

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. PGR2025-00088
U.S. Patent No. 12,174,107 B1
Issue Date: December 24, 2024

Title: FLOW CYTOMETER

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

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1001	U.S. Patent No. 12,174,107 B2 to Yong Qin Chen (filed September 3, 2024, issued December 24, 2024) (“ 107 patent ”)
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1017	Listing of Challenged Claims
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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)
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1112	Excerpts from the Opening Invalidity Expert Report of Fedor A. Ilkov, Ph.D. [Redacted Version], served in <i>Beckman Coulter, Inc. v. Cytek Biosciences, Inc.</i> , C.A. No. 24-945 (D. Del. Dec. 19, 2025)
1113	Memorandum from Scott R. Boalick, Chief Administrative Patent Judge re Guidance on USPTO’s recission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,” dated March 24, 2025 (USPTO)
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1116	Memorandum from John A Squires, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office re Voluntary Search Disclosure Declarations as a Favorable Factor in Institution Decisions, dated November 17, 2025
1117	Excerpts of the Prosecution history of U.S. Patent No. 9,746,412

I. INTRODUCTION

Patent Owner's Request for Discretionary Denial in the above-captioned post-grant review ("PGR") of U.S. Patent No. 12,174,107 B1 ("’107 patent" or "EX1001") fails at every threshold. The ’107 patent is PGR-eligible because the Office has never substantively addressed the independent written description and enablement defects identified in the Petition, which defeat any claim to pre-AIA priority and were not cured during prosecution. The *Fintiv* factors also do not support discretionary denial, given Petitioner's diligence and *Sotera* stipulation. Denial under § 325(d) is likewise improper because the Examiner never substantively evaluated the specific teachings, combinations, or motivations relied upon here, and materially erred in identifying the mirror-to-filter relay limitation as a reason for allowance. Denying institution on any of these grounds would improperly insulate a recently issued patent from the exact type of post-grant scrutiny Congress intended PGR proceedings to provide.

II. THE ’107 PATENT IS PGR-ELIGIBLE

Patent Owner's PGR-ineligibility arguments are unconvincing. (Paper 10 ("Mot.") at 9-10.) A patent is PGR-eligible if *even one* of its challenged claims is not entitled to a pre-AIA priority date. *See Tricam Indus., Inc. v. Little Giant Ladder Sys., LLC*, PGR2021-00044, Paper 10 at 15 (PTAB Aug. 3, 2021). Such is the case here.

With respect to the “diameter of the spot is less than 1 mm” limitation of claims 14 and 18, Patent Owner’s reliance on claims 3, 4, 9, and 10 of a pre-AIA provisional for written description support is misplaced. (Mot. at 9 (citing EX2043, cls. 3-4, 9-10).) “[W]hile it is true that original claims are part of the original specification, that truism fails to address the question whether original claim language necessarily discloses the subject matter that it claims.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1349 (Fed. Cir. 2010) (internal citation omitted).

Here, Patent Owner points only to claim language in a pre-AIA provisional application and fails to identify any portion of that provisional’s specification that explains how the inventors achieved the “diameter of the spot is less than 1 mm” limitation. (Mot. at 9.) Because the earliest disclosure demonstrating possession of this limitation only appears in later-filed applications—beginning with Provisional Application No. 61/911,859 (filed December 4, 2013) (EX1107, pp.014:24-015:3), and subsequently repeated in the continuation-in-part application that issued as U.S. Patent No. 9,746,412 (filed November 26, 2014) (EX1070 (“’412 patent”), 9:46-60, 12:35-38, 12:39-44, 20:12-27, 20:34-37, 20:38-43, 20:56-21:4, 21:11-14, 21:15-20, 57:23-26, 58:11-13; *see also* Paper 2 (“Pet.”) at 17-18)—claims 14 and 18 are entitled, at best, to a post-AIA filing date. The ’107 patent is therefore PGR-eligible.

Patent Owner’s contention that claims 6 and 22 are entitled to pre-AIA priority because certain laser wavelengths were “well known” in the art fares no better. (Mot.

at 9-10 (citing MPEP § 2163).) While MPEP § 2163 recognizes that information well known in the art “need not be described in detail,” it simultaneously emphasizes that “sufficient information must be provided to show that the inventor had possession of the invention as claimed.” MPEP § 2163. The written description inquiry, therefore, does not turn on whether a feature was “well known.” *See Juno Therapeutics, Inc. v. Kite Pharma, Inc.*, 10 F.4th 1330, 1338 (Fed. Cir. 2021) (“Accordingly, testimony that scFvs were generally known in the field is insufficient to satisfy the written description requirement for the ’190 patent’s claims requiring scFvs that bind to a selected target.”); *cf. In re Xencor, Inc.*, 130 F.4th 1350, 1362 (Fed. Cir. 2025) (“A patentee cannot be permitted to use a Jepson claim to avoid the requirement that she be in possession of the claimed invention simply by asserting something is well-known in the art.”). It, instead, turns on “whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharms.*, 598 F.3d at 1351.

Here, even if a POSA could have selected the claimed laser colors, Patent Owner has still failed to identify disclosures showing that the inventors themselves possessed the claimed configuration at the relevant time. As explained in the Petition, the first disclosure of lasers configured to emit blue, yellow-green, violet, or ultraviolet light appears in the PCT application filed May 30, 2013—after the

AIA's effective date. (*See* Pet. at 18 (citing EX1071, p.009 (2:13-26)).)

Moreover, Patent Owner's attempt to cabin PGR eligibility to these two limitations is misplaced. Certain challenged claims recite that "the WDM is capable of detecting a substantially full spectrum of visible light." (EX1001, cls. 9, 29.) But the phrase "substantially full spectrum of visible light" appears for the first time in the *claims* of the '107 patent; it appears nowhere in the specification and it does not appear in earlier related applications, including the 2012 pre-AIA provisional applications. (EX1112, ¶68.) Because PGR eligibility turns on whether *any* challenged claim is entitled to a pre-AIA priority date, at least the claims reciting "substantially full spectrum of visible light" are not entitled to a pre-AIA priority date. *See Tricam*, PGR2021-00044, Paper 10 at 15.

III. DISCRETIONARY DENIAL UNDER *FINTIV* IS UNWARRANTED

As discussed below, the *Fintiv* factors weigh in favor of institution.

***Fintiv* factor 1 – whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.** *Fintiv* factor 1 is neutral because the district court has never considered a stay in the context of an instituted PGR.

Patent Owner's reliance on the district court's prior denial of a stay does not support discretionary denial under *Fintiv* factor 1. (Mot. at 10-12.) The court denied Petitioner's motion to stay, not because it categorically rejected the relevance of post-grant review proceedings, but because no PGR petitions had yet been filed at

the time the motion was decided. (EX2011 at 1-2.) The court’s denial, therefore, rested on the speculative nature of the PTAB proceedings, not on a determination that a stay would be inappropriate if a concrete, instituted PGR were before the Board.

That distinction matters. *Fintiv* factor 1 asks (in relevant part) whether evidence exists that a stay *may be* granted if a proceeding is instituted. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6-7 (PTAB Mar. 20, 2020) (“*Fintiv*”) (precedential). Here, the district court has never considered—much less rejected—a stay motion in the context of an instituted PGR. Instead, the court expressly relied on the absence of any filed PGRs and the resulting uncertainty as to whether PTAB review would occur at all. (EX2011 at 1-2.) Once that uncertainty is removed through institution, that rationale for denying a stay no longer applies.

Patent Owner’s reliance on *Samsung* and *10x Genomics* does not compel a different result. (Mot. at 11.) In both cases, the Board relied on district court reasoning that affirmatively indicated a renewed stay motion would be denied *even if* PTAB review were instituted. *See Samsung Elecs. Co. v. Cal. Inst. of Tech.*, IPR2023-00133, Paper 10 at 14 (PTAB May 4, 2023) (denying institution based on the district court’s express finding that (*inter alia*) a stay was “unlikely to simplify the issues in the underlying litigation”); *see also 10x Genomics, Inc. v. President & Fellows of Harvard Coll.*, IPR2023-01299, Paper 15 at 16 (PTAB Mar. 7, 2024)

(denying institution based on the district court's coordinated schedule with related cases and the lack of intent by either party to pursue a stay if trial was instituted).

None of these circumstances are present here. The district court never found that PGR proceedings would fail to simplify the issues for trial. (EX2011 at 1-2.) The district court also has no coordinated schedule with related cases, and Petitioner *does* intend to seek a stay if this PGR is instituted.

Patent Owner's reliance on *Courtesy Products* and *Micron* is also misplaced, as neither case holds that the presence of other asserted patents in parallel litigation precludes meaningful simplification from post-grant review. (Mot. at 11-12.) Although the court in *Courtesy Products* noted that the parties were competitors, the denial of a stay rested primarily on the fact that the accused infringer had previously licensed the asserted patents and paid royalties for years *before* invoking PTAB review. *Courtesy Prods., L.L.C. v. Hamilton Beach Brands, Inc.*, No. 13-2012, 2015 WL 5145526, at *2 (D. Del. Sep. 1, 2015). The court viewed the requested stay as disrupting settled commercial expectations and prolonging a dispute that had already been resolved by mutual agreement. *See id.* ("Finally, and perhaps most significantly, . . . Hamilton Beach is now using every procedural tool at its disposal to attempt to invalidate patents that it licensed for years."). No such licensing history or reliance interest exists here.

Nor is this case like *Micron*, where the district court necessarily would

proceed to trial on asserted claims not subject to PTAB review regardless of the outcome. *See President & Fellows of Harvard Coll. v. Micron Tech., Inc.*, No. 17-1729, 2018 WL 10337332, at *1 (D. Del. Jan. 8, 2018). Here, institution would directly address the '107 patent, which is asserted in the parallel litigation. Thus, even if other patents remain in the district court litigation, resolving validity issues for the '107 patent would materially simplify the proceeding.

Accordingly, while the district court previously denied a stay based on the absence of any filed or instituted post-grant proceedings, that decision does not demonstrate that a stay would be denied following institution here. And once this PGR is instituted, Petitioner's *Sotera* stipulation (which precludes Petitioner from pursuing overlapping §§ 102 and 103 invalidity grounds in the district court) would substantially reduce parallel litigation of validity issues, making a stay more likely to be granted. (*See* Paper 6.) *Fintiv* factor 1 is therefore neutral and does not support discretionary denial.

***Fintiv* factor 2 – proximity of the court's trial date to the Board's projected statutory deadline for a final written decision.** *Fintiv* factor 2 is neutral because the timing of the district court trial alone does not preclude meaningful PGR review.

Patent Owner argues that *Fintiv* factor 2 favors discretionary denial because the district court trial (August 2026) is scheduled before the projected statutory

deadline for a Final Written Decision (April 2027). (Mot. at 12.) While timing is a relevant consideration under *Fintiv* factor 2, the PTAB's recent guidance confirms that it is not dispositive and must be weighed holistically with other circumstances, including the strength of the merits and potential simplification of issues. (*See* EX1113); *Fintiv*, Paper 11 at 9. Here, the '107 PGR challenges claims beyond those asserted in the parallel district court litigation, meaning that institution would still materially advance review of this patent and resolve issues that would otherwise remain unaddressed at trial. (*Compare* EX2045 (showing Patent Owner's election of claims 5, 16, 18, 26, 27, and 29 in the district court litigation), *with* Pet. at 1 (requesting PGR of claims 1-3, 5-14, 16-18, 20-22, and 26-30).) In addition, as discussed further *infra* in the discussion of *Fintiv* factor 6, the merits of the PGR challenges are strong, further supporting exercise of discretion to institute. Accordingly, while the trial date precedes the projected Final Written Decision, *Fintiv* factor 2 should be treated as neutral rather than favoring discretionary denial.

***Fintiv* factor 3 – investment in the parallel proceeding by the court and the parties.** Even though the district court has invested in the parallel litigation, *Fintiv* factor 3 does not favor denial for two independent reasons.

First, Petitioner acted diligently and filed this PGR after it had sufficient clarity regarding the scope of Patent Owner's asserted claims. "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[.]” *Fintiv*, Paper 11 at 11. Here, Patent Owner’s initial complaint, filed August 14, 2024, only asserted U.S. Patent Nos. 10,330,582 (“’582”) and 11,703,443 (“’443”). (EX1025.) Patent Owner did not add U.S. Patent No. 12,174,106 (“’106”) and the ’107 patent until January 9, 2025. (EX1106.) On February 14, 2025, Patent Owner alleged infringement of 90 claims across four patents. (EX1019, p.005.) After months of dispute and multiple court orders directing claim narrowing (*see* EX1105, pp.201:12-204:10; EX1114, pp.012:2-016:23, 020:2-25, 024:1-025:1; *see also* EX1115), Petitioner filed the ’107 PGR on September 23, 2025, based on the best information reasonably available and well before the statutory deadline. (*See generally* Pet.) Petitioner’s filing, thus, reflects diligence, not delay, thereby rendering *Fintiv* factor 3 neutral. *See Intel Corp. v. VLSI Tech. LLC*, IPR2019-01192, Paper 15 at 12-13 (PTAB Jan. 9, 2020) (finding Petitioner was diligent in filing petition after narrowing of asserted claims).

Second, notwithstanding the investment to date, institution would not result in meaningful duplication of effort or inefficiency. As discussed further in connection with *Fintiv* factor 4, Petitioner’s *Sotera* stipulation substantially mitigates concerns regarding duplicative work or inconsistent decisions. (*See* Paper 6.) Under these circumstances, *Fintiv* factor 3 is neutral and does not support discretionary denial.

***Fintiv* factor 4 – overlap between issues raised in the petition and in the**

parallel proceeding. *Fintiv* factor 4 weighs against discretionary denial because Petitioner has provided a *Sotera* stipulation.

Although some overlap exists between the issues raised in this PGR and the parallel district court litigation, Petitioner’s timely *Sotera* stipulation alleviates these concerns. (*See* Paper 6.) As the Board has explained, a *Sotera* stipulation “mitigates any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions,” ensuring that post-grant review serves as a “true alternative” to district court litigation. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (“*Sotera*”) (precedential). Consistent with this precedent, the USPTO’s March 2025 guidance confirms that “a timely-filed *Sotera* stipulation . . . is highly relevant” (though not dispositive) to the *Fintiv* analysis. (EX1113, pp.002-003.)

Here, Petitioner stipulated that, if this PGR is instituted, it will not pursue in district court the specific grounds raised (or that reasonably could have been raised) under §§ 102 or 103 based on patents or printed publications, nor § 103 grounds combining other prior art with the same references relied upon in this PGR. (*See* Paper 6.) This stipulation meaningfully narrows the overlap between the two proceedings and ensures that the Board, not the district court, will be the forum to adjudicate the core prior-art-based invalidity challenges to the ’107 patent.

Patent Owner unconvincingly argues that overlap nevertheless remains

because Petitioner continues to assert system art- and § 112-based invalidity defenses in district court. (Mot. at 14-16.) But the Board has squarely rejected the notion that the presence of system art in district court undermines the significance of a *Sotera* stipulation. *See Nikon Corp. v. Optimum Imaging Techs., LLC*, IPR2024-01372, Paper 17 at 22-23 (PTAB Apr. 23, 2025) (“[W]e see nothing in the *Sotera* decision that suggests that the impact of a *Sotera* stipulation is weakened or undermined by the assertion of system art in district court[.]”). And overlap of § 112 issues is inherent in any PGR and does not, standing alone, justify discretionary denial. *See Intel*, IPR2019-01192, Paper 15 at 11 (recognizing that the relevant inquiry is whether institution would lead to inefficient duplication, not whether *any* overlap exists).

At most, this case presents partial, not complete, overlap, which the Board has found insufficient to justify discretionary denial where a *Sotera* stipulation meaningfully cabins duplicative adjudication. *See, e.g., Sotera*, Paper 12 at 19. Accordingly, *Fintiv* factor 4 weighs against exercising discretion to deny institution.

***Fintiv* factor 5 – whether the petitioner and the defendant in the parallel proceeding are the same party.** *Fintiv* factor 5 is, at most, neutral. While the parties are the same in the parallel litigation, the Board has recognized that this factor is not dispositive and must be weighed in the context of the overall *Fintiv* analysis. *See, e.g., Fintiv*, Paper 11 at 6.

***Fintiv* factor 6 – other circumstances that impact the Board’s exercise of discretion, including the merits.** *Fintiv* factor 6 favors institution because the Petition presents compelling evidence that the Challenged Claims are unpatentable. (See generally Pet.; see also EX1002.)

As discussed *supra*, the ’107 patent is PGR-eligible for multiple independent reasons (see Section II), contrary to Patent Owner’s arguments. (Mot. at 16-17.) The ’107 patent expressly teaches that WDM techniques from optical communications are “readily adapted for fluorescence light detection” (EX1001, 4:65-67), refuting Patent Owner’s analogous-art argument and confirming that Goodman is properly combined with Chandler and Oostman. (Mot. at 16.) Patent Owner’s contention that the Petition lacks motivation to combine is likewise incorrect (*id.*), as the Petition identifies multiple independent motivations grounded in the prior art—consistent with Chandler’s stated design goals and Goodman’s express teachings regarding ease of integration, scalability, and fabrication. (Pet. at 47-50.) Nor does Oostman teach away from a zig-zag WDM configuration (Mot. at 16-17); at most, it describes alternative layouts (EX1005, 7:32-36), which is legally insufficient to negate motivation to combine. See *Santarus, Inc. v. Par Pharm., Inc.*, 694 F.3d 1344, 1356 (Fed. Cir. 2012) (“A statement that a particular combination is not a preferred embodiment does not teach away absent clear discouragement of that combination.” (citation omitted)). Patent Owner’s conclusory assertion that Petitioner’s § 112

grounds are “weak” further provides no basis for discretionary denial. (Mot. at 17.)

Patent Owner’s assertion that the Petition “backfills gaps” through unsupported expert opinion also fails. (Mot. at 18-19.) Dr. Ilkov’s testimony is firmly anchored in the disclosures of the prior art itself and reflects predictable engineering tradeoffs and known design alternatives, not hindsight reconstruction. (EX1002, ¶167 (citing EX1051 (Chandler), 7:1-6, 3:51-55); EX1002, ¶169 (citing EX1016 (Goodman) at 3:48-67); EX1002, ¶¶171, 262.)

Separately, Patent Owner’s assertion that Petitioner’s Search Disclosure Declaration (“SDD”) should be ignored is incorrect. (Mot. at 17-18.) As the PTAB guidance (Nov. 17, 2025) explains, “[t]he voluntary submission of an SDD will be considered as a non-exclusive, non-dispositive favorable discretionary factor supporting institution, particularly where the SDD reveals new or underutilized pathways relevant to Office search practice.” (EX1116, p.002.) While some references in the Petition were previously considered during prosecution, the SDD documents Petitioner’s systematic search methodology and diligence, which the Office recognizes as favorable. (*Id.*) Submission of the SDD, therefore, supports institution.

Lastly, as discussed more fulsomely *infra* in Section IV.B, Patent Owner is wrong—material error warrants USPTO intervention. (Mot. at 17-18.)

IV. DISCRETIONARY DENIAL UNDER § 325(D) 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 that were never presented to the Examiner, 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 ’107 Patent

Becton, Dickinson factors (a) and (c) weigh against discretionary denial, given the absence of any substantive evaluation during prosecution of the asserted combination of references in Grounds 8 and 9. *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17-18 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) (“*Becton, Dickinson*”).

Regarding Grounds 8 and 9, “because [Chandler] was not presented in combination with the other references asserted here...the combination of references asserted in the Petition do not qualify as art that was ‘previously presented’ to the Office.” *Samsung Elecs. Co. v. Netlist, Inc.*, IPR2022-00063, Paper 13 at 13-14 (PTAB May 5, 2022). Here, Chandler was never before the Examiner during prosecution and was never cited on the face of the ’107 patent. (See EX1001, pp.001-

004; *see also* EX1003 (no mention of Chandler in the prosecution history.) Patent Owner does not dispute this fact. (*See generally* Mot. at 19-20.) Thus, the asserted Ground 8 and 9 combinations that include Chandler fail *Advanced Bionics* step one, and the Board need not proceed to *Advanced Bionics* step two.¹

2. Chandler Is Not Cumulative of Any Reference Considered During Prosecution of the '107 Patent

Becton, Dickinson factor (b) also weighs against discretionary denial because Chandler is not cumulative of Roth-131 or Frazier.

Patent Owner's sole theory of cumulateness—that all three references mention avalanche photodiodes (“APDs”)—fails as a matter of law. (*See* Mot. at 20 & n.8.) Overlap in general subject matter is insufficient under § 325(d); the inquiry requires a fact-specific comparison of the structure and purpose of the references. *See Oticon Med. AB v. Cochlear Ltd.*, IPR2019-00975, Paper 15 at 15-16 (PTAB Oct. 16, 2019) (“*Oticon*”) (precedential). Here, the Petition relies on Chandler not merely for the presence of APDs, but for its disclosure of an integrated filtering,

¹ To the extent the Office considers Goodman and Frazier to satisfy *Advanced Bionics* step one because Patent Owner cited these references in an IDS containing hundreds of other references (*see* EX1003, pp.254, 257) which the Examiner stated received “only the most cursory” review, as discussed further in Section IV.B, the combination presented in Grounds 10 and 11 still fails *Advanced Bionics* step two.

amplification, and digital conversion (“FADC”) unit, in which APDs are structurally incorporated and arranged in a circular configuration. (Pet. at 41 (citing EX1051, 4:62-5:4, 5:23-33, 7:24-45, 7:46-54, FIG. 4).) By contrast, Roth-131 and Frazier disclose APDs as standalone, linearly arranged detectors. (See EX1045, FIG. 1, FIG. 2; *id.*, 7:52-8:14, 11:54-67; *see also* EX1009, FIG. 1.) Chandler’s APDs are also designed to *amplify* detected signals, whereas Roth-131’s APDs merely *generate* signals representing fluorescence intensity. (EX1051, 8:34-36; EX1045, 7:60-63, 8:4-6.) These structural and functional differences preclude any finding that Chandler is cumulative. *See Oticon*, IPR2019-00975, Paper 15 at 15.

Patent Owner’s remaining cumulativeness arguments fare no better. (Mot. at 20.) Common assignment to Luminex is legally irrelevant under *Advanced Bionics*. *See Geotab USA, Inc. v. Omega Pats., LLC*, IPR2023-00504, Paper 11 at 16 (PTAB July 25, 2023). Nor does an expert’s assertion that Roth-131 is “embodied in” certain products transform Roth-131 into Chandler or obviate the required reference-by-reference comparison. And Patent Owner’s conclusory claim that the Examiner “already evaluated” § 112 support cannot invoke § 325(d), where—undisputedly—the Examiner issued no § 112 rejections and never considered the specific written

description and enablement deficiencies raised in Grounds 1-7.² *See Beigene USA, Inc. v. Pharmacyclics LLC*, PGR2024-00009, 2024 WL 1915139, at *17-18 (PTAB May 1, 2024). Finally, MPEP § 2163 merely describes an Examiner’s general obligations; it does not establish substantive consideration of the issues presented here. Accordingly, § 325(d) does not apply.

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

Although the Director need not reach *Advanced Bionics* step two, it independently weighs against discretionary denial. The Examiner materially erred by overlooking and failing to reject the claims over the Chandler-based combinations (Grounds 8-9) and the Oostman-based combinations (Grounds 10-11). *See Advanced Bionics*, Paper 6 at 8 n.9, 10. Neither Chandler nor the Oostman-based combinations formed the basis for any rejection during prosecution. (*See generally* EX1003.) Accordingly, *Becton, Dickinson* factor (c) weighs against denial.

As detailed in the Petition, Goodman alone discloses the precise limitation the Examiner identified as absent from the prior art: “wherein each of the mirrors in the array of mirrors is configured to: receive light reflected by a filter in the array of filters; and reflect light to another filter in the array of filters[.]” (EX1003,

² Notably, the Examiner never issued *any* rejections during prosecution of the ’107 patent. (*See generally* EX1003.)

p.244.) Goodman expressly discloses this limitation, supplying the same teaching across Grounds 8-11. (*See* Pet. at 61-63 (Ground 8), 85 (Ground 9), 94 (Ground 10), 105 (Ground 11).) Goodman explains that its “reflectors are positioned opposite from the wavelength selective elements such that each of the reflectors, as part of an imaging relay system, directs the beam of optical energy from one wavelength selective filter to an adjacent wavelength selective filter.” (Pet. at 61-62 (citing Goodman, 4:53-58, 4:60-62, 9:61-65).) As the Petition explains, a POSA would have understood that directing light between adjacent filters necessarily requires each reflector to perform both the “receive” and “reflect” functions recited in the claims, a relay operation repeated across the array. (Pet. at 61-63 (citing EX1002, ¶¶188-191).) Because Goodman expressly teaches the very feature relied upon for allowance, the Examiner overlooked or misapprehended its disclosure, constituting material error under *Becton, Dickinson* factor (e). *See Aylo Freesites Ltd. v. Dish Techs. L.L.C.*, IPR2024-00940, Paper 12 at 34-35 (PTAB Nov. 21, 2024) (“It is difficult to characterize error in a nearly silent record, and we find that Petitioner has sufficiently demonstrated error based in part on its unpatentability contentions.”).

Becton, Dickinson factor (f) likewise weighs against denial. During prosecution, Patent Owner submitted an IDS spanning hundreds of references during the prosecution of the '107 patent (EX1003, pp.102-118), after having done the same years earlier in the prosecution of U.S. Patent No. 9,746,412

(“the ’412 patent”)—the parent from which the challenged ’107 patent descends (EX1117, pp.002-011.) In that earlier prosecution, the Examiner expressly warned that, due to the unusually large number of references and lack of applicant guidance, “**only the most cursory review**” was possible unless Patent Owner identified references warranting “higher degree” consideration. (EX1117, p.046 (emphasis added).) Patent Owner never did so: not then, and not during the ’107 prosecution.

Under *Ecto World*, such circumstances fail to satisfy *Becton, Dickinson* factor (f) because they directly undermine any inference that the Examiner meaningfully considered Goodman or Frazier merely because they appear on the ’107 patent application’s IDS. *Ecto World, LLC v. Rai Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 6-7 (Dir. Dec. May 19, 2025) (precedential). Absent any meaningful consideration of Goodman or Frazier, the Petition presents “additional evidence and facts [that] warrant reconsideration of the prior art or arguments.” *Becton, Dickinson*, Paper 8 at 18.

Dr. Ilkov’s expert declaration provides an independent reason why, under *Becton Dickinson* factor (f), the Board should reconsider whether the asserted prior art renders the ’107 patent’s claims obvious. (See generally EX1002.) Under *BMW v. Foras*, new prior art combinations and expert support weigh strongly against § 325(d) denial. *BMW of N. Am., LLC v. Foras Techs., Ltd.*, IPR2024-01346, Paper

7 at 20-21 (PTAB Mar. 7, 2025) (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). And under *Therabody*, the presence of expert analysis unavailable during prosecution further reinforces that institution is appropriate. *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); *see also Sci. Design Co. v. Shell Oil Co.*, IPR2021-01537, Paper 7 at 25 (PTAB Mar. 18, 2022) (“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.”).

The Examiner, thus, erred under *Advanced Bionics* step two because he never evaluated the asserted art or the Petition’s prior art combinations, overlooked material teachings in the asserted references, as discussed above, and was impeded by Patent Owner’s own mega-IDS filings. The Board should not exercise discretion to deny institution under § 325(d) because the Petition’s new prior art combinations and expert evidence warrant reconsideration.

V. CONCLUSION

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

Dated: January 2, 2026

Respectfully submitted,

COOLEY LLP
ATTN: Patent Group
1299 Pennsylvania Avenue NW
Suite 700
Washington, DC 20004
Tel: (703) 456-8647
Fax: (703) 456-8100

By: /Joseph Van Tassel /
Joseph Van Tassel
Reg. No. 74,136
Counsel for Petitioner

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 exhibits (Nos. 1112-1117) are being served via electronic mail on the 2nd day of January, 2025, upon Patent Owner's counsel as follows:

Alexis Cohen	Alexis.Cohen@wilmerhale.com
Laura Macro	Laura.Macro@wilmerhale.com
Omar Khan	Omar.Khan@wilmerhale.com
Akkad Moussa	Akkad.Moussa@wilmerhale.com
Jeffrey Dennhardt	Jeffrey.Dennhardt@wilmerhale.com
Jennifer Graber	Jennifer.Graber@wilmerhale.com
Patrick Nyman	Patrick.Nyman@wilmerhale.com

DATED: January 2, 2026

/ Joseph Van Tassel /
Joseph Van Tassel
Reg. No. 74,136
COOLEY LLP
1299 Pennsylvania Ave. NW,
Suite 700
Washington, D.C. 20004
Tel: (202) 776-2066