

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

MALVERN PANALYTICAL LTD,

Plaintiff,

v.

TA INSTRUMENTS-WATERS LLC and
WATERS TECHNOLOGIES CORPORATION,

Defendants.

Civil Action No. 19-2157-RGA

JOINT STIPULATION OF NON-INFRINGEMENT

1. In light of the Court’s Claim Construction Order entered at D.I. 154, Plaintiff Malvern Panalytical Inc. (“Plaintiff”) and Defendants TA Instruments-Waters LLC and Waters Technologies Corporation (collectively, “Defendants”) (each of Malvern, TA Instruments, and Waters being a “Party,” and collectively the “Parties”) hereby stipulate and agree as follows:

2. On November 18, 2019, Plaintiff filed its Complaint against Defendants (D.I. 1) alleging infringement of United States Patent Nos. 8,449,175 (the “175 Patent”), 8,827,549 (the “549 Patent”), 9,404,876 (the “876 Patent”), 10,036,715 (the “715 Patent”), and 10,254,239 (the “239 Patent”) (collectively, the “Asserted Patents”). On January 23, 2020, Plaintiff filed its First Amended Complaint (D.I. 14).

3. On May 19, 2020, Defendants filed an Answer to Plaintiff’s First Amended Complaint (D.I. 26) wherein, *inter alia*, Defendants denied infringement of the Asserted Patents, and asserted affirmative defenses, including non-infringement and invalidity of the Asserted Patents.

4. On June 15, 2020, Plaintiff served its Identification of Accused Products and Asserted Patents (D.I. 36). On August 14, 2020, Plaintiff served its claim charts (D.I. 48), which

specified that the following claims from each of the five Asserted Patents were asserted against Defendant (“Asserted Claims”):

Patent	Accused Product(s)	Asserted Claims
'175 Patent	Affinity ITC; Affinity ITC Auto	9, 12, 14-18, 20, 24, 27, and 28
'549 Patent	Affinity ITC; Affinity ITC Auto	1, 2, 5, 7-11, 13-14, 17, and 18
'876 Patent	Affinity ITC Auto	1, 3-8, 10-14
'715 Patent	Affinity ITC Auto	1-11
'239 Patent	Affinity ITC Auto	1-6, 8, 9, 11-24, and 26-30

5. On January 21, 2021, Defendants filed an amended Answer to Plaintiff’s First Amended Complaint (D.I. 88) wherein Defendants asserted an additional affirmative defense of unenforceability.

6. On February 1, 2021, Plaintiff filed its Second Amended Complaint (D.I. 93).

7. On February 8, 2021, Defendants moved to partially dismiss the Second Amended Complaint (D.I. 95), specifically regarding Plaintiff’s pre-suit willful infringement allegations. Plaintiff filed an opposition to Defendants’ partial motion to dismiss on February 21, 2021 (D.I. 104), and Defendants filed a reply on March 1, 2021 (D.I. 122). Defendants’ motion remains pending.

8. On March 15, 2021, following briefing by the Parties and a hearing held on January 20, 2021, the Court issued a Memorandum Opinion providing constructions of disputed claim terms (D.I. 145). On March 22, 2021, the Court issued its Claim Construction Order (D.I. 154). The Court provided constructions for 14 terms of the Asserted Patents, including the following:

CLAIM TERM	COURT'S CONSTRUCTION
<p>“pipette guiding mechanism arranged to guide the pipette assembly” / “guiding mechanism” / “pipette guiding mechanism” (’175 Patent Cls. 9, 12, 16, 24, 27, and 28); (’549 Patent Cls. 1, 2, 14, 17, and 18)</p>	<p>“mechanism that manually guides the pipette assembly”</p>

9. Each of the Asserted Claims of the ’175 and ’549 Patents includes at least one of the following terms, or ultimately depends from an independent claim that includes at least one of the following terms: “pipette guiding mechanism arranged to guide the pipette assembly,” “guiding mechanism,” or “pipette guiding mechanism.”

10. Subject to all of Plaintiff’s rights to appeal, Plaintiff concedes that, under the Court’s construction of the terms “pipette guiding mechanism arranged to guide the pipette assembly,” “guiding mechanism,” and “pipette guiding mechanism” to mean a “mechanism that manually guides the pipette assembly,” none of the Defendants’ Accused Products satisfies those limitations of the Asserted Claims of the ’175 or ’549 Patents. In Plaintiff’s view, the arms of the Accused Products that Plaintiff alleges correspond to the “pipette guiding mechanism” are motorized and computer-guided, and, hence, not manually guided.

11. To preserve judicial and Party resources and to permit appellate review of the Court’s construction of the claim terms identified above, the Parties stipulate and agree to the entry of a final, appealable judgment against Plaintiff and in favor of Defendants that the Accused Products have not infringed and currently do not infringe any of the Asserted Claims of the ’175 and ’549 Patents, because none of the Accused Products satisfies the “pipette guiding

mechanism arranged to guide the pipette assembly,” “guiding mechanism,” and “pipette guiding mechanism” terms recited in the Asserted Claims as the Court has construed those terms.¹

12. The Parties further stipulate and agree that (i) Plaintiff’s infringement claims as to the ’876, ’715, and ’239 Patents are dismissed without prejudice, and Plaintiff reserves and retains the right to reassert the ’876, ’715, and ’239 Patents in the future, including in the event of a reversal and remand to this Court following the expected appeal from the final judgment entered pursuant to this Joint Stipulation of Non-Infringement; (ii) Defendants’ unadjudicated defenses with respect to all Asserted Patents are dismissed without prejudice, and Defendants reserve and retain the right to reassert any such defenses in the future, including in the event of a reversal and remand to this Court following the expected appeal from the final judgment entered pursuant to this Joint Stipulation of Non-Infringement; and (iii) the deadlines under Federal Rule of Civil Procedure 54(d) for seeking costs and fees shall be tolled until 14 days after a mandate issues from the Federal Circuit. The Parties further stipulate and agree that these dismissals without prejudice do not give rise to any *res judicata* and/or preclusion. The Parties agree to jointly request that the Court retain jurisdiction to address any subsequent requests for costs or fees under Rule 54(d) or 35 U.S.C. § 285.²

13. Notwithstanding the foregoing, and for the avoidance of doubt, Plaintiff states specifically that it disagrees with and objects to the Court’s construction of the terms “pipette guiding mechanism arranged to guide the pipette assembly,” “guiding mechanism,” and “pipette guiding mechanism.” Plaintiff expressly reserves its right to challenge these constructions on

¹ Defendants have additional non-infringement arguments which they reserve pursuant to Paragraph 12.

² The Parties also stipulate and agree that any discovery disputes that are actively being discussed are hereby preserved, including in the event of a reversal and remand to this Court following the expected appeal from the final judgment entered pursuant to this Joint Stipulation of Non-Infringement.

appeal. The Parties expressly reserve all appellate rights including, but not limited to, the right to appeal the Court's Claim Construction Order to the United States Court of Appeals for the Federal Circuit.

14. A proposed final judgment reflecting this stipulation is submitted herewith.

15. This stipulation may be made part of the appellate record by any Party.

DATED: April 12, 2021

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SO ORDERED this _____ day of April, 2021.

UNITED STATES DISTRICT JUDGE

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