

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. 12,174,106
Case No. PGR2025-00084

**PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION OF
DISCRETIONARY DENIAL**

Petitioner's discretionary denial opposition (Paper 15 ("Opposition")), for the first time, raises two baseless arguments: (1) that the "side-scatter" limitation in unchallenged claims makes the '106 patent PGR-eligible (Opposition at 3-4); and (2) that it is "prosecution gamesmanship" to file a continuation application from a divisional application (*id.* at 17-19). These efforts do not justify the USPTO wasting its resources on this proceeding.

I. The "Side-Scatter" Limitation in Unchallenged Claims Does Not Make This Proceeding PGR-Eligible

Petitioner admits that "the Petition presents *two* independent § 112 defects affecting the '106 patent's PGR-eligibility: one involving the 'curved mirror' limitation ... and another involving 'the semiconductor detector' limitation" (Opposition at 2) (emphasis added). As previously explained, these arguments have no basis, the former of which has already been rejected by the USPTO. Paper 6 at 9-12. Petitioner's Opposition now resorts to a third argument for PGR-eligibility involving side-scatter light.¹ *Id.* at 3-4. This additional argument lacks merit.

Petitioner concedes that "pre-AIA priority applications describe optical

¹ Petitioner incorrectly cites *unchallenged* claims 9 and 20 to say that "[c]ertain challenged claims" require that the "collecting optical element" be "configured to collect and focus *side-scatter* light." Opposition at 4.

components capable of collecting fluorescent or scattered light.” *Id.* at 3 (citing E1109 at [0017]); *see also, e.g.*, EX1110 at [0004], [0006], [0008], [0017], [0018]. Pre-AIA priority applications further disclose measuring scattered light and depict the scattered light profile. *E.g.*, EX1110 at [0011], [0013], [0017], [0018], [0019], FIGs. 3-5. These passages and figures disclose both forward- and side-scatter detectors to measure the scattered light, as demonstrated in the depicted time profiles. These applications also explain the importance of minimizing scattered light. *E.g., id.* at [0004], [0015]. Side-scatter detectors were also routinely used in flow cytometers by that time. *See, e.g.*, EX2029 at 276-278 (describing measuring side-scatter dating back to 1975); EX2043 at [0004] (citing EX2029). Pre-AIA priority applications thus support the “side-scatter” limitation, which cannot confer PGR-eligibility to this proceeding. *See Fox Factory, Inc. v. SRAM, LLC*, PGR2016-00043, Paper No. 9, 13 (PTAB Apr. 3, 2017) (denying institution where petitioner failed to show claim was “not entitled to the filing date of the” priority application).

II. Petitioner's Gamesmanship Arguments Are Incorrect and Irrelevant

Petitioner contends that filing the '106 patent as a continuation of a divisional patent constitutes “prosecution gamesmanship.” *See* Opposition at 17-19. Petitioner's argument is misplaced. A patent is *not* invalid simply based on the type of application from which it depends. *See* MPEP §§ 201.06, 201.07 (continuation

applications may be filed from any prior nonprovisional application (including a divisional), provided the disclosure remains the same and the parent is co-pending). There was nothing improper about the prosecution of the '106 patent, which had overlapping classifications as the '412 patent. *Compare* EX1003 *with* EX1070.

Petitioner's cited cases (Opposition at 19) do not hold otherwise. Rather, these cases concern whether a patent maintains consonance to get the benefit of 35 U.S.C. § 121's safe harbor to protect the patent from obviousness type double-patenting ("OTDP"). *See Symbol Techs., Inc. v. Opticon, Inc.*, 935 F.2d 1569, 1579 (Fed. Cir. 1991) (continuation of a divisional application entitled to benefit of the safe harbor provision because consonance was maintained); *Gerber Garment Tech., Inc. v. Lectra Sys., Inc.*, 916 F.2d 683, 688 (Fed. Cir. 1990) (continuation invalid for OTDP because the claims were not consonant); *St. Jude Med., Inc. v. Access Closure, Inc.*, 729 F.3d 1369, 1380 (Fed. Cir. 2013) (safe harbor provision did not apply).

Petitioner does not (because it cannot) raise obviousness-type double patenting arguments in a PGR. *See* 35 U.S.C. § 321(b). Tellingly, Petitioner did not preserve an OTDP validity challenge in the district court either. Thus, the PGR should still be discretionarily denied.

Respectfully submitted,

Dated: January 12, 2026

/Alexis R. Cohen/
Alexis R. Cohen (Reg. No. 76,998)

CERTIFICATE OF SERVICE

I hereby certify that on January 12, 2026, I caused a true and correct copy of the following materials:

- Patent Owner's Discretionary Denial Reply

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