

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

VIVITRO LABS INC.,  
Petitioner,

v.

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

---

Case IPR2024-00320  
Patent 9,237,935

---

JOINT MOTION TO TERMINATE INTER PARTES REVIEW AND REQUEST  
TO KEEP BUSINESS CONFIDENTIAL INFORMATION SEPARATE

In accordance with 35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74, and the Board's authorization granted on December 5, 2024, Petitioner ViVitro Labs Inc. and Patent Owner Biomedical Device Consultants & Laboratories of Colorado, LLC jointly move to terminate this *inter partes* Review proceeding based on an agreement between the parties.

On December 4, 2024, the parties agreed to resolve their disputes relating to U.S. Patent No. 9,237,935, to dismiss with prejudice the co-pending litigation in the Central District of California (Case No. 2:23-cv-04291), and request termination of this proceeding. The parties have executed a confidential agreement; pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), that written agreement is submitted concurrently herewith as Exhibit 1040. There are no other agreements or understandings, oral or written, between the parties made in connection with, or in contemplation of, the termination of the above-referenced proceeding.

Termination of this proceeding is appropriate. In view of the resolution between the parties, no dispute remains between the parties as to the challenged patent. In accordance with the agreement, the co-pending litigation will be dismissed with prejudice. Ex-1040 ¶ 18. The Patent Owner has not yet filed its Patent Owner Response, the Board has not yet decided the merits of this proceeding, and a Final Written Decision has not been entered. Termination of this proceeding is also consistent with the "strong public policy reasons favoring

settlement between the parties to a proceeding.” *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). Thus, notwithstanding that the proceeding has moved beyond the preliminary stage, good cause exists to terminate the proceeding.

The parties also jointly request under 37 C.F.R. § 42.74(c) that Exhibit 1040 be treated as business confidential information and be *kept separate* from the files of the above captioned proceeding. This agreement between Petitioner and Patent Owner contains confidential information regarding the terms of the settlement. See Ex-1040 ¶ 24. Accordingly, good cause exists to treat Exhibit 1040 as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

For these reasons, the Parties respectfully request that the Board grant this joint motion for termination and to keep business confidential information separate.

Respectfully submitted,

/Warren Thomas/

Warren J. Thomas (Reg. No. 70,581)  
*Attorney for Petitioner ViVitro Labs Inc.*

/Jordan L. Stott/

Jordan L. Stott (Reg. No. 71,867)  
*Attorney for Patent Owner Biomedical Device  
Consultants & Laboratories of Colorado, LLC*

**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(b) and agreement of the parties, I certify that on December 6, 2024, a copy of this paper and all accompanying exhibits were served on counsel for the Patent Owner by email to:

stott.jordan@dorsey.com  
bjorklund.shannon@dorsey.com  
tamkin.greg@dorsey.com

/Meg Cogburn/  
Meg Cogburn, Paralegal  
Meunier Carlin & Curfman LLC  
999 Peachtree St, NE  
Suite 1300  
Atlanta, GA 30309