

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CYTEK BIOSCIENCES, INC.,
Petitioner

v.

BECKMAN COULTER, INC.
Patent Owner

Case No. IPR2025-01319
U.S. Patent No. 11,703,443 B2
Issue Date: July 18, 2023

Title: FLOW CYTOMETER

**PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL**

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Exhibit No.	Description of Document
1001	U.S. Patent No. 11,703,443 B2 to Yong Qin Chen (filed November 4, 2022, issued July 18, 2023) (“443 patent”)
1002	Declaration of Fedor A. Ilkov, Ph.D.
1003	Prosecution History of U.S. Patent No. 11,703,443 B2
1004	Nigel P. Carter and Michael G. Ormerod, <i>Chapter 1, Introduction to the Principles of flow cytometry</i> , Flow Cytometry, pp. 1-22 (3rd ed. 2000)
1005	U.S. Patent No. 6,683,314 B2 to Clifford A. Oostman, Jr. et al. (filed August 28, 2001; published January 27, 2004) (“Oostman”)
1006	U.S. Patent No. 5,317,162 to Bertram G. Pinsky et al. (filed September 9, 1992; published May 31, 1994) (“Pinsky”)
1007	Excerpts of Howard M. Shapiro, Practical Flow Cytometry (4th ed. 2003) (“Shapiro”)
1008	World Patent No. WO 2010/101623 A1 to Michael Thomas (filed March 2, 2010; published September 10, 2010) (“Thomas”)
1009	U.S. Patent No. 8,284,402 B2 to Erich Frazier et al. (filed February 26, 2010; published October 9, 2012) (“Frazier”)
1010	U.S. Patent No. 4,244,045 to Kiyoshi Nosu et al. (filed January 31, 1979; published January 6, 1981) (“Nosu”)
1011	U.S. Patent No. 8,537,468 B1 to Xuan Wang et al. (filed June 10, 2011; published September 17, 2013) (“Wang”)
1012	U.S. Patent No. 6,198,864 B1 to Brian E. Lemoff et al. (filed November 24, 1998; published March 6, 2001) (“Lemoff”)
1013	U.S. Patent No. 7,212,343 B1 to Chun He et al. (filed July 11, 2003; published May 1, 2007) (“He”)

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Exhibit No.	Description of Document
1014	U.S. Patent No. 5,835,517 to Vijaysekhar Jayaraman et al. (filed October 4, 1996; published November 10, 1998) (“ Jayaraman ”)
1015	U.S. Patent No. 6,201,908 B1 to Eric B. Grann (filed July 2, 1999; published March 13, 2001) (“ Grann ”)
1016	U.S. Patent No. 6,542,306 B2 to Timothy D. Goodman (filed March 16, 2001; published April 1, 2003) (“ Goodman ”)
1017	Listing of Challenged Claims
1018	Joint Claim Construction Chart including Exhibit A Parties Agreed and Proposed Constructions filed in <i>Beckman Coulter, Inc. v. Cytek Biosciences, Inc.</i> , C.A. No. 24-945 (D. Del. May 28, 2025), D.I. 89 & 89-1
1019	Plaintiff’s Disclosure of Asserted Claims and Infringement Contentions [Redacted Version], served in <i>Beckman Coulter, Inc. v. Cytek Biosciences, Inc.</i> , C.A. No. 24-945 (D. Del. Feb. 14, 2025)
1020	Definition of Mirror from Concise Oxford English Dictionary (12th ed. 2011)
1021	Excerpts of Course 1 Fundamentals of Light and Lasers, Optics and Photonics Series, Modules 1-6, OP-TEC (3rd ed. 2018)
1022	Henry Semat and Robert Katz, <i>Chapter 38: Mirrors and Lenses</i> , Physics, Robert Katz Publications, pp. 699-722 (1958)
1023	Steve Wasserman, <i>Geometrical optics and ray tracing</i> , Course Wiki (August 27, 2019)
1024	Plaintiff Beckman Coulter, Inc.’s Opening Claim Construction Brief, served in <i>Beckman Coulter, Inc. v. Cytek Biosciences, Inc.</i> , C.A. No. 24-945 (D. Del. June 5, 2025)

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1025	Complaint filed in <i>Beckman Coulter, Inc. v. Cytek Biosciences, Inc.</i> , C.A. No. 1:24-cv-00945 (D. Del. Aug. 14, 2024), D.I. 1
1026	Summons in a Civil Action to Cytek Biosciences, Inc. c/o Cogency Global, Inc. served on August 15, 2024, filed in <i>Beckman Coulter, Inc. v. Cytek Biosciences, Inc.</i> , C.A. No. 1:24-cv-00945 (D. Del. Aug. 16, 2024), D.I. 5
1027	Stipulation and Order Amending Scheduling Order filed in <i>Beckman Coulter, Inc. v. Cytek Biosciences, Inc.</i> , C.A. No. 1:24-cv-00945 (D. Del. March 4, 2025), D.I. 55
1028	Prosecution history of EP24151670
1029	Excerpts of the Prosecution history of U.S. Patent No. 9,746,412
1030	Rochelle A. Diamond, <i>Chapter 8: Quality Control Guidelines for Research Flow Cytometry</i> , In Living Color, pp. 98-105 (2000)
1031	<i>Reserved</i>
1032	First Amended Complaint filed in <i>Beckman Coulter, Inc. v. Cytek Biosciences, Inc.</i> , C.A. No. 1:24-cv-00945 (D. Del. Jan. 9, 2025), D.I. 42
1033	Cytek Biosciences Debuts New Advanced Flow Cytometry System, (June 7, 2017), https://cytekbio.com/blogs/news/cytek-biosciences-debuts-newadvanced-flow-cytometry-system
1034	U.S. Patent No. 10,330,582 B2 to Yong Qin Chen (filed June 30, 2017, issued June 25, 2019) (“582 patent”)

I. INTRODUCTION

Petitioner submits this Opposition to Patent Owner's Request for Discretionary Denial in the above-captioned *inter partes* review (IPR) of U.S. Patent No. 11,703,443 B2 ("’443 patent" or "EX1001"), Claims 1-4, 6, 7, 9, 10, 11, 13, and 15-18 (the "Challenged Claims"). Institution is warranted under both *Advanced Bionics* and *Fintiv*. The Petition presents a compelling challenge to the ’443 patent, based on art and arguments *not* considered during prosecution. This very art resulted in a novelty rejection of nearly identical claims by the European Patent Office ("EPO"). Additionally, Patent Owner's serial gamesmanship during the prosecution of the ’443 patent and Petitioner's strong settled expectations favor institution.

II. DISCRETIONARY DENIAL UNDER *ADVANCED BIONICS* IS UNWARRANTED

A. *Advanced Bionics* Step 1 Is Unmet Because the Petition Raises Art and Arguments Not Previously Considered by the Office

Because the Petition raises novel and non-cumulative art and arguments, denial under § 325(d) is inappropriate under *Advanced Bionics* Step 1. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) ("*Advanced Bionics*") (precedential).

1. The Examiner Did Not Consider the Petition's Asserted References During Prosecution of the ’443 Patent

While Goodman and Oostman appear on the face of the ’443 patent, there is no evidence that the Examiner considered either reference individually, let alone

collectively. Contrary to the Patent Owner’s argument that the ’443 patent “under[went] extensive and thorough prosecution,” (Paper 7 (“Mot.”) at 5), the ’443 patent issued without a single office action. No evidence exists in the prosecution history of the ’443 patent or any of the related prosecution histories highlighted by Patent Owner of the Examiner ever substantively considering Goodman (beyond its mere inclusion in the IDS of the ’443 patent). To the contrary, in prosecuting the ’412 patent, the Patent Owner submitted an IDS identifying hundreds of references (EX1029, pp.002-011), prompting the Examiner to respond as follows:

The examiner notes that due to the unusually large number of references cited, and the absence of any description of the relevance of the references, it should be assumed that only the most cursory review of the cited documents consistent with these guidelines has been performed. If applicant is aware of any information that might be of particular relevance, it should be pointed out in order to insure a higher degree consideration.

(EX1029, p.046.) Yet Patent Owner failed to raise either Goodman or Oostman for “higher degree [of] consideration” during prosecution, instead submitting another IDS citing hundreds of references. (EX1003, pp.147-160.) Absent “other evidence of record to show that the Examiner considered [the reference] in any meaningful way during prosecution . . . ,” Step 1 is not satisfied. *Samsung Elecs. Co. v. Maxell, Ltd.*, IPR2024-00906, Paper 11 at 14-15 (PTAB Dec. 11, 2024) (“*Samsung*”).

The Board’s decision in *Whitewater West Industries, LTD v. American Wave Machines, Inc.* is instructive. IPR2022-01033, Paper 8 at 16 (PTAB Nov. 22, 2022)

(“*Whitewater West*”). There, the patent owner argued that *Advanced Bionics* Step 1 was met because it had submitted the two references in question in an IDS, and the specification of the challenged patent even discussed one of the references. *Whitewater West*, Paper 6 at 8 (Aug. 24, 2022). The patent owner even noted that one of these references had the same inventor as the challenged patent and that the Examiner had “specifically searched prior art by the same inventor.” *Id.* Yet as the Board explained in its decision to institute IPR:

The exercise of discretion in *Advanced Bionics* did not turn on mere citation in an IDS of the art asserted in the petition. . . . [T]he criteria adopted by the Board for denying the petition in *Advanced Bionics* included not only the fact the art was made of record, but also the fact it was applied and discussed during prosecution. Anything less disregards the express reasoning behind the Board’s exercise of discretion in that case.

Whitewater West, Paper 8 at 16 (emphasis omitted). The Board’s reasoning in *Whitewater* is consistent with the Board’s findings elsewhere. Indeed, the Board has found in multiple instances that merely including a reference in an IDS that is signed by the Examiner during prosecution is insufficient to satisfy *Advanced Bionics* Step 1. *E.g.*, *Sci. Design Co. v. Shell Oil Co.*, IPR2021-01537, Paper 7 at 25 (PTAB Mar. 18, 2022) (“*Sci. Design*”) (concluding that listing a reference on an IDS initialed by an Examiner, without more, is “not indicat[ive of] a substantive

evaluation of the asserted art”); *Samsung*, Paper 11 at 14-15 (similar). As consistently held by the Board, “a reference that ‘was neither applied against the claims nor discussed by the Examiner’ does not weigh in favor of exercising [] discretion under §325(d).” *Fasteners for Retail, Inc. v. RTC Indus., Inc.*, IPR2019-00994, Paper 9 at 7–11 (PTAB Nov. 5, 2019); *see also Cisco Sys., Inc. v. NetSocket, Inc.*, IPR2023-00607, Paper 11 at 22 (PTAB Sep. 26, 2023) (“[A] reference that ‘was neither applied against the claims nor discussed by the Examiner’ does not weigh in favor of exercising discretion under § 325(d).”); *Samsung Elecs. Co. v. Ouraring, Inc.*, IPR2024-01077, Paper 8 at 19 (PTAB Jan. 28, 2025) (*Advanced Bionics* Step 1 was unmet, including because the reference was “neither applied in a rejection nor meaningfully discussed during prosecution” despite being listed on an IDS).

Here, the only reference to either Goodman or Oostman in the ’443 prosecution history that Patent Owner identifies is that they were included on an IDS that the Examiner electronically signed. (Mot. at 6.) But as the Board explained in *Samsung*, inclusion on an IDS submitted by the applicant—even where the examiner includes the text “ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH” and has not lined through the reference in question—is insufficient. *Samsung*, Paper 11 at 14-15 (“Other than being listed on the first page of this IDS (line 8), Patent Owner does not point us to any other evidence of record to show that the Examiner considered [the asserted reference] in any meaningful way during

prosecution of the [challenged] patent[, and i]ndeed, in the Examiner's Detailed Action issued with the Notice of Allowability, the Examiner does not mention [the asserted reference] at all, but instead cites to [non-asserted references].”).

2. Petition's Asserted References Are Not Cumulative of Any Reference Considered During Prosecution of the '443 Patent

Petitioner's Asserted References are not cumulative of any reference considered by the Examiner during prosecution of the '443 patent. In fact, the Examiner did not issue any rejection of the original claims for the '443 patent. The only reference cited during prosecution of the '443 patent was U.S. Patent No. 11,333,597 to Yan in the Notice of Allowability. (EX1003, p.243.) The Examiner distinguished Yan based on priority rather than its substantive disclosures. (*Id.*)

3. Evidence of Examiner's Consideration of Oostman in *Other* Proceedings Does Not Satisfy *Advanced Bionics* Step 1

Patent Owner's reliance on the prosecution histories of related patents as evidence that the Examiner considered the Asserted References is misplaced.

First, Patent Owner's argument ignores practical realities surrounding the prosecution histories of the '443 patent and its family. Because Patent Owner delayed filing the '443 application, more than six years had elapsed between the office action during prosecution of U.S. Patent No. 9,746,412 (the "'412 patent") that Patent Owner cites and Patent Owner's filing of the application that led to the '443 patent, (*compare* EX2015, pp.1067, 1070-1071, *with* EX1001, p.001).

Moreover, because Patent Owner failed to heed the Examiner's restriction requirement, (*see infra*, Section IV.B), the priority chain of the '443 patent does not include U.S. Patent No. 10,330,582 (the "'582 patent"), whose prosecution history Patent Owner also cites. Thus, Patent Owner's argument that references considered during the prosecution of the '412 and '582 patents would have been automatically considered during prosecution of the '443 patent ignores impediments to the Examiner's awareness resulting from Patent Owner's own actions.

Second, even if the prosecution histories of the '412 and '582 patents are incorporated into the prosecution history of the '443 patent, there is no evidence that the Examiner ever considered the particular obviousness combination, along with the expert declaration accompanying the combination, that the Petition now raises. *BMW of N. Am., LLC v. Foras Techs., Ltd.*, IPR2024-01346, Paper 7 at 20-21 (PTAB Mar. 7, 2025) ("*BMW*") (refusing to exercise § 325(d) discretion to deny institution when petitioner raised additional combinations that were not before the Examiner and expert testimony supporting the obviousness combination).

As noted above, in prosecuting the '412 patent, Patent Owner submitted an IDS identifying hundreds of references (EX1029, pp.002-011), prompting the Examiner to respond that "only the most cursory review of the cited documents consistent with these guidelines has been performed" and that any "any information that might be of particular relevance [] should be pointed out in order to insure a

higher degree [of] consideration.” (EX1029, p.046.) But Patent Owner failed to raise either Goodman or Oostman for “higher degree [of] consideration,” and instead submitted another IDS citing hundreds of references. (EX1003, pp.147-160.) While the Examiner may have considered Oostman in certain office actions of patents related to the ’443 patent, he never considered Goodman nor the obviousness combination raised by the Petition. *See BMW*, Paper 7 at 20-21.

B. *Advanced Bionics* Step 2 Is Unmet & § 325(d) Denial Is Inappropriate Due to Examiner Error & Patent Owner’s Actions

Even if inclusion of the Asserted References on an IDS satisfied *Advanced Bionics* Step 1, discretionary denial under § 325(d) is not warranted under Step 2. Here, there is clear evidence that the Examiner failed to appreciate that the proposed obviousness combination discloses every limitation of the Challenged Claims (as evidenced by a novelty rejection over similar grounds at the European Patent Office (“EPO”)), and Patent Owner’s failure to raise the Asserted References to the Examiner for consideration makes denial under § 325(d) inappropriate.

Applying the *Becton Dickinson* framework demonstrates the Examiner’s error. Regarding fact (c) (the extent to which the asserted references were evaluated), Patent Owner submitted an IDS spanning hundreds of references, yet not a single office action occurred. Indeed, Patent Owner did not raise, and the Examiner gave no indication of considering, either Goodman or Oostman individually, let alone collectively, vis-à-vis the Challenged Claims. *Ecto World, LLC v. RAI*

Strategic Holdings, Inc., IPR2024-01280, Paper 13 at 6-7 (Dir. Dec. May 19, 2025) (“*Ecto World*”) (“[E]ven if a petitioner fails to make a persuasive argument that the Examiner erred by overlooking particular teachings in the prior art provided on an IDS, a petitioner may be able to demonstrate that discretionary denial is inappropriate under *Becton Dickinson* factor (f) [because] [t]hat factor considers the extent to which additional evidence and facts warrant reconsideration of the prior art or arguments [such as] the volume of the references submitted to the Office during examination and any applicant information or assistance regarding the relevance of references.”). Here, Petitioner has identified how Examiner erred in the evaluation of the Asserted References (*Becton Dickinson* factor (e)) and substantial evidence exists that warrants reconsideration of this art (*Becton Dickinson* factor (f)).

First, examiners at the EPO reached the same conclusions on the Challenged Claims in a foreign counterpart, EP24151670, which is still undergoing prosecution. (EX1028.) There, Patent Owner originally asserted nearly identical claims to those recited in the ’443 patent. (*Compare* ’443, cls. 1-4, 7, 9, 10, 11, 13, 15-17, with EX1028 (Jan. 12, 2024 Claims), pp.056-058, cls. 1-4, 6, 8-10, 12, 14, 15.)¹ The EPO

¹ Original claim 5 to EP24151670 is a combination of the additional limitations in Claims 5 and 6 of the ’443 patent. Original claim 15 to EP24151670 is a combination of the additional limitations in Claims 16 and 17 of the ’443 patent.

issued a novelty rejection of those claims based on the same prior art that the Petition identifies: Goodman and Oostman. (EX1028 (Apr. 9, 2024) Eur. Search Op., pp.037-042.) Rather than challenge the prior art, Patent Owner drastically narrowed its claims, (EX1028 (Nov. 7, 2024), pp.014-031)—clear evidence that the Challenged Claims are invalid over Petitioner’s proposed obviousness combination.

Second, rather than drawing the Examiner’s attention to the proposed obviousness combination which resulted in a novelty rejection at the EPO, Patent Owner buried these references during prosecution of the ’443 patent in an IDS spanning hundreds of references. Such actions clearly impeded the Examiner’s ability to consider the Asserted References individually or collectively.² As

² For example, in *Ecto World*, the Board initially denied institution under § 325(d). Paper 16 at 2 (PTAB June 25, 2025). But following a request for director review, Director Stewart remanded the matter to the Board for further proceeding consistent with her guidance as to *Advanced Bionics* and *Becton, Dickinson*. *Id.* On remand, the Board opted *against* denying institution pursuant to § 325(d). *Id.* at 15. Specifically, the Board concluded that § 325(d) denial was not appropriate where the patent owner submitted a lengthy IDS and “Petitioner . . . show[ed] that the applicant did not respond to the Examiner’s request [to] point out ‘any particular reference . . . which the examiner should . . . pay particular attention to.’” *Id.* at 14.

explained in Section B.3 above, Patent Owner's argument that the Examiner would have been aware of Oostman based on office actions in the prosecution of the related '412 and '582 patents is unfounded. Indeed, the onus was on Patent Owner, aware of the Examiner's previous request to raise prior art of "particular relevance" for "higher degree [of] consideration," (EX1029, pp.002-011), to draw the Examiner's attention to the Asserted References, especially in light of the EPO novelty rejection. Instead, Patent Owner swept the Asserted References under the proverbial rug.

Third, Dr. Ilkov's expert declaration, which was not available during the '443 patent's prosecution and which explains why the Challenged Claims are obvious over the prior art, warrants reconsideration, *Therabody, Inc. v. Hyperice IP Subco, LLC*, PGR2024-00053, Paper 8 at 10-11 (PTAB Apr. 21, 2025) (finding "factor (f) weigh[ed] against exercising discretion to deny institution under § 325(d)" in light of expert declaration); *Sci. Design*, Paper 7 at 25 ("Based on the strength of Petitioner's challenges, we find that Petitioner sufficiently demonstrates that the Examiner erred in overlooking the relevant disclosures of the cited references.").

III. DISCRETIONARY DENIAL UNDER *FINTIV* IS UNWARRANTED

Denial under *Fintiv* is not warranted here because four of the six *Fintiv* factors are either neutral or weigh in favor of institution. And here, factor 6 (compelling merits) outweighs any other factor that may favor denial. *Inergy Tech., Inc. v. Force MOS Tech. Co.*, IPR2024-00093, Paper 13 at 17-20, 23-25 (PTAB May 21, 2024)

(“*Inergy*”) (granting institution despite factors 1-5 weighing against institution based on compelling merits given strength of the petition); *Samsung Elecs. Co. v. Sionyx, LLC*, IPR2024-01431, Paper 21 at 17-18 (PTAB Apr. 10, 2025) (same); *Vizio, Inc. v. Maxell, Ltd.*, IPR2022-01458, Paper 8 at 62 (PTAB Apr. 11, 2023) (similar).

Fintiv 1 – likelihood of a stay in parallel litigation. This factor is either neutral or slightly favors discretionary denial. While the district court’s denial of Petitioner’s motion to stay issued when only one of four asserted patents was challenged at the PTAB, all four patents have since been challenged. And while an EPR requested on a related patent has been denied, Petitioner’s time to request Director Review of that denial, which Petitioner intends to seek, has not yet expired.

Other circumstances have changed, favoring a stay. For example, Patent Owner dropped one of the four asserted patents in the district court, leaving only three asserted patents, and both parties have already narrowed their asserted claims and prior art references. *See, e.g., SITO Mobile R&D IP, LLC v. World Wrestling Ent., Inc.*, C.A. No. 21-721-CFC, 2021 WL 7628181, at *1 (D. Del. Dec. 20, 2021) (considering if stay will reduce the burden of litigation on the parties and court, and granting motion to stay for simplification of the issues pending IPR); *Uniloc 2017 LLC v. Vudu, Inc.*, Civ. No. 19-183-CFC, Dkt. 72 at 2 (D. Del. Mar. 26, 2020) (granting stay after institution of IPRs).

Fintiv 3 – investment in parallel proceedings by Court and parties. This

factor is neutral. Even if the district court has issued substantive orders, this factor may weigh against denial where, as here, the petitioner promptly filed its petition after learning which claims are being asserted against it. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 11 (PTAB Mar. 20, 2020) (“*Apple*”) (precedential) (“The Board recognizes . . . that it is often reasonable for a petitioner to wait to file its petition until it learns which claims are being asserted against it . . .”); *see also Bio-Rad Labs., Inc. v. Cal. Inst. of Tech.*, IPR2024-01451, Paper 11 at 10-11 (PTAB Mar. 27, 2025) (factor 3 weighed against denial where “infringement and invalidity contentions ha[d] been served, damages contentions ha[d] been exchanged, [and] a *Markman* hearing ha[d] been held” but “expert reports, expert discovery, expert depositions, and pretrial motions and disclosures” remained).

Patent Owner argues that Petitioner delayed in filing this IPR. (Mot. at 12-13.) Not so. Petitioner worked diligently to learn which patents and claims Patent Owner intended to litigate. In fact, Patent Owner’s initial Complaint, filed August 14, 2024, only alleged infringement of the ’582 and ’443 patents. (EX1025.) By January 9, 2025, Patent Owner alleged infringement of two additional patents. (EX1032.) On February 14, 2025, Patent Owner served its Disclosure of Asserted Claims and Infringement Contentions, which alleged infringement by Petitioner of 90 claims across four asserted patents. (EX1019.) After a months-long dispute over narrowing the asserted claims, Patent Owner was ordered to narrow its asserted

claims on April 2, 2025 from 90 claims across four patents to 42 claims. Thereafter, Petitioner diligently worked to prepare its petitions for IPR, PGR, and EPR across the Asserted Patents, even while engaging in claim construction briefing. Despite Patent Owner's resistance to case narrowing, Petitioner was diligent in filing the IPR within two months of the joint claim construction chart, and ahead of the statutory deadline. *See Apple*, Paper 11 at 11; *Intel Corp. v. VLSI Tech. LLC*, IPR2019-01192, Paper 15 at 12–13 (PTAB Jan. 9, 2020) (petitioner was diligent in filing the petition after patent owner narrowed the asserted claims in the district court litigation).

Moreover, Patent Owner's assertion that the Petition was not timely served, (Mot. at 12), is meritless. As soon as Petitioner discovered the inadvertent omission in service, Petitioner promptly filed an Updated Certificate of Service (Paper 6), explaining the inadvertent clerical error. (Paper 6 at 2.) As already fully briefed in Paper 6, Patent Owner was on notice of the filing of the Petition within the statutory deadline, which undoubtedly places the service in compliance with 35 U.S.C. § 312(a)(5). (*Id.* at 1-2 (citing cases).) Petitioner did not unduly delay. *NEC Corp. v. Peloton Interactive, Inc.*, Civ. A. No. 22-987-CJB, 2024 WL 1533952, at *2 (D. Del. Apr. 9, 2024) (“[F]iling an IPR petition close to the one-year statutory deadline is not problematic *per se*, because ‘accused infringers often understandably want to have a good handle on what the scope of the district court litigation will be before they file an IPR petition.’” (citation omitted)).

Fintiv 4 – overlap between the issues. This factor strongly favors institution.

Because Goodman is *not* asserted as prior art in the district court litigation, the obviousness combinations proposed by the Petition will not be litigated in district court. Thus, there can be no overlap of issues. Nevertheless, to address any perceived concerns, Petitioner hereby stipulates that if this IPR is instituted, Petitioner will not pursue in the pending litigation (i) the specific grounds of invalidity that were raised or that reasonably could have been raised under 35 U.S.C. §§ 102 or 103 on the basis of prior art patents or printed publications in this IPR, and (ii) grounds of invalidity under 35 U.S.C. § 103 on the basis of any other prior art that could not have been raised in the IPR (e.g., system art) in combination with any of those prior art references relied on listed in the grounds for this IPR with respect to any challenged claim. To avoid any doubt, if the PTAB declines or rescinds institution of IPR, Petitioner reserves the right to pursue any grounds of invalidity, including but not limited to the grounds in (i) and (ii), in the pending litigation.

Fintiv 6 – compelling merits. The compelling merits factor strongly favors institution here, outweighing any other *Fintiv* factors individually or collectively. *Inergy*, Paper 13 at 17-20, 23-25 (refusing to exercise discretion to deny petition despite each *Fintiv* factor weighing against institution—including a trial date several months before the deadline for the PTAB’s decision—because petition presented prima facie case that at least one of the challenged claims was unpatentable); *TVision*

Insights, Inc. v. Nielsen Co. (US), LLC, IPR2023-01014, Paper 10 at 52-53 (PTAB Jan. 8, 2024) (compelling merits of Petition’s challenges “very heavily weigh[] against exercising . . . discretion to deny institution”).

Here, there is clear and compelling evidence that the Challenged Claims are unpatentable over the Petition’s proposed obviousness combination. (*See* EX1002.) As explained in Section II.B, the EPO already found claims nearly identical to the Challenged Claims unpatentable over the Petition’s proposed obviousness combination and Patent Owner refused to draw the Examiner’s attention to this particular reference combination during prosecution of the ’443 patent, even as it rewrote its co-pending claims at the EPO. Moreover, as explained below, Petitioner enjoyed strong settled expectations and Patent Owner engaged in gamesmanship at the Patent Office, which militate against denial of institution.

Patent Owner’s argument that “the petition backfills fundamental gaps in the prior art through unsupported statements from Petitioner’s expert, Dr. Ilkov,” (Mot. at 19-20), is baseless. Notably, Patent Owner does not argue that Dr. Ilkov is not a person of ordinary skill in the art or that Dr. Ilkov is not qualified as an expert to opine on the Asserted Claims. Dr. Ilkov, as a qualified expert, can rely on his general knowledge to “support a motivation to combine or to demonstrate the knowledge of a person having ordinary skill in the art. *See, e.g., Unification Techs. LLC v. Micron Tech. Inc.*, 2024 WL 3738401, at *7 (Fed. Cir. Aug. 9, 2024) (affirming use of

general knowledge in an IPR proceeding in the form of expert testimony and AAPA to demonstrate how a skilled artisan would have understood a prior art reference's disclosure as teaching a claim limitation)." Mem. from Dir. Stewart, Re Enforcement & Non-Waiver of 37 C.F.R. § 42.104(B)(4) & Permissible Uses of General Knowledge In *Inter Partes* Reviews (July 31, 2025).

IV. ADDITIONAL CONSIDERATIONS WARRANT INSTITUTION

A. Petitioner's Settled Expectations Strongly Favor Institution

In the years following launch of the first of the Accused Products (the Aurora flow cytometry system), Petitioner developed strong settled expectations that its products did not infringe the '443 patent or any related patent including because (1) the patents Patent Owner is asserting in the district court litigation had not yet issued and Patent Owner delayed in bringing suit; and (2) because of Patent Owner's tacit admission that Petitioner's products did not infringe its patents.

Indeed, when the Aurora system launched in June 2017, (EX1033), none of the Asserted Patents had issued. It would be two years until the first of the Asserted Patents, the '582 patent, issued in June 2019, (EX1034), and four more years until the '443 patent issued in 2023, (EX1001) (and another year until Patent Owner filed suit in August 2024, (EX1025)). Thus, by the time the '443 patent issued, the Aurora system had already been on the market for six years.

Moreover, clear evidence justified Petitioner's belief that its products did not infringe Patent Owner's patents. In fact, the only patent related to the Asserted Patents which issued prior to the launch of the Aurora system was the '412 patent, which Patent Owner has not asserted against Petitioner, suggesting it did not support any infringement allegations. Indeed, this comprises a tacit concession of non-infringement by Patent Owner, increasing Petitioner's settled expectations. *Cf Datadome S.A. v. Arkose Labs Holdings, Inc.*, IPR2025-00693, -00694, Paper 13 at 2 (PTAB Aug. 14, 2025) (“[A] concession of non-infringement by a patent owner may constitute settled expectations for a petitioner.”).

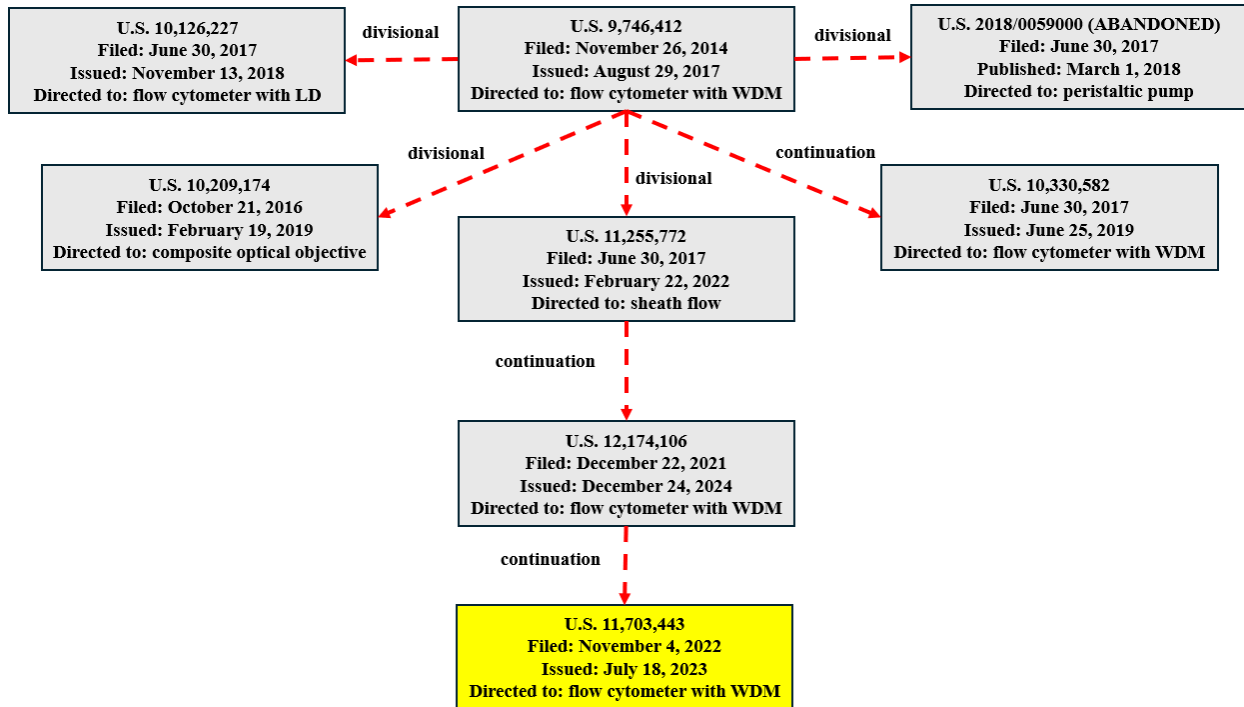
Further, the '443 patent issued just over two years ago in July 2023, and is not entitled to settled expectations. Patent Owner's argument that it is entitled to settled expectations based on Petitioner's knowledge of the patent family containing the '443 patent is meritless. Indeed, as explained above, the first of the Asserted Patents (the '582 patent) issued two years *after* the Aurora system launched, the first of the Asserted Patents' related patents (the '412 patent) has never been asserted against Petitioner, and, to the contrary, Patent Owner's actions amounted to a tacit concession of non-infringement.

B. Patent Owner's Prosecution Gamesmanship Warrants Institution

But for Patent Owner's gamesmanship following a restriction requirement during prosecution of the '443 patent and related patents, the Challenged Claims

would never have issued. Specifically, Patent Owner failed to properly file the '443 patent as a continuation of the '412 patent (directed to a flow cytometer having a wavelength division multiplexer) and instead improperly filed the '443 patent as a continuation of a divisional of the '412 patent directed to a method of sheath flow despite *none* of the '443 patent claims being directed to this invention. *St. Jude Med., Inc. v. Access Closure, Inc.*, 729 F.3d 1369, 1380 (Fed. Cir. 2013) (held patents invalid where line of demarcation from restriction requirement not maintained).

During prosecution of the '412 patent, the Examiner required restriction of the claims to one of the following inventions: (1) a flow cytometer having a wavelength division multiplexer; (2) a flow cytometer having a composite microscope objective; (3) a flow cytometer having a fluidic system; (4) a flow cytometer having a peristaltic pump; and (5) a flow cytometer having a laser diode system. (EX1029, Restr. Req. (Apr. 20, 2016), pp.021-027.) The inventor elected Group 1 for continued examination. (EX1029, Resp. to Restr. Req. (June 3, 2016), pp.029-034.) The application ultimately issued as the '412 patent on August 29, 2017. The applicant then filed several divisional applications from the '412 patent, presumably to cover each invention defined during the '412 patent's prosecution. Patent Owner also filed a continuation of the '412 patent directed to a flow cytometer having a wavelength division multiplexer ("WDM"), which issued as the '582 patent. This convoluted prosecution history is demonstrated by the family tree below:



Like the '412 patent, the '582 claims are directed to a flow cytometer with a WDM, and like the '443 patent, the '582 patent is asserted against Petitioner in district court litigation. As relevant to this case, the divisional application filed on June 30, 2017, which issued as U.S. Patent No. 11,255,772 (the "'772 patent"), claims the method of providing sheath flow to a flow cell.

However, before the '772 patent issued, the applicant improperly filed a continuation application from the '772 patent on December 22, 2021 claiming a flow cytometer having a WDM, despite the fact that the '582 patent covering the same subject matter had already issued as a continuation of the '412 patent. This application resulted in U.S. Patent No. 12,174,106 ("the '106 patent"), which issued on December 24, 2024. Before the issuance of the '106 patent, the applicant filed a

continuation application on November 4, 2022, which ultimately resulted in the challenged '443 patent, covering a flow cytometer having a WDM.

Of course, Patent Owner should have filed the '106 patent as continuation of the '582 patent, which also covers a flow cytometer covering a WDM, and *not* as a continuation of the '772 patent. However, by the time the Patent Owner was ready to file the '106 patent on December 22, 2021, the only available avenue was through a continuation application from the '772 patent because the patents directed to a flow cytometer covering the WDM had already been issued. Patent Owner's lack of diligence led to the improper issuance of the '443 patent as a continuation of a divisional patent, in violation of the well-settled requirement for consonance between inventions. *See, e.g., Gerber Garment Tech., Inc. v. Lectra Sys., Inc.*, 916 F.2d 683, 688 (Fed. Cir. 1990) (finding asserted claims of a continuation patent of a divisional invalid for lack of consonance); *Symbol Techs., Inc. v. Opticon, Inc.*, 935 F.2d 1569, 1579 (Fed. Cir. 1991) (extending § 121 safe harbor provision to continuation applications descending from a divisional application).

V. CONCLUSION

For the foregoing reasons, Petitioner respectfully opposes Patent Owner's Request for Discretionary Denial.

Dated: October 30, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. § 42.6, that I caused a true and correct copy of the foregoing documents **PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL**, including all exhibits (**Nos. 1032-1034**) is being served via electronic mail on the 30th day of October, 2025, upon Patent Owner's counsel as follows:

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DATED: October 30, 2025

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