

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. PGR2025-00084
U.S. Patent No. 12,174,106 B2
Issue Date: December 24, 2024

Title: FLOW CYTOMETER

**PETITIONER'S SUR-REPLY TO PATENT OWNER'S REPLY IN
SUPPORT OF REQUEST FOR DISCRETIONARY DENIAL**

This sur-reply: (a) addresses Patent Owner’s mischaracterization of Petitioner’s PGR-eligibility and prosecution gamesmanship arguments (Paper 18 (“Reply”)), and (b) explains why neither support discretionary denial.

I. The “Side-Scatter” Limitation Independently Makes this Proceeding PGR-Eligible Under *Tricam*

Petitioner is not advancing a new § 112 theory involving side scatter light. (Reply at 1.) Rather, Petitioner is responding to Patent Owner’s own attempt to cabin the PGR-eligibility inquiry to two select claim limitations by identifying an additional, independent limitation—collection and focusing of side-scatter light—that independently defeats pre-AIA priority. (Paper 6 at 9-12.) *Tricam* allows this. *See Tricam Indus., Inc. v. Little Giant Ladder Sys., LLC*, PGR2021-00044, Paper 10 at 15 (PTAB Aug. 3, 2021) (“[PGR-eligibility] depends on whether the Petition shows that the patent *contains or contained at any time* a claim that lacks written description and enabling support in a priority application filed before March 16, 2013.”¹ (emphasis added)). Thus, Petitioner’s PGR-eligibility arguments are proper.

The remainder of Patent Owner’s argument rests on the faulty premise that

¹ *Tricam* also makes clear that PGR eligibility does not turn on whether a particular claim is challenged, contrary to Patent Owner’s argument. (Reply at 1 n.1.)

general disclosures of “scatter” or “fluorescence” light collection support the claim limitation requiring that “the collecting optical element is further configured to collect and focus side-scatter light.” (Reply at 1-2; EX1001, cls. 9, 20.) They do not. The pre-AIA application Patent Owner cites discloses optical systems that collect *scatter* and *fluorescence* emission—not *side-scatter* light, as claimed. (See Reply at 2 (citing EX1110, ¶¶4, 6, 8, 11, 13, 15, 17-19).) Likewise, the textbooks Patent Owner cites merely establish background scientific knowledge of side-scatter light—not possession of a specific optical element configured to collect and focus it, as claimed. (Reply at 2 (citing EX2029, EX2043).)

By contrast, the first disclosure that expressly describes side-scattered light and optical elements configured to collect it appears in Provisional Application No. 61/911,859, filed December 4, 2013. (See EX1111, 83:1-13.) That disclosure, therefore, independently defeats pre-AIA priority under *Tricam*, thereby rendering the '106 patent PGR-eligible. See *Tricam*, Paper 10 at 15.

II. Patent Owner’s Strawman Arguments Do Not Undermine the Prosecution Gamesmanship Evidence Supporting Institution

Patent Owner mischaracterizes Petitioner’s prosecution gamesmanship arguments as a per se attack on continuation practice. (Reply at 2-3.) They are not. Instead, Petitioner relies on the '106 patent’s prosecution history to show that this patent only issued because Patent Owner disregarded the restriction requirement’s

line of demarcation, thereby providing an independent, equitable basis for institution. (Paper 15 (“Opp’n”) at 17-19.) The MPEP sections cited by Patent Owner merely describe when continuations may be filed procedurally; they do not authorize the misuse of continuation practice to evade PGR. (Reply at 2-3.)

Patent Owner’s attempt to reframe Petitioner’s argument as an impermissible OTDP challenge fares no better. (*Id.* at 3.) Petitioner’s cited cases illustrate the settled principle that, once a restriction requirement issues, an applicant must maintain consonance with the examiner-defined invention groupings and may not later claim subject matter from a different restricted group through continuation practice. (Opp’n at 18-19.) That principle is relevant here not to assert OTDP, but to demonstrate that Patent Owner’s effort to claim WDM subject matter via a continuation of a divisional restricted to sheath-flow methods is inconsistent with the prosecution framework Patent Owner accepted. That inconsistency bears directly on the equities underlying discretionary denial and PGR eligibility. Patent Owner’s characterization of this argument as a prohibited OTDP challenge is, therefore, a strawman.

III. Conclusion

For these reasons, Patent Owner’s Reply fails to rebut Petitioner’s showing that institution is warranted.

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

Respectfully submitted,

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 **PETITIONER’S SUR-REPLY TO PATENT OWNER’S REPLY IN SUPPORT OF REQUEST FOR DISCRETIONARY DENIAL** to be served via electronic mail on the 14th day of January, 2026, upon Patent Owner’s counsel as follows:

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

DATED: January 14, 2026

/Joseph Van Tassel/
Joseph Van Tassel
Reg. No. 74,136
COOLEY LLP
1299 Pennsylvania Ave. NW,
Suite 700
Washington, D.C. 20004
Tel: (703) 456-8647
Fax: (703) 456-8100