

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WATERS TECHNOLOGIES CORPORATION
Petitioner,

v.

BIOMEDICAL DEVICE CONSULTANTS & LABORATORIES OF
COLORADO, LLC
Patent Owner.

Case IPR2018-00498
Patent 9,186,224

**JOINT MOTION TO TERMINATE PROCEEDING
UNDER 35 USC §317(A) AND 37 CFR § 42.72 AND
JOINT REQUEST THAT THE SUBMITTED SETTLEMENT
AGREEMENT BE KEPT SEPARATE AS
BUSINESS CONFIDENTIAL INFORMATION**

I. JOINT MOTION FOR TERMINATION OF THE REVIEW

Under 35 USC § 317(a) and 37 CFR § 42.72, Petitioner, Waters Technologies Corporation, and Patent Owner, Biomedical Device Consultants & Laboratories of Colorado, LLC, (collectively, “the Parties”) jointly request to terminate the present *inter partes* review, Case No. IPR2018-00498, challenging US Patent No. 9,186,224 (the ‘224 Patent).

As an initial matter, the Patent Trial and Appeal Board (hereinafter “the Board”) authorized the Parties to file by May 18, 2018, this joint motion for termination and a request for treating the written settlement agreement as business confidential information via a communication on May 11, 2018.

Petitioner filed the present *inter partes* review petition on January 15, 2018. Patent Owner filed its preliminary response on April 27, 2018. The Board has not yet issued a decision on institution.

Termination is appropriate at this time for the following reasons:

The Parties have since settled their disputes, including those involving the ‘224 Patent, and have reached agreement to terminate this *inter partes* review. A Settlement Agreement has been made in writing and was fully executed by the Parties on May 4, 2018. Complying with 35 USC §317(b) and 37 CFR § 42.74(b), a true copy of this Settlement Agreement is submitted concurrently herewith as

Exhibit 1019. No other such agreements, written or oral, exist between or among the Parties. There are no other agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination of this proceeding.

The Settlement Agreement also requires that the Patent Owner file a notice of dismissal with prejudice of the related district court proceedings between the Parties, specifically: *Biomedical Device Consultants & Laboratories of Colorado, LLC v. TA Instruments – Waters LLC*, 0:17-cv-03403-DWF-SER (D.Minn).

Patent Owner represents that there are no other pending district court actions in which the ‘224 Patent has been asserted.

Finally, this joint request is proper because no final written decision on the merits has been entered, and because no other parties remain in this *inter partes* review.

II. JOINT REQUEST THAT THE SUBMITTED SETTLEMENT AGREEMENT BE KEPT SEPARATE AND TREATED AS BUSINESS CONFIDENTIAL INFORMATION

Under 35 USC §317(b) and 37 CFR §42.74(c), the Parties also request that the Settlement Agreement “be treated as business confidential information, [] be kept separate from the file of the involved patents, and [] be made available only to Federal Government agencies on written request, or to any person on a showing of

good cause.” 317 USC §317(b). In view of this request, the Settlement Agreement (Exhibit 1019) has been filed for access by the “Parties and Board Only.”

III. CONCLUSION

For the reasons above, the Parties jointly request that this motion be granted pursuant to 35 USC §317 and 37 CFR §§ 42.72 through 42.74.

Dated: May 14, 2018

Respectfully submitted,

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PETITIONER'S UPDATED
LIST OF EXHIBITS

Exhibit No.	Short Name	Description
1001	'224 Patent	US Patent No. 9,186,224 to McCloskey <i>et al.</i>
1002	Original Application	USSN 14/523,104, filed on October 24, 2014
1003	Billiar	Declaration of Prof. Billiar
1004		Curriculum Vitae of Prof. Billiar
1005	Office Action	Office Action mailed March 20, 2015
1006	Interview	Interview Summary mailed May 14, 2015
1007	Response	Amendment & Response Mailed June 17, 2015
1008	Allowance	Notice of Allowance mailed September 17, 2015
1009	Inventor Declaration	Inventor Declaration dated May 10, 2013 (and filed with Response Mailed June 15, 2015)
1010	Pickard	US Patent No. 4,682,491 to Pickard
1011	St. Jude	US Patent No. 5,916,800 to Elizondo <i>et al.</i> and assigned to St. Jude [<i>sic</i>] Medical, Inc.
1012	Woodward	US Patent No. 3,208,448 to Woodward
1013	Iwasaki	<i>Iwasaki et al., Implications for the Establishment of Accelerated Fatigue Test Protocols for Prosthetic Heart Valves, Artificial Organs Vol. 26 No. 5:420-429 (2002).</i>
1014	Reul	<i>Reul et al., Durability/Wear Testing of Heart Valve Substitutes, J Heart Valve Dis Vol. 7, No. 2: 151-157 (March 1998).</i>
1015	ISO 5840	International Standard ISO 5840, Cardiovascular implants – Cardiac valve prostheses, Fourth

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