

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CYTEK BIOSCIENCES, INC.,
Petitioner,

v.

BECKMAN COULTER, INC.,
Patent Owner.

U.S. Patent No. 11,703,443
Case No. IPR2025-01319

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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TABLE OF EXHIBITS

Exhibit	Description
EX2001	About Beckman Coulter (https://www.beckmancoulter.com/about-beckman-coulter/history-and-innovation)
EX2002	CytoFLEX Flow Cytometer (https://www.beckman.com/flow-cytometry/research-flow-cytometers/cytoflex)
EX2003	Beckman Coulter Patents (https://www.beckman.com/patents)
EX2004	Cytek Form S-1 Registration Statement (2021)
EX2005	Information Disclosure Statement for Application No. 15/817,237 to U.S. Patent No. 10,436,697 (May 7, 2019)
EX2006	Information Disclosure Statement for Application No. 15/942,430 to U.S. Patent No. 11,333,597 (June 17, 2021)
EX2007	Defendant Cytek Biosciences, Inc.'s Answer to the Complaint and Counterclaims, <i>Beckman Coulter, Inc. v. Cytek Biosciences, Inc.</i> , C.A. No. 24-945, D.I. 16 (D. Del. Oct. 7, 2024)
EX2008	Transcript of Scheduling Conference, <i>Beckman Coulter, Inc. v. Cytek Biosciences, Inc.</i> , C.A. No. 24-945, D.I. 23 (D. Del. Nov. 12, 2024)
EX2009	Defendant Cytek Biosciences, Inc.'s Revised Invalidity Contentions, <i>Beckman Coulter, Inc. v. Cytek Biosciences, Inc.</i> , C.A. No. 24-945 (D. Del. July 11, 2025)
EX2010	Defendant's Opening Brief in Support of Its Motion to Stay Pending <i>Inter Partes</i> Review and Post Grant Review of the Asserted Patent

IPR2025-01319
Patent No. 11,703,443
Patent Owner's Request for Discretionary Denial

Exhibit	Description
	Claims, <i>Beckman Coulter, Inc. v. Cytek Biosciences, Inc.</i> , C.A. No. 24-945, D.I. 107 (D. Del. July 22, 2025)
EX2011	Order, <i>Beckman Coulter, Inc. v. Cytek Biosciences, Inc.</i> , C.A. No. 24-945, D.I. 124 (D. Del. July 30, 2025)
EX2012	Transcript of <i>Markman</i> Hearing of August 21, 2025, <i>Beckman Coulter, Inc. v. Cytek Biosciences, Inc.</i> , C.A. No. 24-945, D.I. 151 (D. Del. Aug. 21, 2025)
EX2013	Transcript of <i>Markman</i> Hearing of September 17, 2025, <i>Beckman Coulter, Inc. v. Cytek Biosciences, Inc.</i> , C.A. No. 24-945, D.I. 173 (D. Del. Sept. 17, 2025)
EX2014	U.S. Patent Pub. No. 2004/0165828 (“Capewell”)
EX2015	File History for U.S. Patent No. 9,746,412
EX2016	File History for U.S. Patent No. 10,330,582
EX2017	DocketNavigator, Time-to-Trial Statistics for District of Delaware (Sept. 2025)
EX2018	EP2861956B1
EX2019	EP3206010B1
EX2020	EP2861956 Search Opinion (Mar. 18, 2016)
EX2021	Assignment for U.S. Patent No. 8,922,778

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Exhibit	Description
EX2022	Assignment for U.S. Patent No. 8,605,283
EX2023	BD LSRFortessa Cell Analyzer User's Guide
EX2024	Request for <i>Ex Parte</i> Reexamination of U.S. Patent No. 10,330,582 B2 Under 35 U.S.C. §§ 302-307 and 37 C.F.R. § 1.510 <i>et seq.</i>
EX2025	Petition for Post-Grant Review of US Patent No. 12,174,106, PGR2025-00084
EX2026	Petition for Post-Grant Review of US Patent No. 12,174,107, PGR2025-00088
EX2027	Amended Scheduling Order, <i>Beckman Coulter, Inc. v. Cytex Biosciences, Inc.</i> , C.A. No. 24-945, D.I. 178 (D. Del. Sept. 29, 2025)

I. Introduction

Patent Owner Beckman Coulter, Inc. (“Patent Owner” or “Beckman Coulter”) is a pioneer and innovator in flow cytometer technologies. In August 2024, Patent Owner commenced a patent infringement litigation in the District of Delaware against its direct competitor, Cytex Biosciences, Inc. (“Petitioner” or “Cytex”). In addition to asserting U.S. Patent No. 11,703,443 (the “’443 patent”), Beckman Coulter asserted three other patents in the same family having the same specification.

Petitioner waited almost a full year into the litigation—now at a very advanced stage—to file this IPR petition, which it failed to properly serve under 37 C.F.R. § 42.105(a) until two months after the statutory bar date passed, *see* Paper 6. Institution will not be a fruitful use of the USPTO’s time. In particular, the district court has already denied a request for a stay pending this IPR, has told the parties numerous times that the trial date should not move, and will resolve the ’443 patent’s validity at a jury trial in August 2026, over five months before the statutory deadline for the USPTO’s final written decision.

It would be a waste of USPTO resources to review the ’443 patent’s validity (or the validity of the other asserted patents) after the district court. Both of Petitioner’s references were already thoroughly considered by multiple examiners during prosecution. Further, Petitioner has taken no measures to ensure the USPTO

would be an efficient and streamlined forum to resolve validity. Petitioner has not offered any *Sotera*-like stipulation and, even if it did, Petitioner is relying on duplicative system prior art to contend in district court that the '443 patent is invalid.

Petitioner's approach ensures inefficiency and duplicative proceedings, including because Petitioner has not brought timely challenges against any of the other asserted patents. After waiting nearly the full year to file this IPR, Petitioner then filed an *ex parte* reexamination request for one other asserted patent and waited another eight weeks to file post-grant challenges for the other two asserted patents, just before the statutory deadline for post-grant reviews. Petitioner's delayed requests ask that different divisions of the USPTO review its related challenges on three different timelines using different standards for institution and different substantive review standards (*e.g.*, for the relevant claim construction standards).

All six factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) support denying institution, as do the additional considerations in the Board's March 26, 2025 guidance on "Interim Processes for PTAB Workload Management," including that no material error during prosecution warrants intervention, Patent Owner's expectations were settled, and the petition heavily relies on expert testimony. Discretionary denial is also warranted under 35 U.S.C. § 325(d). The petition should be discretionary denied.

II. Background

A. Patent Owner Is a Known Innovator and Petitioner Is a Competitor

Patent Owner has been a pioneer and innovator in flow cytometry and cell sorter technologies for over 40 years. EX2001. Flow cytometers analyze cells by channeling them through a beam of light and detecting the fluorescence of any dyes tagged to the cells. EX1001 at 1:49-55. Patent Owner's groundbreaking technology revolutionized the industry with the first compact, high-performance flow cytometers utilizing small area detectors. EX2002. Several of Patent Owner's key innovations are reflected in the '443 patent, and Patent Owner marks its CytoFLEX Flow Cytometers and Sorters with the '443 patent. EX2003.

Petitioner sells competing flow cytometer products. EX2004 at 118-124 (“Our direct competitors include ... Beckman Coulter (Danaher Corporation).”). Petitioner has known about patents in the same family as the '443 patent sharing the same inventor and specification since at least 2019. *See* EX2005 at 1; EX2006 at 2.

B. The '443 Patent Claims Key Innovations

The '443 patent was filed on November 4, 2022. The '443 patent claims the benefit of applications filed on or after May 2012. The '443 patent also has the same priority claims and specification as the three other patents asserted in the litigation: U.S. Patent No. 10,330,582 (the “'582 patent”); U.S. Patent No. 12,174,106 (the

“'106 patent”); and U.S. Patent No. 12,174,107 (the “'107 patent”).

The asserted patents sought to enhance the performance of flow cytometers while making them more compact and easier to use. The '443 patent describes innovative, compact wavelength division multiplexers (“WDMs”) that permit the use of powerful, millimeter-sized detectors never before used in flow cytometry, resulting in improved sample analysis and a smaller instrument footprint. EX1001 at 43:52-44:44. By measuring differences between individual cells using high-quality detectors, the inventions enabled breakthrough biological research and cutting-edge diagnostics. *Id.* at 1:49-2:3, 43:52-44:44.

Flow cytometer detection systems present different challenges from WDMs in other fields. For example, unlike WDMs in optical communications, flow cytometers must detect light with a wide range of wavelengths of unknown and uncontrolled signal strength. *See* EX1016 at 2:20-64; EX1007 at 67, 151. Furthermore, in flow cytometry, light enters a detection system from a large optical fiber which produces a much larger light beam than produced in optical communications. EX1001 at 44:47-67. This presents challenges in controlling the light beam over an extended distance and focusing the beam onto the detectors, as needed for effective detection. *Id.* at 44:24-44. The '443 patent recognized and overcame these challenges with its innovative designs for WDMs.

C. The '443 Patent Family Underwent Substantive Examination that Included the Only Two References Asserted in the Petition

The '443 patent issued on July 18, 2023 as a continuation in a family of patents that has undergone extensive and thorough prosecution including multiple prior-art based rejections by multiple examiners, including a Supervisory Patent Examiner.

During prosecution of a grandparent to the '443 patent, the Examiner rejected the claims as obvious over the published application for U.S. Patent No. 6,683,314 (“Oostman”) (EX1005), the reference asserted by Petitioner here, and U.S. Patent Pub. No. 2004/0165828 (“Capewell”) (EX2014), a reference from the optical communications field. EX2015 at 1070-1071. Initially, the Examiner combined Oostman’s flow cytometer with Capewell’s optical communications WDM, alleging that the references were “[i]n a similar field of endeavor.” *Id.* Applicant made no amendments in response, explaining that “the fluorescence detection instrument, as taught by *Oostman*, and the optical communication system, as taught by *Capewell*, are actually different kinds of optical systems with different sizes of light sources,” and therefore obviousness had not been established. *Id.* at 1107-1109. The Examiner “fully considered” Applicant’s arguments and found them “persuasive.” *Id.* at 1132.

During prosecution of the '582 patent, another patent in the '443 patent family asserted in the litigation, the Examiner also rejected the claims based on Oostman. EX2016 at 537-542. Applicant again overcame this rejection. *Id.* at 599.

Following the extensive prosecution in the earlier family members of the '443 patent and additional examination of the '443 patent, the Examiner and Supervisory Patent Examiner allowed the '443 patent claims after an examiner amendment limiting the claims to be “for a flow cytometer.” EX1003 at 241-43. The Examiner signed and verified that they considered both Oostman and Petitioner's only other reference asserted here, U.S. Patent No. 6,542,306 (“Goodman”) (EX1016):

Art	6,542,306	12/12/2003	Classifications
A72	6,542,306	4/1/2003	Goodman
A73	6,572,255	6/3/2003	Husher
A74	6,805,882	8/19/2003	Orlyn et al.
A75	6,818,143	9/9/2003	Roche et al.
A76	6,838,481	10/28/2003	Sklar et al.
A77	6,847,175	11/11/2003	LoRegio et al.
A78	6,883,314	1/27/2004	Oostman Jr. et al.
A79	6,713,019	3/30/2004	Ozasa et al.
A80	6,748,133	6/8/2004	Liu et al.
A81	6,767,188	7/27/2004	Vrane et al.
A82	6,768,593	7/27/2004	Jutamulla
A83	6,788,409	9/7/2004	Goodwin
A84	6,794,671	9/21/2004	Nicoll et al.

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EXAMINER: /MEENAKSHI S SAHU/	DATE CONSIDERED: 03/07/2023
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EXAMINER: INITIAL IS REFERENCE CONSIDERED, WHETHER OR NOT CITATION IS IN CONFORMANCE WITH MPEP 609; DRAW LINE THROUGH CITATION IF NOT IN CONFORMANCE AND NOT CONSIDERED. INCLUDES COPY OF THIS FORM WITH NEXT COMMUNICATION TO APPLICANT.

INFORMATION DISCLOSURE STATEMENT — PTO-1449 (MODIFIED)

EX1003 at 225 (annotated).

D. The Parallel District Court Litigation Is at an Advanced Stage

On August 15, 2024, Patent Owner brought suit in the U.S. District Court for the District of Delaware to enforce its patent rights against Petitioner. In the district court, a jury trial is scheduled for August 17, 2026, more than five months before the January 2027 projected final written decision deadline. EX2027 at 2.

The district court judge, Judge Connolly, has several times rejected efforts by Petitioner to adjourn the trial to later than August 2026. In initially scheduling the trial, Petitioner sought an October 2026 trial date, but Judge Connolly explained: “I like the idea that when cases are filed here, they are tried within two years. That’s kind of optimal. This case was filed in August [of 2024]. So I’m going to give you a trial date of August 17th [2026].” EX2008 at 16:2-6.

Judge Connolly already denied a stay pending this IPR, finding that the “trial date has been set for August 17, 2026,” and that “a stay would cause delay that is unfair to Beckman Coulter, which competes directly with Cytek.” EX2011 at 2-3. Judge Connolly also found that “[t]he timing of Cytek’s IPR counsels against a stay” given that, after infringement contentions were filed, Cytek “waited another five months to file its IPR petition—less than one month before the IPR bar date.” *Id.* at 2. He noted the significant investment in the case, and that the court “has heard and resolved multiple discovery disputes.” *Id.* at 2-3. He further stated that “any institution decisions will not come until early 2026, and by that time expert discovery will have closed and trial will be only months away.” *Id.* at 3.

Judge Connolly has since rejected additional efforts by Petitioner to push back the trial date. The parties participated in two *Markman* hearings, during which Petitioner suggested postponing the case schedule. *See* EX2012 at 180:6-13. In

response, Judge Connolly repeated that the trial date “should not have to move.” *Id.* at 180:14-15. He has also noted that the court has “incurred an awful lot of judicial time to date” and that the parties need to keep moving the case forward. EX2013 at 204:4-9. Thus, trial is likely to be in August 2026. And even the median time-to-trial statistics for the District of Delaware suggest trial would begin by December 2026 (EX2017), which is also before the final written decision due date in this IPR.

As of the date of this filing, Petitioner has not offered a *Sotera* stipulation or any other stipulation agreeing to not pursue invalidity arguments in the district court that could have been raised in this IPR. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18 (PTAB Dec. 1, 2020).

As explained above (pp. 3-4), Patent Owner asserts the '443 patent and the related '582, '106, and '107 patents. Petitioner filed a request to reexamine the '582 patent on August 7, 2025 (EX2024), which is pending a reexam order decision; a post-grant review of the '106 patent on September 15, 2025 (EX2025); and a post-grant review of the '107 patent on September 23, 2025 (EX2026).

III. The Petition Should Be Discretionarily Denied

There are two separate and independent bases for discretionary denial. ***First***, discretionary denial is warranted under 35 U.S.C. § 314(a) because the validity of the patent is already at issue in district court litigation, which is at an advanced stage.

Denying institution would avoid inconsistent outcomes and would preserve the Board's time and resources. Additional factors also favor denial, such as the weak merits, settled expectations given Petitioner's longstanding knowledge of Patent Owner and the '443 patent family, and the petition's heavy reliance on Petitioner's expert. ***Second***, denial is warranted under 35 U.S.C. § 325(d) because multiple examiners during prosecution extensively considered the prior art and arguments in the petition's only ground and already found the claims non-obvious over that art.

A. Discretionary Denial Is Warranted Under 35 U.S.C. § 314(a)

All six factors set forth in *Fintiv* support denying institution.

1. *Fintiv* Factor 1 favors denial: a stay is improbable

The district court has ***already denied*** a motion by Petitioner to stay the litigation pending this IPR. EX2011. Noting that “[t]he motion was easy to decide,” the district court explained that, among other things, “[t]he timing of Cytek’s IPR petition also counsels against a stay,” given the advanced stages of litigation. *Id.* at 1-3. The district court also reasoned that “a stay would cause delay that is unfair to Beckman Coulter, which competes directly with Cytek.” *Id.* at 3.

The district court’s reasons for denying a stay—the advanced stages of the litigation and prejudice because of direct competition—would apply regardless of whether this IPR were instituted. In fact, the rationale for denying a stay would be

further supported at an *even later* stage of the litigation (when any renewed stay motion might be brought). As noted by the court, “any institution decisions will not come until early 2026, and by that time expert discovery will have closed and trial will be only months away.” EX2011 at 3. Additionally, the district court scheduled the case to be “tried within two years” of August 2024 (EX2008 at 16:2-6), and stated at *Markman* that the trial date “should not have to move” (EX2012 at 180:6-15).

The district court is unlikely to grant another request for a stay, which weighs in favor of denial. *See Samsung Elecs. Co. v. California Inst. of Tech.*, IPR2023-00133, Paper 10 at 14 (PTAB May 4, 2023) (finding this factor favored discretionary denial because “[t]he district court has already denied a motion for a stay, and the reasoning in its decision on the motion indicates that the court is unlikely to grant a renewed motion”); *10x Genomics, Inc. v. President & Fellows of Harvard Coll.*, IPR2023-01299, Paper 15 at 16 (PTAB Mar. 7, 2024) (finding this factor favored discretionary denial where there was a “prior denial of a motion to stay”).

2. *Fintiv* Factor 2 favors denial: the trial is significantly earlier than a final written decision

By the time of the projected statutory deadline for the final written decision (January 2027), it will have been *over five months* since the conclusion of the trial (August 2026). As discussed above (pp. 7-8), Judge Connolly has indicated he is unlikely to delay the litigation, and even the median time-to-trial statistics in the

District of Delaware suggest trial would begin by December 2026. *See* EX2017.

The significantly earlier trial date strongly favors discretionary denial. *See Ericsson Inc. v. Procomm Int'l PTE. Ltd.*, IPR2024-01455, Paper 15 at 2 (PTAB May 16, 2025) (trial set to conclude half a year earlier is “substantially before” the final written decision). Discretionary denial is especially appropriate here where Petitioner has offered no stipulation of any kind, much less a *Sotera* stipulation, that would prevent duplication of effort and inconsistent decisions. *See Phison Elecs. Corp. v. Vervain, LLC*, IPR2025-00213, Paper 14 at 3 (PTAB July 10, 2025) (discretionary denial appropriate where “Petitioner has not offered a stipulation to address concerns of duplicative efforts and potentially conflicting decisions in view of a significantly earlier trial date in a co-pending case that is unlikely to be stayed”). No efficiency is gained by having the USPTO review the '443 patent after the district court is poised to address multiple validity issues at trial.

Additionally, the existing and upcoming district court proceedings—even apart from the upcoming trial—further suggest that no efficiencies will be gained by the USPTO's review. For example, in addition to an earlier trial where invalidity issues will be determined, Petitioner apparently intends to raise various invalidity issues, including potentially indefiniteness, at summary judgment. EX2013 at 197:19-22. The district court has also issued several claim construction rulings

relating to the '443 patent claims, and the petition provides no invalidity analysis for claims 16-18 of the '443 patent that would apply the district court's means-plus-function construction of "optical element." *Compare* EX2013 at 180 *with* Pet. at 65-70. Discretionary denial is especially warranted here to avoid inconsistent results.

3. *Fintiv* Factor 3 favors denial: Petitioner delayed filing the IPR and there is substantial investment in the litigation

Despite Patent Owner bringing suit in August 2024, Petitioner filed this IPR on July 17, 2025, waiting right up until the statutory deadline, which it did not serve under 37 C.F.R. § 42.105(a) until two months after the statutory bar date passed, *see* Paper 6. Petitioner's unexplained delay in filing this IPR favors discretionary denial. *See Ericsson Inc. and Cellco Partnership d/b/a Verizon Wireless v. Procomm International PTE. Ltd.*, IPR2024-01455, Paper 15, at 2-3 (PTAB May 16, 2025) (granting discretionary denial, highlighting Petitioner's failure to sufficiently "explain why it waited nearly a year to file the Petition").

Further, due to the Petitioner's delay, the district court litigation has proceeded to a very advanced stage (*see supra* p. 7), which also favors denial. *See Nokia of Am. Corp., et al. v. Pegasus Wireless Innovation LLC*, IPR2025-00036, 2025 WL 1203702, at *6 (PTAB Apr. 25, 2025) (factor 3 favored denial where *Markman* hearing was held and the parties exchanged invalidity contentions); *Arthrex, Inc., v. Medshape, Inc.*, IPR2025-00053, 2025 WL 1203664, at *5 (PTAB Apr. 25, 2025)

(factor 3 favored denial even where fact discovery was ongoing because the parties had exchanged contentions and held a *Markman* hearing before the institution decision). The parties have already exchanged contentions, substantially completed fact discovery, completed *Markman*, and the district court has issued *Markman* rulings. Here, by the time an institution decision is due, fact and expert discovery will have closed, and trial will be only a few months away. *See* EX2027 at 2.

4. *Fintiv* Factor 4 favors denial: the issues significantly overlap

The significant overlap between issues raised in the petition and in the district court favors denial. The claims challenged in the petition cover all claims of the '443 patent that are asserted in the district court.¹ Further, the references relied on in Petitioner's sole ground are the same or substantially the same as the art and arguments found in the invalidity contentions in the litigation. Petitioner relies on Oostman for every challenged claim in this IPR; its invalidity contentions rely on Oostman's patent publication (U.S. Patent Pub. Appl. No. 2003/0048539). *See* EX2009 at 123 (Reference A-9); *id.* at 47-48.² Petitioner also relies on the LSR

¹ For dependent claims 17-18 which are no longer at issue in the litigation, the petition refers back to its reasoning for at-issue claims. Pet. at 67-70.

² References to "Oostman-537" appear to refer to the Oostman publication.

Fortessa and LSR II products (*see id.* at 123 (References A-15 and A-16)), which are marked with Oostman (*see* EX2023 at 2). Additionally, Petitioner relies on “WDM References” (*see* EX2009 at 42-48), that are duplicative of Goodman. Petitioner has not filed *any* stipulation that would minimize concerns about duplicative efforts and inconsistent results. The significant overlap weighs in favor of denial.

5. *Fintiv* Favor 5 favors denial: the parties are the same

The parties here are the same as in the litigation, which favors denial.

6. *Fintiv* Factor 6 favors denial: petition's only ground is weak

The merits of the petition, which are weak at best, are insufficient to overcome the factors strongly favoring discretionary denial. The petition proposes combining two references from different fields of endeavor: optical communications (Goodman) and flow cytometry (Oostman). WDMs from optical communications could not simply be used in flow cytometry. WDMs in optical communications were constructed to handle light of defined wavelengths with minimal spacing (~1-5nm), high intensity, and low etendue (how spread out the light is); flow cytometry was used to detect light emitted from fluorescent dyes with a broad range of wavelengths (between violet, blue, green, red at >50nm), low intensity, and high etendue. *See* EX1001 at 44:54-67, 49:10-15; EX1016 at 2:21-64. The petition ignores these differences and simply combines optical communications prior art with flow

cytometry prior art. *See Broadcom Corp. v. International Trade Comm.*, 28 F.4th 240, 251 (Fed. Cir. 2022) (skilled artisan would not have been motivated to combine prior art from different fields of endeavor with different purposes). The petition fails to explain why there would have been a reasonable expectation of success in view of the challenges of adopting WDMs from the optical industry in flow cytometers.

The petition also impermissibly relies on the '443 patent to support its alleged motivation. Pet. at 27 (“[T]he '443 specifically identifies WDMs in the optical communication industry as analogous to WDMs in flow cytometry.”). Not only does this misrepresent the specification, which actually highlights the **challenges** in translating WDMs from optical communications to flow cytometry (EX1001 at 44:54-45:3), but also disregards that “the question is whether there is something **in the prior art** as a whole to suggest the desirability, and thus the obviousness, of making the combination.” *In re Beattie*, 974 F.2d 1309, 1311-1212 (Fed. Cir. 1992) (emphasis added).

The petition further argues that a skilled artisan would use the zig-zag configuration from Goodman (Pet. at 29), when Oostman already discloses a zig-zag configuration and states that using “a **star-shaped** pattern yield[s] a more compact polygonal arrangement of detectors” than a zig-zag pattern. Oostman (EX1005) at 7:32-36 (emphasis added). The petition makes the fatal error of failing

to provide any reason why a skilled artisan would add features from one prior art system to another that were already contemplated by that art but not preferred. *See Virtek Vision Int'l ULC v. Assembly Guidance Sys., Inc.*, 97 F.4th 882, 887 (Fed. Cir. 2024) (“The mere fact that these possible arrangements existed in the prior art does not provide a reason that a skilled artisan would ... make this substitution....”).

The weak merits favor discretionary denial.

B. Other Considerations Also Favor Discretionary Denial

Discretionary denial is also appropriate under the Board's recent guidance.

1. No material error warrants USPTO intervention

Here, there are no countervailing considerations, such as material error, that warrant the Board referring this petition to the merits panel. *See TankLogix, LLC v. SitePro, Inc.*, IPR2025-00761, Paper 10 at 2-3 (PTAB. Sept. 3, 2025) (discretionary denial favored where petitioner's assertions were “insufficient to demonstrate material error by the Office”). Prosecution of the '443 patent was very thorough and there was no material error that would warrant the USPTO's intervention and weigh against the district court's advanced stages of litigation.

Though Petitioner suggests that it does not use cumulative art because the Examiner “only cited U.S. Patent No. 11,333,597 to Yan” (Pet. at 5), this ignores that multiple Examiners and a Supervisory Patent Examiner extensively examined

multiple parent applications and specifically discussed Oostman as a primary reference in rejections. EX2015 at 1070-1071, 1132; EX2016 at 537-542; *see* MPEP § 609.02 (“The examiner of the continuing application will consider information which has been considered by the Office in the parent application.”). It also disregards that an Examiner combined Oostman with Capewell, a reference from the optical communications industry cumulative of Goodman. EX2015 at 1070-1071. Moreover, it ignores that the Examiner signed and ***verified*** that they considered both Goodman and Oostman during the '443 patent's prosecution. EX1003 at 225.

The petition's discussion of the prosecution of a foreign counterpart, European Patent No. EP24151670 (Pet. at 29-30) is not instructive here. Federal Circuit precedent is clear that European patent prosecution is not relevant to USPTO examination. *AIA Eng'g v. Magotteaux Int'l*, 657 F.3d 1264, 1279 (Fed. Cir. 2011) (declining to consider foreign applications because “theories and laws of patentability vary from country to country, as do examination practices”).

In any event, the European proceedings support discretionary denial. To be clear, European prosecution has not concluded. Original EP claim 1 did not recite “for flow cytometry”—the ***very same*** limitation the Examiner added when allowing the U.S. claims. *See* EX1028 at 56; EX1003 at 241-43. The European Patent Office issued only a preliminary search report rejecting claim 1 and providing a single

sentence objecting to the dependent claims that a “skilled person would implement the WDM device” in flow cytometry art. EX1028 at 41. Since then, Applicant amended claim 1 to recite a “flow cytometer,” and explained in detail why a skilled artisan would not have implemented WDMs in flow cytometry. EX1028 at 16-30. The European Patent Office has not yet addressed this response, but is obligated to consider it. *See* EPO Guidelines for Examination, C-II, 3.1 (“The applicant’s response to the search opinion ... will be taken into account by the examining division.”). Indeed, two other European patent applications in the same family that recited “flow cytometer” limitations were allowed. EX2018 at 20 (requiring a “flow cytometer”); EX2019 at 20 (same). In one of those granted patents, the European Patent Office also considered Oostman. EX2020 at 2.

Thus, there was no material error in the carefully considered prosecution of the ’443 patent, and the Board should exercise its discretion to deny institution.

2. Expectations are settled or at least neutral

Petitioner knew of the patent family containing the ’443 patent for at least *six years* before filing this IPR. *See* EX2005 (citing the ’443 patent’s grandparent publication in May 2019). Petitioner has also acknowledged Beckman Coulter is a direct competitor since 2021. EX2004 at 122-124. And Petitioner acknowledges that Patent Owner has marked its CytoFLEX Flow Cytometers and Sorters with the

related '582 Patent since at least October 17, 2021, and with the '443 patent since at least February-September 2024. EX2007, ¶ 29. Thus, Patent Owner's expectations in the '443 patent were settled, or at least neutral, by the time Petitioner filed this IPR in July 2025, at the very end of the statutory period to file an IPR.³

3. The petition depends on its expert to fill gaps in the prior art

Discretionary denial is warranted because the petition backfills fundamental gaps in the prior art through unsupported statements from Petitioner's expert, Dr. Ilkov.⁴ For example, the petition's argument that Oostman's solution of star-shaped detector clusters are suboptimal because they increase "complexity in geometry of the optical fibers to minimize signal loss (and maximize internal reflection of incident light)" (Pet. at 24-25), is contrary to other statements in Oostman and based simply on Dr. Ilkov's say-so (EX1002, ¶ 75). Additionally, Dr. Ilkov's unsupported statements (*e.g.*, EX1002, ¶ 81) are the sole basis for the petition's extraordinary and

³ Even if expectations were not settled, denial is appropriate where "Petitioner has not offered a stipulation to address concerns of duplicative efforts and potentially conflicting decisions" in "a significantly earlier trial date in a co-pending case that is unlikely to be stayed." *Phison*, IPR2025-00213, Paper 14 at 2; *see supra* p. 11.

⁴ Notably, Dr. Ilkov has patents assigned to Petitioner, *e.g.*, EX2021, EX2022.

flawed argument that a skilled artisan, although starting with Oostman's flow cytometers, would have sought to replace *all* of Oostman's key fluorescence detection instrument components—*i.e.*, the entire disclosure of Oostman that forms the basis for all its patented claims—with Goodman's WDM from another field (Pet. at 29). The extent of the petition's reliance on expert testimony for fundamental elements of a *prima facie* case weighs in favor of denial.

C. Discretionary Denial Is Warranted Under 35 U.S.C. § 325(d)

The Board may deny the petition for a separate reason: because Oostman and Goodman are “the same prior art ... previously [] presented to the Office.” 35 U.S.C. § 325(d). As explained above (pp. 5-6), both references were considered by multiple examiners during prosecution of the '443 patent's grandparent and the related '582 patent. *See ADT v. Vivint*, IPR2022-00612, Paper 8 at 21-23 (PTAB Aug. 22, 2022) (“Petition presents substantially the same prior art that was already considered by the examiner during prosecution,” including art that was “made of record”). Also as explained above (pp. 16-18), the USPTO did not commit material error when considering the prior art during prosecution.

IV. Conclusion

Patent Owner respectfully requests that the Board deny institution.

IPR2025-01319
Patent No. 11,703,443
Patent Owner's Request for Discretionary Denial

Respectfully submitted,

Dated: September 30, 2025

/Alexis R. Cohen/
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Registration No. 76,998

Counsel for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify that on September 30, 2025, I caused a true and correct copy of the following materials:

- Patent Owner's Request for Discretionary Denial
- Exhibit List
- Exhibits for Patent Owner's Request for Discretionary Denial
(EX2001-EX2027)

to be served on Petitioner via electronic mail to:

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