

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,
Petitioner,
v.

MOSKOWITZ FAMILY LLC,
Patent Owner.

IPR2025-01598
Patent 9,005,293

**JOINT MOTION TO TERMINATE PURSUANT TO
35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

Mail Stop “PATENT BOARD”
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
2001	Pretrial Scheduling Order, <i>Moskowitz Family LLC v. Medtronic, Inc. et. al.</i> , No. 0:25-CV-00769-PJS-DLM, ECF No. 36 (Dist. Of Minn. September 10, 2025) (Micko, D.)
2002	Stipulation Extending Time For Defendants To Respond To Plaintiff's Complaint, <i>Moskowitz Family LLC v. Medtronic, Inc. et. al.</i> , No. 0:25-CV-00769-PJS-DLM, ECF No. 15 (Dist. Of Minn. March 19, 2025)
2003	Stipulation Extending Time For Defendants To Respond To Plaintiff's Complaint, <i>Moskowitz Family LLC v. Medtronic, Inc. et. al.</i> , No. 0:25-CV-00769-PJS-DLM, ECF No. 24 (Dist. Of Minn. May 22, 2025)
2004	Scheduling Order, <i>Moskowitz Family, LLC v. NuVasive, LLC et. al.</i> , No. 1:25-CV-00711-WCB, ECF No. 17 (D. Del. October 20, 2025) (Bryson, W.)
2005	Email from Chetan R. Bansal, Counsel for Medtronic to Eric Zelepugas, Counsel for Moskowitz Family LLC, dated December 2, 2025
2006	October 3, 2025 Update to USPTO Interim Director Discretionary Process
2007	March 24, 2025 Guidance on USPTO's rescission of "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation"
2008	USPTO FAQs for Interim Processes for PTAB Workload Management (Archived)
2009	Complaint, <i>Moskowitz Family LLC v. Zimvie Inc.</i> , No. 1:22-cv-01632-UNA, ECF No. 1 (D. Del. December 23, 2022)
2010	Information Disclosure Statement citing Messerli to Examiner Philogene in co-pending sibling U.S. Patent Application No. 13/084,543 (April 18, 2012)
2011	Information Disclosure Statement citing Byrd to Examiner Philogene in co-pending sibling U.S. Patent Application No. 13/084,543 (May 4, 2012)
2012	Information Disclosure Statement citing Messerli and Byrd to Examiner Philogene again in co-pending child U.S. Patent Application No. 13/741,361 (April 18, 2012)

2013	Office Action citing Waugh by Examiner Philogene in related U.S. Patent Application No. 13/401,829 (July 16, 2013)
2014	Office Action citing Waugh by Examiner Philogene in related U.S. Patent Application No. 13/418,323 (December 30, 2013)
2015	Office Action citing Waugh by Examiner Philogene in related U.S. Patent Application No. 13/418,335 (September 9, 2013)
2016	Office Action citing earlier publication of '293 patent in U.S. Patent Application No. 14/494,381 (September 17, 2015)
2017	Complaint, <i>Moskowitz Family LLC v. Globus Medical, Inc.</i> , No. 6:19-cv-00672, ECF No. 1 (W.D. Tex. November 20, 2019)
2018	Complaint, <i>Moskowitz Family, LLC v. NuVasive, LLC et. al.</i> , No. 1:25-CV-00711-WCB, ECF No. 1 (D. Del. June 6, 2025)
2019	Complaint, <i>Moskowitz Family LLC v. Medtronic, Inc. et al.</i> , No.0:25-cv-00769, ECF No. 1 (Dist. Of Minn February 28, 2025)
2020	Letter from Michael Fink, Counsel for Nathan Moskowitz to Newton Metcalf Jr., Director of Advanced Technologies Program for Medtronic, Inc., dated June 30, 2015
2021	Letter from Michael Fink, Counsel for Nathan Moskowitz to Brad Lerman, Senior Vice President and General Counsel for Medtronic, Inc., dated June 30, 2015
2022	Attachments to Notice Letters including Moskowitz Patent Portfolio and U.S. Patent No. 9,005,293
2023	Letter from Michael Fink, Counsel for Nathan Moskowitz to Peter Ullrich, Chief Executive Officer for Titan Spine, dated July 27, 2015
2024	<i>Uniloc USA, Inc. v. Motorola Mobility LLC</i> , Case No. 2:16-CV-00992-JRG, ECF No. 125 (E.D. Tex. Apr. 5, 2017)) (Gilstrap, J.)
2025	Information Disclosure Statement citing U.S. Patent No. 9,005,293 in Patent App. No. 16/282,661 (July 19, 2019)
2026	Information Disclosure Statement citing U.S. Patent No. 9,005,293 in Patent App. No. 17/590,529 (Feb. 1, 2022)
2027	Information Disclosure Statement citing U.S. Patent No. 9,005,293 in Patent App. No. 29/783,700 (May 14, 2021)
2028	Joint Stipulation for Stay of Litigation, <i>Moskowitz Family LLC v. Medtronic, Inc. et al.</i> , No.0:25-cv-00769, ECF No. 76 (Dist. Of Minn June 12, 2026)
2029	Agreement Regarding Claim 43 of U.S. Patent No. 9,005,293

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 and 42.74 and authorization provided by the Board on June 18, 2026, Patent Owner Moskowitz Family LLC and Petitioner Medtronic, Inc. (collectively, the “Parties”) jointly move to terminate this *inter partes* review in its entirety in light of the Parties’ agreement resolving their dispute with respect to claim 43 of U.S. Pat. No. 9,005,293 (“the ’293 patent”).

The Parties submit this joint motion together with true copies of the agreements and understandings made in connection with the requested termination, including a Joint Stipulation filed in the related district-court litigation (Ex. 2028) and an agreement including a covenant not to sue concerning claim 43 of the ’293 patent (Ex. 2029).

Medtronic is the only petitioner in this proceeding, and claim 43 is the only challenged claim. The Parties’ agreement resolves the dispute between the Parties regarding claim 43, including the dispute presented in this proceeding. Accordingly, the Parties jointly request that the Board terminate this proceeding as to Petitioner and Patent Owner.

II. STATEMENT OF REASONS FOR RELIEF REQUESTED

On June 12, 2026, Moskowitz and Medtronic reached an agreement resolving the dispute in this *inter partes* review. As part of that resolution, Moskowitz agreed

to dismiss its allegation in the related district court litigation that Medtronic infringes claim 43 of the '293 patent with prejudice, and the Parties agreed to jointly seek termination of this proceeding, which challenges only claim 43. The Parties' agreement therefore resolves the dispute presented in this proceeding. Termination will conserve the resources of the Parties and the Board and will promote the efficient resolution of the related disputes.

Medtronic filed the Petition in this *inter partes* review on September 29, 2025, challenging claim 43 of the '293 patent. Paper 1. The Director instituted review on March 23, 2026. Paper 10. No Patent Owner response, motion to amend, reply, sur-reply, expert deposition, or oral hearing has occurred. The Office has not decided the merits of this proceeding. Because the Parties jointly request termination before any decision on the merits, termination is appropriate under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), true copies of the agreements and understandings made in connection with the requested termination are being submitted as Exhibits 2028-2029.

The Parties certify that Exhibits 2028-2029 reflect the complete agreements and understandings made in connection with, or in contemplation of, the termination of this proceeding, and that there are no other collateral agreements or

understandings, oral or written, made in connection with, or in contemplation of, termination. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(b).

III. TERMINATION IS APPROPRIATE

Under 37 C.F.R. § 42.72, the Board may terminate a trial without rendering a final written decision where appropriate, including in response to a joint request under 35 U.S.C. § 317(a). Termination is appropriate here because the Parties have resolved the dispute presented in this proceeding, Medtronic is the only petitioner, claim 43 is the only challenged claim, and the Office has not decided the merits.

Termination would also conserve Board and party resources. If the proceeding continues, the Parties and the Board would need to devote resources to further briefing and potential motion practice, expert discovery, and hearing preparation, even though the Parties have resolved the dispute involving the only challenged claim. Termination now avoids those unnecessary expenditures and promotes the efficient resolution of the Parties' disputes.

The Board has recognized that there are strong public-policy reasons to favor settlement between parties to a proceeding. *See* Consolidated Trial Practice Guide at 86. That policy applies here. The Parties reached their agreement early in the post-institution schedule, before any merits decision and before the principal post-institution papers and hearing. Termination will therefore advance the interests of efficiency, finality, and the consensual resolution of disputes.

For these reasons, Moskowitz and Medtronic jointly request that the Board terminate this *inter partes* review in its entirety under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72.

Date: June 26, 2026

Respectfully submitted,

/Eric A. Zelepugas/

Eric A. Zelepugas

Registration No. 73,302

Lead Counsel for Patent Owner

/Naveen Modi /

Naveen Modi

Registration No. 46,224

Lead Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **JOINT MOTION TO TERMINATE** and associated exhibits (Exhibits 2028-2029) were served electronically via e-mail on June 26, 2026, in their entireties on the following counsel of record for Petitioner:

Naveen Modi (Lead Counsel)
Young Park (Back-up Counsel)
Chetan Bansal (Back-up Counsel)
naveenmodi@paulhastings.com,
youngpark@paulhastings.com,
chetanbansal@paulhastings.com,
PH-Medtronic-Moskowitz-IPR@paulhastings.com

Date: June 26, 2026

Respectfully submitted,
AVANTECH LAW, LLP
80 S 8th St, Suite 900
Minneapolis, MN 55402
(312) 487-2185

/Eric A. Zelepugas/
Eric A. Zelepugas
Registration No. 73,302
Lead Counsel for Patent Owner