

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

BECKMAN COULTER, INC.,	)	
	)	
Plaintiffs,	)	
	)	
v.	)	C.A. No. 24-945-CFC-EGT
	)	
CYTEK BIOSCIENCES, INC.,	)	PUBLIC VERSION
	)	
Defendant.	)	

**PLAINTIFF BECKMAN COULTER, INC.'S LETTER TO THE HONORABLE
ELEANOR G. TENNYSON REGARDING DISCOVERY DISPUTE**

OF COUNSEL:

Omar A. Khan
Jeffrey Dennhardt
Lauren E. Matlock-Colangelo
WILMER CUTLER PICKERING HALE
AND DORR LLP
7 World Trade Center
250 Greenwich Street
New York, NY 10007
(212) 230-8800

Asher S. McGuffin
WILMER CUTLER PICKERING HALE
AND DORR LLP
60 State Street
Boston, MA 02109
(617) 526-6000

March 18, 2025

RICHARDS, LAYTON & FINGER P.A.
Frederick L. Cottrell III (#2555)
Kelly E. Farnan (#4395)
Christine D. Haynes (#4697)
One Rodney Square
920 North King Street
Wilmington, Delaware 19801
(302) 651-7700
cottrell@rlf.com
farnan@rlf.com
haynes@rlf.com

*Attorneys for Plaintiff
Beckman Coulter, Inc.*

Dear Judge Tennyson:

The parties have already agreed that the case should be narrowed in due course, with limits on elected claims and defenses. (Def. Ex. A.) But Defendant takes the extreme and unreasonable position that Plaintiff should be forced to narrow its claims by more than half *before* Defendant discloses *anything* about its invalidity or non-infringement theories. At the same time, Defendant seeks to preserve an unlimited number of invalidity grounds until after a *Markman* ruling and more than 100 grounds through summary judgment. The correct approach—and this Court’s routine practice—is the middle ground (as Plaintiffs proposes) of reciprocal narrowing of claims and defenses, beginning after the parties exchange contentions. The Court should adopt Plaintiff’s proposal to voluntarily dismiss all but 42 claims after contentions and all but 22 after *Markman*; Defendant should be limited to 8 invalidity grounds pre-*Markman* and 3 grounds after. D.I. 61-1.

Factual Background. The agreed Scheduling Order, and (as Defendant does not dispute) each of the six drafts the parties exchanged before filing, expressly permitted Plaintiff to amend its complaint without leave. D.I. 25 ¶ 8; Exs. 1-5. Thus, Plaintiff amended to add two new patents (in the same family as the original two patents), less than three weeks after the new patents issued. Within days of receiving Defendant’s core technical document production, Plaintiff pointed out various systemic and pervasive deficiencies in that production.¹ Nevertheless, Plaintiff reserved its rights and timely served infringement contentions showing Defendant infringes 90 claims across the four asserted patents. Defendant has not substantively responded to Plaintiff’s interrogatories, including those seeking non-infringement contentions. Ex. 6. Nor has Defendant provided invalidity contentions, which are due on April 21, 2025. D.I. 60 at 2-3.

Claim Narrowing Should Begin After Contentions. There appears to be no serious dispute that Plaintiff lacks sufficient information to meaningfully assess whether the asserted claims present distinct questions of non-infringement, invalidity, and damages. Requiring Plaintiff to substantially narrow claims at this early stage—without the benefit of routine discovery and contentions—would unfairly force Plaintiff to blindly dismiss infringed claims that presumptively have different scope. *Wenger Mfg. v. Coating Mach. Sys.*, 239 F.3d 1225, 1233 (Fed. Cir. 2001). The Federal Circuit warned that early claim narrowing may violate due process and “deny[] the plaintiff the opportunity to determine whether particular claims might raise separate issues of infringement or invalidity *in light of the defendants’ accused products and proposed defenses.*” *In re Katz*, 639 F.3d 1303, 1312–13 n.9 (Fed. Cir. 2011). That is precisely what will happen under Defendant’s proposal, which would force Plaintiff to halve the number of claims *before* Defendant serves invalidity contentions and *before* Defendant substantively responds to Plaintiff’s written discovery. Ex. 6. Moreover, there remain serious gaps in Defendant’s core technical document production, which must be addressed before Plaintiff can reasonably narrow its claims.

Accordingly, claim narrowing should begin only *after* Defendant serves its invalidity contentions, completes its core technical production, and responds to key interrogatories (such as the one seeking non-infringement contentions). Defendant’s invalidity contentions and related production are due on April 21 (D.I. 55), and the parties also are negotiating supplemental core technical document production(s) from Defendant and a date for mutual supplementation to certain interrogatory responses. Plaintiff should be permitted time to analyze that discovery so it can make

¹ The parties continue to meet-and-confer over the sufficiency of the core technical production.

an informed claim election four weeks later, on May 19.

Contrary to Defendant's assertions, the "[Delaware] Court's typical procedure is to allow for a first cut-down of asserted claims and ... [invalidity] defenses *after initial contentions are completed*" to ensure "a full and fair opportunity to understand the case before eliminating claims and defenses." *Collegium v. Teva*, No. 18-300-LPS (D. Del. Aug. 6, 2018) (Ex. 7) (emphasis added); *see also, e.g., MQ Gaming v. LEGO*, No. 19-905-MN, D.I. 29 (D. Del. Jan. 13, 2020) (Ex. 8) (denying motion to narrow before contentions); *Sysmex v. Beckman Coulter*, No. 19-1642-GBW, D.I. 40 (D. Del. Feb. 11, 2020) (Ex. 9) (denying motion to narrow before *Markman*); *Ravgen v. Ariosa*, No. 20-1646-JLH, D.I. 269 (D. Del. Aug. 18, 2023) (Ex. 10) (same); *VLSI v. Intel*, No. 18-966-CFC, D.I. 40 at 2 (D. Del. Nov. 1, 2018) (Ex. 11) (narrowing after contentions); *MG FreeSites v. Scorpcast*, No. 20-1012-CFC, D.I. 93 (D. Del. Dec. 27, 2021) (Ex. 12) (same); *Align v. 3Shape*, No. 18-1949-LPS, D.I. 223 (D. Del. Feb. 19, 2021) (Ex. 13) (same); *PureWick v. Sage*, No. 19-1508-MN, D.I. 89 (D. Del. Oct. 28, 2020) (Ex. 14) (same); *EMC v. Pure Storage*, No. 13-1985-RGA, D.I. 66 (D. Del. Sept. 19, 2014) (Ex. 15) (same). This Court has held that letting plaintiffs "meaningfully consider [Defendant's] invalidity contentions prior to narrowing" will "minimize the prejudice ... that would result if Plaintiffs were forced to narrow ... without the benefit of that knowledge." *Integra v. Hyperbranch*, 223 F. Supp. 3d 202, 204 (D. Del. 2016).

Defendant's arguments to the contrary should be rejected. *First*, Defendant cherry-picks two cases where plaintiffs narrowed before contentions. Neither case explains why narrowing occurred at that time, and neither suggested narrowing before contentions was necessarily the proper approach. In *Deere*, the scheduling order did not explain why the Court departed from its usual timing for narrowing. In *Sensormatic*, the timing of narrowing was undisputed, so the Court did not consider the issue. And in *VLSI*, claim narrowing began *after* contentions, not before. No. 18-966-CFC, D.I. 40 at 2. Thus, the weight of authority favors the "typical procedure" of narrowing after contentions, which "minimize[s] ... prejudice," as discussed above. *Collegium* (Ex. 7); *Integra*, 223 F. Supp. 3d at 204.

Second, Defendant suggests it is inequitable for it to prepare invalidity contentions before Plaintiff narrows. Not so. It is common for Delaware defendants to provide contentions and constructions on more than 40 claims—or even more than 100 claims—before Plaintiff narrows its claims. *See Collegium* (Ex. 7) (100 claims); *State Farm v. Amazon*, No. 22-1447-CJB, D.I. 32, 34 (D. Del. Mar. 14, 2023) (Ex. 16) (151 claims); *MG FreeSites*, D.I. 44 at 5, 93 (Ex. 12) (107 claims); *BD v. NeuMoDx*, No. 19-1126-LPS, D.I. 108 (D. Del. Nov. 24, 2020) (120 claims was "more reasonable ... than an arbitrary reduction to 40 asserted claims at this relatively early stage") (Ex. 17); *3Shape* (Ex. 13) (101 claims); *MQ Gaming*, D.I. 22, 29 at 1 (Ex. 8) (80 claims). *Katz* does not support a lower limit. While the *Katz* court ordered the plaintiff to select 40 *dependent* claims, *Katz*'s contentions also included every parent claim, so "almost 100 claims" were asserted. 639 F.3d at 1312. Narrowing *after* contentions is the equitable approach because both parties will narrow on a level playing field, each with the benefit of the other's contentions and discovery.² Instead of forcing Plaintiff to blindly and arbitrarily elect claims, the Court should follow its typical practice that avoids prejudice—initial narrowing after contentions.

Defendant Should Be Limited in the Number of Invalidity Grounds. Despite

² The Court should disregard Defendant's vague complaint about IPR efficiency, as Plaintiff's proposal includes narrowing before Defendant's August IPR bar date. 35 U.S.C. § 315(b).

demanding substantial limits on asserted claims, Defendant seeks the opposite for itself, demanding *no limit* on pre-*Markman* invalidity grounds.³ Defendant seeks the benefit of substantial discovery—including a claim construction ruling—before narrowing its grounds, while at the same time seeking the exact opposite for Plaintiff. But Plaintiff should not be left to guess at the grounds on which Defendant may rely. Just as Plaintiff must reasonably narrow its claims, so too should Defendant narrow its grounds. Even after *Markman*, Defendant seeks to maintain 7 invalidity grounds per claim, totaling over 100 grounds, far more than can reasonably be addressed in expert discovery or at summary judgment. Typically, this Court limits defendants to 3 or fewer grounds per claim post-*Markman*. *E.g.*, *Tonal v. iFIT*, No. 20-1197-GBW, D.I. 59 (D. Del. Feb. 15, 2022) (Ex. 18) (2.5 per claim); *XMTT v. Intel*, No. 18-1810-RGA, D.I. 203 (D. Del. Nov. 22, 2021) (Ex. 19) (1 per claim); *Broadsoft v. Callwave*, No. 13-711-RGA, D.I. 219 (D. Del. Sept. 8, 2015) (Ex. 20) (~1 per claim); *3Shape* (Ex. 13) (2 per claim); *CAO Lighting v. GE.*, No. 20-681-MN (D. Del. Aug. 18, 2022) (Ex. 21) (~1.5 per claim); *Confluent v. HyperBranch*, No. 17-688-LPS (D. Del. Oct. 30, 2017) (Ex. 22) (3 per claim). Plaintiff's proposal provides Defendant ample grounds both pre- and post-*Markman* and should be adopted.

Defendant's arguments are without merit. *First*, Defendant contends it should not be limited pre-*Markman* because Plaintiff identified alternative priority dates. This is a red herring. Across 5 meet-and-confers and in its letter brief to the Court, Defendant has not identified a single prior art reference impacted by the alternative dates [REDACTED]. There is no evidence Plaintiff's alternative priority dates impact invalidity grounds at all; nor is there any reason to believe that Plaintiff's proposal does not reasonably account for such impact (if any). *Second*, Defendant cites the same cherry-picked cases, even though grounds limits were not disputed in either. *Deere*, No. 18-827-CFC, D.I. 72; *Sensormatic*, No. 19-1543-CFC, D.I. 16. There is no reason why Defendant needs to preserve unlimited grounds pre-*Markman*; and expert discovery and summary judgment cannot and should not entail over 100 invalidity grounds.

22 Claims Post-*Markman* Is Reasonable. At the conclusion of the meet-confer process, the parties were only 4 claims apart—25 claims (Plaintiff) versus 18 claims (Defendant). Plaintiff then offered a middle-of-the-road compromise of 22 claims, a 50% reduction from the agreed 42-claim pre-*Markman* limit. Ex. 23 at 10. In response, Defendant rejected that proposal, withdrew its 18-claim offer, reverted to its initial 15-claim proposal, and essentially declared an impasse. Defendant should not be rewarded for refusing to compromise.

Defendant does not explain why it rejected the 22-claim compromise or why 22 claims is prejudicial or “unwieldy.” There is no reason Defendant cannot litigate 22 claims (instead of 15 or 18) during expert discovery. This Court commonly allows parties to assert over 22 claims post-*Markman*. *See, e.g.*, *Collegium*, No. 18-300-LPS (Ex. 7) (33 claims); *NeuMoDx*, No. 19-1126-LPS, D.I. 292 at 4 (52 claims); *MQ Gaming*, No. 19-905-MN, D.I. 59 at 2, 60 (40 claims); *3Shape*, No. 18-1949-LPS, D.I. 223 (60 claims); *Journey v. Padagis*, No. 20-1413-CFC, D.I. 75 (D. Del. Jan. 27, 2022) (Ex. 24) (24 claims). And, as both parties acknowledge, there will be further narrowing before trial. Here, too, Defendant cherry-picks cases where the Court set a slightly lower post-*Markman* claim limit, but it does not and cannot identify any rule requiring fewer than 22 claims or any reason why that number is unfairly prejudicial. The Court should adopt Plaintiff's 22-claim compromise, which reasonably permits Plaintiff to adjudicate likely unique infringement issues across the four asserted patents.

³ “Ground” should mean what the Court defined as “prior art argument” in *Confluent* (Ex. 22).

Respectfully,

/s/ Frederick L. Cottrell, III

Frederick L. Cottrell, III (#2555)

Attachments

cc: All Counsel of Record (by CM/ECF and email)