

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,
Petitioner

v.

MOSKOWITZ FAMILY LLC,
Patent Owner.

Case IPR2025-01598
Patent No. 9,005,293

PETITIONER'S DISCRETIONARY DENIAL OPPOSITION

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Ex. 1004	File History for U.S. Patent No. 9,005,293
Ex. 1040	Amended Complaint, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Mass. filed Feb. 28, 2025), Dkt. 27.
Ex. 1041	Answer to Amended Complaint, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Mass. filed Feb. 28, 2025), Dkt. 29.
Ex. 1042	File History for U.S. Patent No. 9,907,674
Ex. 1043	File History for U.S. Patent No. 11,903,849
Ex. 1044	Amended Complaint, Exhibit A2, Amended Complaint, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Minn. filed Feb. 28, 2025), Dkt. 27-2.
Ex. 1045- Ex. 1046	RESERVED
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Ex. 1049	U.S. Patent No. 6,972,019 to Michelson (“Michelson ’019”)
Ex. 1050	Amended Complaint, Exhibit A4, Amended Complaint, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Minn. filed Feb. 28, 2025), Dkt. 27-4.
Ex. 1051	Amended Complaint, Exhibit A3, Amended Complaint, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Minn. filed Feb. 28, 2025), Dkt. 27-3.
Ex. 1052	Amended Complaint, Exhibit A5, Amended Complaint, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Minn. filed Feb. 28, 2025), Dkt. 27-5.

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Ex. 1070	Sotera Stipulation, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Mass. filed Feb. 28, 2025), Dkt. 38.
Ex. 1071	Plaintiff-Appellant’s Principal Brief, <i>Moskowitz Family LLC v. Globus Medical, Inc.</i> , Nos. 24-1696, 24-1753 (Fed. Cir. Jan. 30, 2025).
Ex. 1072	Administrative Office of the United States Courts, U.S. District Court – Judicial Caseload Profile (June 30, 2025), https://www.uscourts.gov/sites/default/files/document/fcms_na_distprofile0630.2025.pdf
Ex. 1073	Time to Trial in Delaware District, Docket Navigator
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Ex. 1075	E-mail from Shelly Jonas

I. INTRODUCTION

This IPR presents a rare instance where the Patent Office's own findings in subsequent continuation applications confirm that the Office erred in issuing the challenged patent. The error is so clear that Patent Owner Moskowitz's 20-page brief does not dispute any of the Office's dispositive findings even though they were front and center in the Petition. While Office error alone is sufficient to warrant institution here, three additional factors support institution of *inter partes* review: the complexity of the parties' dispute, judicial efficiency, and settled expectations.

Office error: As explained in Section II below, the Examiner of the '293 patent failed to perform "a thorough and complete search of the prior art," M.P.E.P. § 904.02, as shown by the Examiner's failure to uncover not one, but three anticipatory references (Byrd, Messerli, and Waugh) classified within the classes (class 623, subclasses 17.11 and 17.16) searched by the Examiner. The relevance of these three references is apparent from a simple comparison of their figures with those of the '293 patent. The materiality of this error is confirmed by the Office's rejection of similar claimed subject matter in subsequent continuation applications over Messerli and Waugh. Specifically, the Office concluded in later applications that both Messerli and Waugh disclose the same claim limitations, which formed the basis of allowance of the '293 patent. Institution is thus necessary to correct the above Office error.

Institution is further warranted because Moskowitz perpetuated this Office error. As confirmed by the exhibits submitted by Moskowitz (*see* Exs. 2010-2015), Moskowitz knew about these three key references from related applications since 2012. Moskowitz, however, did not submit these references in an Information Disclosure Statement (“IDS”) until *after* the Examiner had allowed the claims in 2015. Even then, Moskowitz ensured the Examiner would not consider them by filing an IDS without the necessary fee and the certification under 37 C.F.R. § 1.97(e). (Ex. 1004, 407, 413; *see also* M.P.E.P. § 609.05(a).)

Complexity of the parties’ dispute. The parallel district court litigation involves 11 patents stemming from numerous continuation-in-part applications (“CIPs”). Because these CIPs introduce new matter distinct from their parent applications, the asserted patents cover diverse subject matter with different specifications and priority dates. Thus, institution is warranted because the “the Board is better suited to review a large number of patents involving diverse subject matter.” *American Airlines, Inc. v. Intellectual Ventures I, LLC*, IPR2025-00785, Paper 11 (Director Aug. 29, 2025) (citing *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 (Director June 13, 2025)) (referring petitions where the parallel litigation involved 12 patents spanning 6 families).

Judicial Efficiency. The district court trial in Minnesota between Medtronic and Moskowitz will not occur until February 2028 at the earliest, approximately a

year *after* the anticipated final written decision in this IPR. While the '293 patent is also at issue against another party (NuVasive) in Delaware, a February 2027 scheduled trial date in that case, which is only two months before the deadline for the Board to issue a FWD, does not support a discretionary denial, since median time-to-trial statistics in Delaware suggest a trial date in late 2028. *See Amazon.com, Inc. et al. v. NL Giken, Inc.*, IPR2025-00250, Paper 14 (Director May 16, 2025) (finding “likely that a final written decision . . . will issue before the district court trial occurs” based on time-to-trial statistics even though the scheduled trial date preceded the projected final written decision date).

Settled Expectations. The Director has held that a patent owner’s decade-long silence following an express rejection of a license by a petitioner *avored* review because a patent owner cannot use its own delay to shield a patent from institution. *Apple Inc. v. Ferid Allani*, IPR2025-00856, Paper 11 (Director Sept. 5, 2025) (“Apple”). Here, Moskowitz is a well-funded, sophisticated non-practicing entity with no commercialization efforts of its own to speak of. Yet, after Medtronic expressly rejected Moskowitz’s licensing demand in 2016 (Ex. 1040, ¶48; Ex. 1041, ¶48) and continued to develop and commercialize spinal interbody devices that have been successfully implanted in patients for years, Moskowitz remained silent. (DD Req., 9-10.) During this almost decade-long period, Moskowitz sued Medtronic’s competitors (*e.g.*, Globus in 2019, ZimVie in 2022) but not Medtronic. (*Id.*, 8.)

Moskowitz's decade-long failure to pursue negotiations or litigation against Medtronic created strong settled expectations that it would not sue Medtronic. Moskowitz's decision to upset these settled expectations by pursuing litigation after 10 years warrants referral to the institution phase.

II. OFFICE ERROR, PERPETUATED BY MOSKOWITZ'S CONDUCT, WARRANTS REVIEW

A. The Examiner's Failure to Perform an Adequate Search Was Material to Patentability, as Confirmed by the Office's Own Findings in Subsequent Continuation Applications

As explained in the Petition, claim 43 of the '293 patent is anticipated by not one, but three prior art references. The Examiner, however, did not uncover any of these references during prosecution even though they were in the classes searched by the Examiner. This error was material to patentability because, as explained in the Petition (*see* pages 25, 28-29), the Office confirmed in later continuation applications that at least two of these references (Messerli and Waugh) disclose the limitations that formed the basis of allowance for claim 43 of the '293 patent.

1. The Examiner Failed to Uncover Pertinent Prior Art

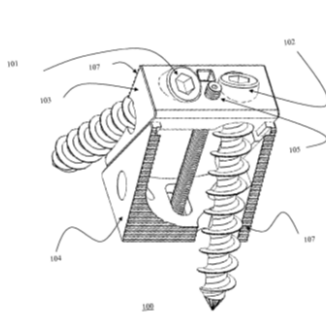
When the claims recite "spatial relationships" or the "shapes of mechanical components constitute important aspects of the claimed invention," an Examiner cannot rely only on a text query and should engage in the "traditional method of browsing all patent documents in one or more classifications" to ensure that they have performed a "thorough and complete search of the prior art." M.P.E.P. § 904.02.

Claim 43 recites such “spatial relationships”—“internal bore with an entry opening and an exit opening, the entry opening of the internal bore is formed only in a top surface of the top wall, while the exit opening is formed at least partially in a bottom surface of the top wall and at least partially in a side surface of the top wall”—which should have precluded the Examiner from relying solely upon a text query for searching. A proper search of the '293 patent (at least as to claim 43 (originally claim 133)) thus required the Examiner to engage in the traditional search practice of browsing all patent documents in the applicable U.S. Patent Classification (USPC) and/or Cooperative Patent Classification (CPC) classifications. (Ex. 1074, ¶¶23-26¹)

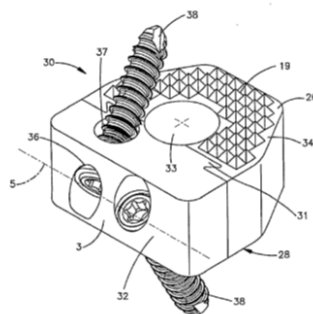
The file history of the '293 patent indicates that the Examiner conducted a classified search, as well as a text query (automated) search. Specifically, the Examiner conducted a search of USPC class 623, subclasses 17.11 through 17.16, as well as subgroups of CPC group A61F 2/44. (Ex. 1004, 198, 348, 392.) The Examiner, however, apparently missed all three anticipatory references, Byrd,

¹ Medtronic submits a declaration from Mr. Robert Bahr, who is an expert on USPTO policy, practice, and procedures. (Ex. 1074, ¶¶7-9.)

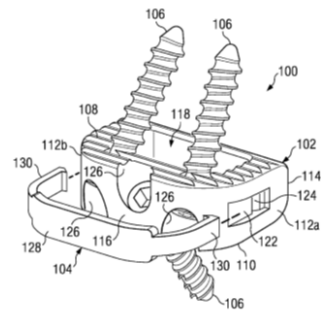
Messerli, and Waugh, even though they were present in the searched classes.² And their relevance is apparent from a simple comparison of their figures with those of the '293 patent. (Ex. 1074, ¶¶27-34.) For example, figure 1B (reproduced below) of the '293 patent, chosen by the Examiner for the front page of the patent, discloses an intervertebral cage, with top and bottom walls, first and second sidewalls, and an internal screw trajectory guide. The front pages of Messerli and Waugh each disclose a strikingly similar intervertebral cage, which warranted a further review of those references during prosecution of the '293 patent.



293 Patent



Messerli



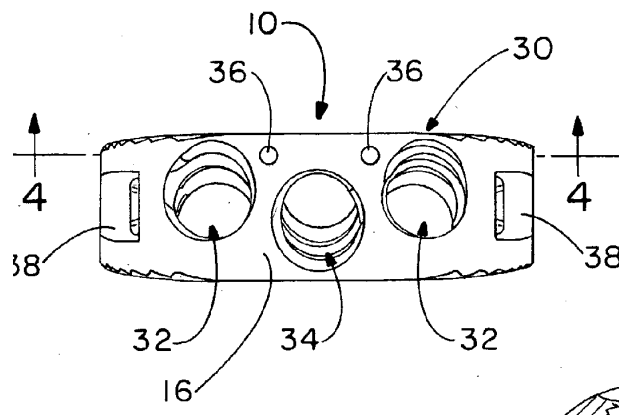
Waugh

More significantly, these front-page figures show, based on Moskowitz's

² Both Messerli and Waugh are classified in USPC class 623, subclass 17.16, while Byrd is classified in USPC class 623, subclass 17.11. (Ex. 1005 (Messerli), Cover (Messerli); Ex. 1006 (Waugh), Cover; Ex. 1007 (Byrd), Cover.)

interpretations, the claim limitations that Moskowitz argued to distinguish claim 43 over the prior art. (*See* Petition, 63-80, 93-98.)

Byrd's figure 3 (reproduced below) similarly discloses an intervertebral cage with an internal bore with an entry opening being formed only (or completely) in the top wall (front surface 16), which made Byrd relevant prior art based on the Examiner's erroneous belief that the "guide [being] only or complet[e]ly formed in the top surface of the top wall" seemed to be a patentable distinction over the prior art. (Ex. 1004, 354.)



(Ex. 1005, Fig. 3.)

2. Office Findings in Subsequent Applications Confirm the Materiality of the Examiner's Error

The Office found during prosecution of two continuation applications of the '293 patent that both Messerli and Waugh disclose the claim features that formed the basis for allowance of claim 43. In both applications, Moskowitz did not contest the Office's findings and amended the claims to overcome Messerli and Waugh.

(See Petition, Sections VIII.B-C.) Under such circumstances, “it is an appropriate use of Office resources to review the potential error” in issuing claim 43. *FreightCar America, Inc. v. National Steel Car Limited*, IPR2025-01046, Paper 20 at 3-4 (Director Oct. 10, 2025) (finding Office error because the prior art “appear[s] to disclose the allowable features of the claims”).

Specifically, during prosecution, Moskowitz distinguished the claimed screw arrangement from the screw arrangements in prior art implants as follows:

In stark contrast to the arrangements in the applied references, the claimed invention provides a unique combination in which an internal screw guide has an internal bore with an entry opening and an exit opening, the entry opening of the internal bore is formed only in a top surface of the top wall, while the exit opening is formed at least partially in a bottom surface of the top wall and at least partially in a side surface of the top wall.

(Ex. 1004, 371; *see also id.*, 354, 368-369 (the Examiner confirming that such claim language distinguished over the prior art).)

As confirmed by the Office in later applications in the priority chain of the '293 patent, such a screw arrangement is disclosed by both Messerli and Waugh. For example, Examiner Philogene, who examined the '293 patent, considered Messerli during prosecution of U.S. Patent No. 9,907,674, which is a continuation of the '293 patent. (Ex. 1042, 536-537.) He determined that Messerli discloses:

the use of a vertebral implant wherein the internal screw guide has an internal bore . . . the entry opening of the internal bore is formed only in the top surface of the top wall, . . . and the exit opening is formed at least partially in the bottom surface of the top wall and at least partially in the side surface of the top wall

(*Id.*, 537.) These are the same limitations that Moskowitz used to distinguish the '293 patent claims from the prior art. (*Compare id.*, 537, with, Ex. 1004, 371.) Moskowitz did not dispute Examiner Philogene's understanding of Messerli. Instead, Moskowitz chose to cancel the then-pending claims in favor of new claims that added a slew of new limitations. (Ex. 1042, 564-581.)

Similarly, a different Examiner considered Waugh during prosecution of U.S. Patent No. 11,903,849, which is also a continuation of the '293 patent. The Examiner found, and Moskowitz did not dispute, that Waugh discloses:

an internal screw guide having an internal bore . . . the internal bore having an entry opening and an exit opening, . . . the entry opening of the internal bore formed only in the top surface of the top wall, . . . and the exit opening formed at least partially in the bottom surface of the top wall and at least partially in a side surface of the top wall.

(Ex. 1043, 161, 180-181; *id.*, 232, 245-246 (amending claims to overcome Waugh).)

Again, these are the same limitations that Moskowitz argued were not disclosed by

the prior art during prosecution of the '293 patent. (*See* Ex. 1004, 371.)

B. Moskowitz Deprived the Examiner the Benefit of Reviewing Byrd, Messerli, and Waugh

The Examiner's failure to identify and examine anticipatory references for claim 43 was perpetuated by Moskowitz, whose actions ensured that the Examiner did not review Byrd, Messerli, and Waugh. Moskowitz knew about and even submitted Messerli and Byrd in Information Disclosure Statements ("IDSs") in related patent applications as early as 2012. (*See* Exs. 2010-2012.) Moskowitz also knew about Waugh because the Office cited Waugh not once but three times in related applications in 2013. (*See* Exs. 2013-2015.) Nevertheless, Moskowitz did not submit an IDS in the '293 patent prosecution during 2012 and 2013. And when Moskowitz did file its first IDS during the '293 patent prosecution in 2014, Moskowitz inexplicably omitted Byrd, Messerli, and Waugh. (Ex. 1004, 202-208.) Moskowitz only identified Byrd, Messerli, and Waugh in a pile of 80 citations *after* the Examiner allowed the claims in 2015, while alleging the references were "not believed to add to the art of record." (*Id.*, 396-406.)

The Office, however, rejected the 2015 IDS as *non-compliant* because it lacked the necessary fee and certification under 37 C.F.R. § 1.97(e). (*Id.*, 407, 413; *see also* M.P.E.P. § 609.05(a).) Instead of rectifying its non-compliant filing and

complying with its duty of disclosure, Moskowitz let the '293 patent issue without facilitating the Office's consideration of pertinent prior art. (Ex. 1074, ¶¶35-40.)

Moskowitz cannot justify its actions by alleging that Examiner Philogene had access to these references in other related applications.³ (DD Req., 19; Ex. 1074, ¶40.) An Examiner is not expected to rummage through or have a working memory of thousands of references across dozens of file histories spanning years; instead, the Office rules put the onus on patent applicants to bring known relevant art to the Office's attention (in each application). M.P.E.P. § 2001.06(b). If Moskowitz had complied with its obligations, claim 43 would not have issued, as demonstrated by the Office Actions in related cases rejecting the same features as claim 43 of the '293 patent over Messerli and Waugh, respectively.

Medtronic submits that this combination of examiner error, applicant's failure to comply with Office rules and procedure, and subsequent rejection of materially similar claims by the Office warrants institution of review of the '293 patent.

³ Patent Owner omits that the claims of those related applications are markedly different from those at issue here. For example, the related application claims either concern a tool or tool assembly, or an implant with a screw locking mechanism, unlike claim 43 of the '293 patent.

III. THE COMPLEXITY OF THE DISPUTE FAVORS INSTITUTION

The Director has repeatedly held that when a district court litigation involves a large number of patents spanning multiple families, as is the case here, the Board is the preferred forum for resolution of validity disputes. Moskowitz’s request for discretionary denial does not address this highly relevant factor.

In *Tesla*, the Office referred petitions where the parallel litigation involved 11 patents, citing the large number of patents and “a diverse range of subject matter” as weighing against discretionary denial. *Tesla*, IPR2025-00217, Paper 9. The Office similarly referred petitions where the parallel litigation involved 12 patents asserted against multiple parties across multiple jurisdictions, finding the Board was “better suited” to review such a large portfolio. *American Airlines, Inc. v. Intellectual Ventures I, LLC*, IPR2025-00785, Paper 11 (Director Aug. 29, 2025). The Office also referred petitions in other cases with similarly complex disputes. *Shenzhen TuoZhu Technology Co., Ltd. v. Stratasys, Inc.*, IPR2025-00438, Paper 10 (Director July 17, 2025) (denying request for discretionary denial where the parallel litigation involved 9 patents and specifically noting that “the large number and vast scope of the patents . . . weighs against discretionary denial.”); *Harbor Freight Tools USA Inc. et al. v. Champion Power Equipment, Inc.*, IPR2025-00805, Paper 20 (Director Sept. 19, 2025) (referring petitions where the parallel litigation involved 13 patents asserted against multiple parties across multiple jurisdictions, finding that resolving

the dispute at the Office “would be more efficient”); *Apple Inc. v. Apex Beam Technologies LLC*, IPR2025-00896, Paper 10 (Director Sept. 3, 2025) (referring petitions where the parallel litigation involved 17 patents, again confirming the Board’s role in managing high-volume patent validity challenges). Institution is similarly warranted here.

The Minnesota Action (involving Petitioner Medtronic as the defendant) involves 11 patents, and Moskowitz is currently seeking to add a 12th patent. (Ex. 1075.) Additionally, the Delaware Action (involving NuVasive as the defendant) involves 10 patents. These patents issued from applications in distinct branches of a fractured priority chain. Specifically, the portfolio comprises patents from numerous CIP applications, resulting in patents that claim diverse subject matter and rely on different priority dates and disclosures. These are precisely the type of “complex” litigations where the Office has found the Board’s expertise most valuable. Institution here allows the Board to apply its specialized technical expertise to specific validity issues, thereby streamlining massive district court actions and preventing the waste of judicial resources on invalid claims. The sheer scale of Moskowitz’s asserted portfolio confirms that the Board is the most efficient forum to resolve these disputes.

IV. SETTLED EXPECTATIONS FAVOR INSTITUTION

Medtronic’s (not Moskowitz’s) settled expectations warrant review. The

Office's decision in *Apple*, IPR2025-00856, Paper 11, is informative. In *Apple*, the settled expectations of a 13-year-old patent were outweighed by the fact that the Patent Owner waited 11 years to sue after the Petitioner declined a license. *Apple*, IPR2025-00856, Paper 11 at 3. Similarly, here, Medtronic expressly stated in January 2016 that it “does not wish to pursue acquisition or license of” Moskowitz's portfolio, including the '293 patent. (Ex. 1040, ¶48; Ex. 1041, ¶48.) Like in *Apple*, Medtronic's rejection of a license put the onus on Moskowitz to either sue or hold its peace. Moskowitz chose not to sue Medtronic for almost 10 years since the January 2016 license refusal even though Medtronic continued commercialization of the allegedly infringing technology. (DD Req., 9-10.) Moskowitz's failure to sue in a timely manner negates any claim that it has settled expectations of patent validity.

Moskowitz argues that its near decade-long delay should not have created “settled expectations” because it is “a small entity with limited resources” and that its enforcement actions against competitors (Globus in 2019, ZimVie in 2022) put Medtronic on notice. (DD Req., 8-9.) By suing Medtronic's competitors (Globus and ZimVie) and ignoring Medtronic, Moskowitz strengthened Medtronic's expectation that Moskowitz would not sue Medtronic for infringement of the '293 patent. Moreover, Moskowitz's claim of “limited resources” is not only unsubstantiated but also contradicted by the evidence. The Globus and ZimVie lawsuits demonstrate that Moskowitz had *sufficient (not limited)* resources. Indeed,

Moskowitz’s pursuit of multiple patent infringement suits and his cultivation of an expansive patent portfolio of over 70 patents and applications (*e.g.*, filing, prosecution, and maintenance fees)—costs for which should easily run millions of dollars—undercuts any claim of limited resources.

While Moskowitz argues that Medtronic knew of Moskowitz’s patent portfolio since 2015 (DD Req., 7-11), that point is irrelevant. By refusing a license and continuing to commercialize and introduce its technology to patients, Medtronic put the onus on Moskowitz to sue if Moskowitz believed that Medtronic’s products infringed the Moskowitz portfolio. Moskowitz’s arguments about meetings with Medtronic regarding purported “concepts” and “prototypes” before the ’293 patent issued also miss the point—and are backed by nothing more than the bare allegations in Moskowitz’s complaint. (*Id.*, 5-6.) Moreover, Moskowitz does not bother to explain how any of his alleged “concepts” and “prototypes” relate to the specific scope of the challenged claims. Vague commercial discussions from over a decade ago, unmoored from the specific patent rights at issue, cannot give rise to any “settled expectations” of patent validity relevant to the ’293 patent. Nor can Moskowitz avoid this result by arguing that Titan Spine’s history cannot be imputed to Medtronic. (DD Req., 7.) The decision in *Apple* focused on the patent owner’s delay, not the petitioner’s identity; Moskowitz cannot reset the clock on its own decade-long silence simply because the product line changed hands. *Apple* at 3.

V. THE FINTIV FACTORS STRONGLY FAVOR INSTITUTION

The *Fintiv* factors strongly favor institution.

A. Factor 1: Medtronic Will Request a Stay

If the petition is instituted, Medtronic will request a stay. Moskowitz argues a stay is “neither requested nor realistic.” (DD Req., 11.) But the Minnesota court has *invariably* granted stays when a significant number of patents are subject to review by the Office. *See, e.g., Vascular Solutions LLC v. Medtronic, Inc.*, No. 0:19-cv-01760-PJS-TNL (D. Minn.), ECF No. 276 (July 7, 2020) (granting Medtronic’s motion to stay pending thirteen IPRs). Moskowitz’s cited cases are inapplicable because, in those cases, the courts denied a stay as IPRs were not yet instituted and involved fewer asserted patents. Here, Medtronic has filed IPRs challenging five patents and anticipates challenging more patents; therefore, there is a high likelihood of stay once IPRs are instituted. Given the complexity of the dispute, instituting review is the most effective way to encourage a stay and conserve judicial resources.

B. Factor 2: The FWD Will Issue Nearly a Year Before Trial

This factor strongly favors institution. Medtronic’s Petition was accorded a filing date in October 2025 (*see* Paper 3), meaning that the Board’s FWD is due in April 2027. Meanwhile, the Minnesota Litigation is scheduled to be ready for trial almost a year later, in February 2028 (*see* Ex. 2001, 16), which is earlier than the district’s median time-to-trial. (Ex. 1072, 58.) Institution will allow the Board to

issue a FWD nearly a year before the Minnesota Litigation trial could begin.

A February 2027 trial date for the '293 patent in a Delaware Action involving a different party (NuVasive) (DD Req., 13) does not weigh in favor of a discretionary denial. The Delaware Action does not involve Medtronic. Medtronic has no control over that case, no ability to participate, will not be bound by its judgment, and Moskowitz cites no authority supporting that another party's trial date should be cognizable under this factor. Moreover, the current median time-to-trial in Delaware is 35 months for civil cases generally (Ex. 1072, 14) and 44 months for patent cases specifically (Ex. 1073, 1). Based on the filing of the NuVasive complaint in June 2025, the median time-to-trial statistics in Delaware show that a trial, if any, is likely to occur substantially later than February 2027—in late 2028 (if not in 2029). As such, the current Delaware trial date in the NuVasive case is not entitled to much weight. *See Amazon.com*, IPR2025-00250, Paper 14.

Even if the scheduled trial date of the Delaware Action holds, Office error, Moskowitz's delay in bringing suit, and the complexity of the parties' dispute support institution. For example, in *Apple*, the Office instituted review given Patent Owner's delay in bringing suit even though the district court trial was scheduled to occur five months before the Board's decision. *Apple* at 2. In both *Tesla* and *Shenzen*, which also involved many asserted patents, the district court trials were scheduled to occur before the Board's final decision. *Tesla* at 2; *Shenzen* at 3. Even

so, in both instances, the Office ordered institution, holding that the “large number and vast scope” of asserted patents “tip[s] the balance” in favor of Board review despite the scheduling conflict. *Tesla* at 2-3; *see also Shenzen* at 3. Here, where the Board’s FWD will issue nearly a year before trial in the Minnesota Litigation, the case for institution is undeniable. But even viewed against the Delaware Action’s timeline, the complexity of this eleven-patent dispute and Moskowitz’s decade-long delay in bringing suit favors review.

C. Factor 3: The Minnesota Action Is in Its Infancy

Institution is an efficient use of Board resources because the parallel litigation with Medtronic has barely begun. The Minnesota court has not yet held a *Markman* hearing or issued a claim construction order. By contrast, in *Apple*, the Office instituted review despite the fact that “the district court has issued a Markman order” and the parties had exchanged written discovery. *Apple* at 2.

D. Factor 4: The *Sotera* Stipulation Supports Institution

Medtronic’s filing of a *Sotera* stipulation (Ex. 1070) “mitigates any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions,” at least as to claim 43. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (P.T.A.B. Dec. 1, 2020) (precedential). Moskowitz’s suggestion that “other asserted claims” (DD Req., 11) of the ’293 patent would nevertheless require litigation is meritless. Claim 43 is the

only claim of the '293 patent that Moskowitz identified in its complaint. (Ex. 1040, ¶63.) Medtronic thus filed the instant IPR challenging claim 43. While Moskowitz identified more asserted claims in its infringement contentions served a month *after* the instant IPR was filed, the additional asserted claims do not favor denial of review.

First, the additional claims have common limitations with claim 43 such that any findings by the Office will be instructive to the district court, thereby narrowing the parties' dispute. *Second*, by the time trial occurs, there will be further case narrowing and there is no guarantee that Moskowitz will assert any claim other than claim 43. *Third*, Moskowitz previously asserted related patents against Globus Medical and failed to prove infringement because the claims recited the term "universal," which the Eastern District of Pennsylvania construed to require a spacer (*i.e.*, a type of spinal implant) that "can be used in any region of the spine and may be inserted through any surgical approach." (Ex. 1071, 28-29.) Every claim of the '293 patent except claim 43 recites the term "universal." Under the district court's construction, Medtronic's products cannot infringe the other claims of the '293 patent because, *inter alia*, Medtronic's spinal implants are for use in specific regions of the spine. Thus, instituting review of claim 43 of the '293 patent will significantly simplify issues for the district court.

E. Factor 5: Early FWD and Different Parties Supports Institution

Moskowitz admits the Delaware Action involves a different defendant,

specifically “one of Petitioner’s competitors” (NuVasive). (DD Req. 13.) Regarding the Minnesota Action, while the parties are the same, the timing of the trial (Factor 2) renders this factor favorable to institution because the Board’s earlier FWD will simplify the issues for trial. *See NeuMoDx Molecular, Inc. v. HandyLab, Inc.*, IPR2020-01133, Paper 23 at 13-14 (P.T.A.B. Aug. 6, 2021).

F. Factor 6: Strong Merits Support Institution

The Petition presents strong challenges of the claims under 35 U.S.C. §§ 102 and 103 based on prior art printed publications. Moskowitz attempts to discredit them by mislabeling them as § 112 or inequitable conduct challenges. (DD Req., 18-20.) This diversionary tactic should be rejected. In fact, Medtronic’s arguments serve only to further highlight the need for the Office to take another look at the ’293 patent. Medtronic’s points regarding the lack of disclosure in the ’293 patent specification are explanatory and underscore Moskowitz’s efforts to obfuscate the scope of his patent estate to avoid critical examination by the Office. Referring this IPR for consideration of institution is the best path forward to rectify Office error perpetuated by Moskowitz’s prosecution tactics.

VI. CONCLUSION

Given that the discretionary denial considerations support institution as discussed above, Medtronic requests institution to allow the Board to correct Office error in issuing claim 43.

Respectfully submitted,

Dated: January 8, 2026

By: /Naveen Modi/
Naveen Modi (Reg. No. 46,224)

Counsel for Petitioner

CERTIFICATE OF SERVICE

I certify that I caused to be served on the counsel identified below a true and correct copy of the foregoing Petitioner's Discretionary Denial Opposition by electronic means on January 8, 2026:

Eric A. Zelepugas (zelepugas@avantechlaw.com)

Robert A. Conley (conley@avantechlaw.com)

moskowitz_post-grant@avantechlaw.com

By: / Naveen Modi /
Naveen Modi (Reg. No. 46,224)
Counsel for Petitioner