F.R. § 42.23(b) and the PTAB’s Trial Practice Guide. Rule 42.23(b) prohibits a patent owner from submitting new evidence with its sur-reply other than deposition transcripts of the cross-examination of any reply witness. 37 C.F.R. § 42.23(b) (“A sur-reply may only respond to arguments raised in the corresponding reply and may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness.”). The PTAB’s Trial Practice Guide likewise states that a “sur-reply may not be accompanied by

new evidence other than deposition transcripts of the cross-examination of any reply witness.” (<https://www.uspto.gov/patents/ptab/trial-practice-guide>.) The Board regularly strikes improper new evidence filed with sur-replies. *See, e.g., Clearone, Inc. v. Shure Acquisition Holdings, Inc.*, IPR2019-00683, Paper 66 at 3-5 (PTAB April 20, 2020) (striking patent file histories and non-patent literature filed with patent owner’s sur-reply because it constituted new evidence other than deposition transcripts of the cross-examination of any reply witness).

Here, Exhibits 2024-2037 are not deposition transcripts. These exhibits instead consist of non-patent literature (Exhibits 2024-2028, 2030, 2031, 2035-2037) and U.S. patents and patent publications (Exhibits 2029, 2032-2034). The Board should strike Exhibits 2024-2037 because Agilent was not permitted to file evidence of this nature with its Sur-Reply. The Board should further strike all discussion of Exhibits 2024-2037 and quotations therefrom in the Sur-Reply because such discussion and quotations effectively incorporate new evidence into the record in violation of Rule 42.23(b) and the Trial Practice Guide.

Agilent has argued that “the exhibits may appropriately be considered by the Board in this case because, *inter alia*, they simply provide basic technical background information in response to several new arguments in Axion’s reply brief.” *See* Axion’s October 22, 2025 email to the Board. But the Board routinely holds that new evidence cannot be submitted with a patent owner’s sur-reply, even

if a patent owner believes it is needed to rebut arguments made in a petitioner's reply. In *Satco Prods., Inc. v. Seoul Semiconductor Co., Ltd.*, for instance, the patent owner argued that new evidence submitted with its sur-reply was "proper rebuttal evidence" to alleged "new arguments raised in Petitioner's Reply." IPR2020-00836, Paper 45 at 75 (PTAB Oct. 22, 2021). The Board rejected this argument and granted petitioner's motion to strike eight new exhibits submitted with the sur-reply:

Patent Owner's argument that the exhibits constitute "proper rebuttal evidence" is not well-taken.... The exhibits were not of record prior to Patent Owner filing them with its Sur-reply. Thus, they were submitted with the Sur-reply as new evidence. Patent Owner does not contend, nor do we find, that the exhibits comprise deposition transcripts of the cross-examination of any reply witness. Thus, the exhibits were improperly submitted, without authorization and in violation of our Rules and Guidance.

Id. at 75-76. Here, likewise, the Board should strike Agilent's Exhibits 2024-2037 and the portions of the Sur-Reply referencing such exhibits because they were "improperly submitted, without authorization, and in violation of [the Board's] Rules and Guidance." *Id.*

Moreover, Exhibits 2024-2037 are not "in response to several new arguments in Axion's reply brief," as Agilent contends. Agilent identifies only one alleged new argument in the Reply, asserting that "Axion's use of [the previously-cited Ghosh prior-art reference, Ex. 1017] on reply is an impermissible attempt to salvage a

deficient obviousness case with a reference not relied upon by Axion in its Petition.” Sur-Reply at 21. Starting with Exhibits 2024-2035, none of this evidence relates to Ghosh, and hence these exhibits were not filed in response to any alleged new Reply argument based on Ghosh. *See id.* at 14 (citing Ex. 2024 as allegedly showing that “in a multiplexed system, longer settlement times would be necessary to achieve acceptable accuracy”), 17-18 (citing Exs. 2025-2035 as allegedly showing that the MDS Sciex CellKey System had an update rate of “2 or 10 seconds and a specified measurement frequency range of 1 kHz – 10 Mhz”).

The two other new exhibits (Exs. 2036 and 2037) do relate to Ghosh,¹ but these exhibits are not in response to a new argument first raised in the Reply. The Petition cited Ghosh to show that “at least as early as the 1990s, applications of impedance-based cell analysis systems using fast, millisecond-time resolution between measurements were known to POSAs, and further, even for such applications, POSAs were seeking faster sampling times to obtain data more frequently.” Pet. at 37-38; *see also id.* (“one known application of impedance-based cell analysis was studying cell pores formed via electroporation,” with

¹ The Sur-Reply cites Exhibits 2036 and 2037 as allegedly showing that dimensions of Ghosh’s plate are different from plates of Xu-752 (Ex. 1005) and Jones (Ex. 1006). Sur-Reply at 22-23.

“Ghosh describ[ing] the use of millisecond-time resolution between two measurements for a well to monitor impedance while studying electroporabilization”). The Reply cited Ghosh for the same reasons and thus did not raise a new argument:

There were applications of impedance-based cell analysis known to a POSA at the time of the '508 patent that required millisecond-time resolution between measurements (e.g., studying electroporabilization, where cell pores “start resealing within a few milliseconds,” EX1017 (Ghosh), 1604, 1609), and also specific cell behaviors that were known to a POSA to occur in milliseconds.

Reply at 10 (citing Pet. at 31-47 and Ex. 1003 (Kim Decl.) at ¶¶107-126).

Ghosh And Other Documentary Evidence Show Known Applications Of Impedance-Based Cell Analysis Requiring Millisecond Time Resolution.

Reply at 11.

Agilent does not contest, e.g., that Ghosh describes the use of impedance-based cell analysis for studying electroporabilization, where cell pores “start resealing within a few milliseconds.” EX1017, 1604, 1609; EX1003, ¶178.

Id.

Further, the Reply’s statement (at 12) recognizing that the '508 patent is, “at most, a minor variation on Ghosh” is not a “new ground of unpatentability” (Sur-Reply at 21), but rather a direct and appropriate response to arguments raised in the

Patent Owner Response. In his declaration in support of the Response, Agilent's expert Dr. Sanchez argued that "[a]lthough impedance-based cellular analysis had been known in 2008, the '508 Patent was the first to describe an impedance-based cellular analysis with 'millisecond time resolution.'" Ex. 2009 at ¶25 (cited in the Response at 8-9). Axion's Reply addressed this contention:

Fifteen years before the '508 patent's alleged priority date, Ghosh described "monitor[ing] the impedance of [a] sample" by "tak[ing] data once every 10 milliseconds" and noting the capability to "take readings as fast as once every 5 milliseconds." EX1017, 1604, 1609. Ghosh thus described impedance-based cellular analysis with millisecond time resolution measurements, contrary to Dr. Sanchez's unsubstantiated opinion. The '508 patent's alleged invention (measuring **two or more wells** at a millisecond time resolution) is, at most, a minor variation on Ghosh (measuring a **single sample** at a millisecond time resolution), and would have been obvious for all of the reasons stated in the Petition.

Reply at 12 (emphasis in original).

This reply argument is "proper" because it is "responsive and simply expands on previously raised arguments." *Rembrandt Diagnostics, LP v. Alere, Inc.*, 76 F.4th 1376, 1384 (Fed. Cir. 2023). It refutes Dr. Sanchez's contention that the '508 patent was "the first" to describe an impedance-based cellular analysis with millisecond time resolution. Ex. 2009 at ¶29. And it properly expands on the Petition's showing that "Ghosh describes the use of millisecond-time resolution between two

measurements for *a well* to monitor impedance while studying electropermeabilization” (Petition at 37), with the Reply comparing Ghosh’s measurement of a *single well* at millisecond time resolution with the ’508 patent’s measurement of *two or more wells* at millisecond time resolution. Reply at 12. Agilent had the opportunity to, and did, respond to this argument in its Sur-Reply (at 22-25). *See Skky, Inc. v. MindGeek, s.a.r.l.*, 859 F.3d 1014, 1022-23 (Fed. Cir. 2017) (reply did not contain new arguments because it “responded to the positions laid out by [patent owner],” and patent owner had the opportunity to, and did, respond).

III. Conclusion

Axion respectfully requests that the Board strike Exhibits 2024-2037 and all corresponding discussion and quotations in the Sur-Reply prior to the oral argument. Agilent’s violation of Rule 42.23(b) and the Trial Practice Guide is glaring, and unless the improper evidence is stricken prior to oral argument, Axion will be prejudiced by having to devote portions of its argument time to addressing this evidence, which Axion will not have had the opportunity to rebut.

Dated: November 14, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on November 14, 2025, a complete and entire copy of PETITIONER’S MOTION TO STRIKE has been served in its entirety by e-mail to:

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