

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,

Petitioner

v.

MOSKOWITZ FAMILY LLC,

Patent Owner

IPR2026-00124
Patent 11,096,797

PATENT OWNER'S PRELIMINARY RESPONSE

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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	First Amended Complaint, <i>Moskowitz Family LLC v. Medtronic, Inc. et. al.</i> , No. 0:25-CV-00769-PJS-DLM, ECF No. 27 (Dist. Of Minn. May 23, 2025)
2005	Stipulation to Amend Case Scheduling Concerning Contentions and Claim Construction, <i>Moskowitz Family LLC v. Medtronic, Inc. et. al.</i> , No. 0:25-CV-00769-PJS-DLM, ECF No. 42 (Dist. Of Minn. January 16, 2026)
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 earlier publication (U.S. Pat. App. Pub. No. 2020/0138591) of '797 Patent in Medtronic U.S. Patent Application No. 17/246,968 (May 3, 2021)
2011	Information Disclosure Statement citing McLuen and Michelson in '797 grandparent U.S. Patent Application No. 15/820,232 (considered by examiner on January 19, 2018)
2012	Information Disclosure Statement citing McLuen and Michelson in '797 parent U.S. Patent Application No. 16/025,667 (considered by examiner on November 7, 2018)
2013	Information Disclosure Statement citing '797 Patent in Medtronic/Warsaw U.S. Patent Application No. 17/391,158 (March 4, 2022)
2014	Information Disclosure Statement citing '797 Patent in Medtronic/Warsaw U.S. Patent Application No. 17/246,959 (May 2, 2022)
2015	Information Disclosure Statement citing '797 Patent in Medtronic/Warsaw U.S. Patent Application No. 17/307,578 (Fed. 25, 2022)
2016	Amended Pretrial Scheduling Order, <i>Moskowitz Family LLC v. Medtronic, Inc. et. al.</i> , No. 0:25-CV-00769-PJS-DLM, ECF No. 44 (Dist. Of Minn. January 20, 2026)

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	<i>Intentionally left blank</i>
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	<i>Intentionally left blank</i>
2024	Uniloc USA, Inc. v. Motorola Mobility LLC, Case No. 2:16-CV-00992-JRG, ECF No. 125 (E.D. Tex. Apr. 5, 2017)) (Gilstrap, J.)

I. INTRODUCTION

Institution should be denied because the Petition never demonstrates the three distinct, nesting tools that claim 16 requires. Independent claim 16 recites a system comprising (1) a first tool, (2) a second tool configured to be positioned within the first tool, and (3) a third adjusting tool configured to be positioned within the second tool—three separate instruments arranged in a defined telescoping relationship. The Petition does not identify that structure in the prior art.

The Petition relies primarily on Michelson to supply the claimed tools. But Michelson discloses two tools: a unitary implant holder assembly and an expander driver. It does not disclose three distinct tools arrangeable in a nested configuration. To bridge that gap, the Petition points to different portions of Michelson’s single implant holder assembly—its outer sleeve and its internal shaft—and labels them separate “tools.” Michelson, however, describes those components as mechanically interlocked parts of one integrated holder that operate together to engage and release the implant. The Petition never explains why a person of ordinary skill would treat those interdependent components as separate instruments, nor how doing so would preserve Michelson’s described mode of operation.

McLuen is likewise deficient. The Petition only relies on McLuen for the implant, not for the three claimed tools. And Petitioner identifies no technological shortcoming in McLuen that would justify importing—and then disaggregating—

Michelson's holder assembly. The asserted combination therefore depends on parsing a single instrument into multiple "tools" to match the claim language. That is not a reasoned basis for institution.

Because the Petition fails to show that the prior art teaches—or renders obvious—the claimed three-tool nesting system, and fails to articulate a supported motivation to combine with a reasonable expectation of success, the Director should deny institution.

II. THE '797 PATENT

Intervertebral fusion procedures require placing an implant within the disc space and then expanding it in a controlled manner to restore disc height and promote stability. That expansion typically occurs after the implant has been positioned, and it must be performed without losing alignment or destabilizing the implant.

The '797 patent addresses that problem. It discloses a coordinated surgical system in which an expandable intervertebral fusion implant is inserted, stabilized, and then expanded in a controlled manner using a deliberately structured set of cooperating instruments. Ex. 1001 at 3:44-55, 10:23-60, 11:1-13, 11:42-12:44, Figs. 8A-8C, 8E-8G. The implant includes an expansion mechanism—such as a rotation screw—that must be accessed and actuated after placement. *Id.* at 10:38-42, 11:55-64, 12:11-17. The patent's solution is structural: a staged, nested tool architecture

that maintains implant stability while permitting controlled actuation of the expansion mechanism. *Id.* at 10:23-60, 11:1-11.

The system employs three distinct tools arranged in a nested configuration. *Id.* A first tool engages opposing side indentations of the implant and securely grips it, functioning as the primary insertion and stabilization instrument. *Id.* at 10:48-55. That first tool defines a central passageway. *Id.* at 11:4-5. A second tool is receivable through that passage and provides guidance and alignment for a third tool. *Id.* at 11:3-5. The third tool—an adjusting tool such as an Allen key or similar driver—is receivable through the second tool and engages the implant’s expansion screw. *Id.* at 11:3-4, 11:58-64; 12:11-17.

Through this arrangement, the implant remains firmly stabilized while the third tool actuates the screw-driven expansion mechanism. *Id.* at 11:3-11, 11:55-64; 12:7-17. The instruments cooperate, but they are separate tools assembled sequentially in a telescoping fashion. Figures 8E–8G illustrate this nested relationship: the third tool is insertable into the second tool, which is insertable into the first tool, forming a modular instrumentation system rather than a single monolithic device. *Id.* at 11:1-6, Figs. 8E-8G.

The claims reflect the same structure. Independent claim 16 recites a first tool with engagement prongs and defining a passage; a second tool receivable within that passage; and a third tool with a screw engagement portion receivable within the

second tool. The intrinsic record thus describes a coordinated, multi-instrument system designed to maintain alignment during implantation while enabling controlled post-placement expansion.

That architecture frames the obviousness dispute.

III. SUMMARY OF THE ASSERTED REFERENCES

Although the Petition introduces McLuen as the primary reference, it relies heavily on Michelson for the three claimed tools. Both references relate to expandable spinal implants and associated instruments. But neither discloses the staged, nested three-tool architecture required by the '797 patent.

The challenged claims require three distinct instruments arranged in a defined telescoping relationship. The Petition does not identify any prior art system that discloses that configuration.

Michelson describes an implant holder assembly used to position an implant, and a separate expander driver used to actuate expansion. McLuen describes an expandable implant and a tool interface designed to improve screw engagement. Neither reference, alone or in combination, discloses three separate tools arranged so that one is received within another in the manner required by claim 16.

As explained below, the Petition attempts to reconstruct Michelson's two-component holder assembly into multiple "tools" in order to meet the claim language. But the cited references do not disclose—or suggest—the claimed

configuration of three distinct tools operating in a nested relationship to stabilize and expand an implant as recited in the '797 patent.

A. McLuen (Ex. 1012)

McLuen describes an expandable spinal implant inserted in a compact configuration and then expanded by rotating an internal screw mechanism. Ex. 1012 ¶ 74. In doing so, McLuen identifies a practical safety concern: conventional screwdrivers used to rotate the positioning screw may slip, particularly in the confined environment, creating a risk of unintended instrument movement near the spine. *Id.* ¶ 76.

McLuen's solution is to add a dedicated, anti-slip tool-to-implant engagement interface. *Id.* ¶¶ 76, 78. Specifically, McLuen implements channels 1522 in the implant body so that a tool can positively seat into the implant and remain secured during rotation of the positioning mechanism. *Id.* Rather than relying solely on a screwdriver tip engaging the screw head, McLuen describes a tool including attachments shaped to fit into the channels 1522, thereby resisting lateral movement and stabilizing the instrument during turning. *Id.* ¶¶ 76-78. In effect, McLuen discloses a tool-to-implant coupling interface that functions as a keyed connection, reducing the likelihood that the driver will come out or disengage while torque is applied.

Operationally, once the implant is positioned, the surgeon uses this specialized tool—configured to engage the channels 1522—to secure the tool to the implant as the positioning means 1508 is rotated. *Id.* As the positioning means is rotated, the internal extending blocks travel outward along the screw components and push the tabs 1530 outward. *Id.* ¶ 75. The implant is thereby expanded and mechanically wedged between adjacent bones. McLuen emphasizes that the channels 1522 improve safety and reliability of this expansion step by ensuring secure tool engagement during actuation. *Id.* ¶¶ 76, 78.

McLuen therefore discloses, at most, a conventional expansion driver (e.g., a screwdriver) used in conjunction with a securing/engagement tool interface at the implant. It does not disclose three distinct tools arranged in the claimed nested configuration (first tool defining a passage; second tool receivable within it; third adjusting tool receivable within the second tool).

B. Michelson (Ex. 1014)

Michelson discloses an expandable interbody implant used with an instrumentation assembly that includes two instruments: an implant holder 500 and an expander driver 600. Ex. 1014 at 12:43-13:13.

The implant holder 500 is a unitary assembly comprising an outer sleeve 504 and a shaft 502 that are mechanically coupled together. The shaft 502 extends within the outer sleeve 504, and comprises a peg 516 that cooperates with L-shaped slot

540 to constrain and lock the shaft 502 relative to the outer sleeve 504. *Id.* at 15:1–8, 17:65–18:2. Michelson refers to outer sleeve 504 and shaft 502 collectively as “implant holder 500,” not as separate instruments. *E.g.*, Ex. 1014 at 12:45-46 (“Implant holder 500 has a shaft 502 and an outer sleeve 504.”); *see also id.* at 14:65-15:21; 17:63-18:2. The sleeve and shaft do not function independently. They operate together as a single gripping mechanism for engaging and releasing the implant.

Michelson explains that advancing shaft 502 forces the sleeve’s side extensions outward so that flanges engage the implant. *Id.* at 15:1–8. Retracting the shaft allows the extensions to collapse inward to release the implant. *Id.* at 17:65–18:2. The sleeve does not engage the implant absent coordinated shaft movement. The two components are disclosed and used as parts of one integrated holder tool.

Once the implant is positioned, expander driver 600 is inserted through implant holder 500 to engage and rotate the implant’s expansion mechanism. *Id.* at 15:28-30, 16:46–55. The driver is used to rotate the implant’s expansion mechanism; the holder grips and stabilizes the implant during that process.

Thus, Michelson discloses at most two tools for securing and expanding the implant: (1) a unitary implant holder assembly and (2) an expander driver. It does not disclose three distinct tools arranged in a nested configuration, nor does it describe separating components of the holder assembly into independent instruments that are receivable within one another as required by claim 16.

IV. CLAIM CONSTRUCTION

Petitioner asserts that no claim construction is necessary. Pet. at 16. But Petitioner’s obviousness theory depends on treating separately recited “tools” as portions of a single instrument. The Board need not adopt any special definition to resolve that issue. The plain language of claim 16 is sufficient.

Under *Phillips*, claim terms are given their ordinary and customary meaning in light of the intrinsic record. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc). Here, the claim itself recites three tools—a first tool, a second tool, and a third adjusting tool—arranged in a defined nesting relationship. To the extent construction is required, the claim language and specification make clear that these are distinct tools that are combinable, not subcomponents of a single device.

Patent Owner addresses that issue below.

A. First Tool, Second Tool, Third Adjusting Tool.

Claim 16 recites three tools separately: “a first tool,” “a second tool,” and “a third adjusting tool.” “Where a claim lists elements separately, the clear implication of the claim language is that those elements are distinct components.” *Becton, Dickinson & Co. v. Tyco Healthcare Group, LP*, 616 F.3d 1249, 1254 (Fed. Cir. 2010).

The structure of claim 16 reinforces that conclusion. The first tool defines a first tool passage. The second tool is receivable within that passage. The third

adjusting tool is receivable within a passage of the second tool. The claim thus requires a staged, nesting relationship among three tools—each capable of being received within another.

That nesting requirement is structural. A single instrument cannot simultaneously be both the outer tool defining a passage and the separate inner tool that is receivable within that passage. Nor can components of a unitary instrument be treated as a distinct “tools” when the claim requires that the tools be arranged in a receivable-within configuration.

The specification is consistent with this reading. Figures 8C and 8E–8G depict the first tool, second tool, and third adjusting tool as separate instruments assembled together. Ex. 1001, Figs. 8C, 8E-8G. The drawings illustrate the second tool can be inserted into the first tool, and the third adjusting tool can be inserted into the second tool—confirming the distinct, combinable nature of the recited tools.

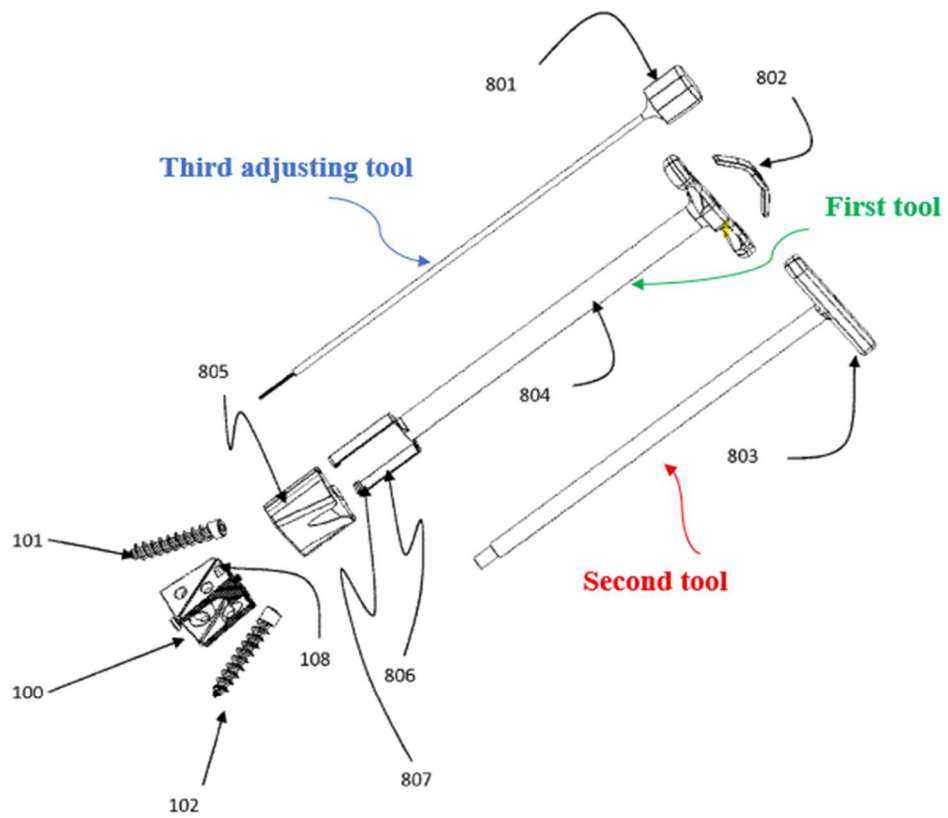


Fig. 8C

Ex. 1001, Fig. 8C

For example, Figures 8E-8F illustrate how the third adjusting tool fits within the second tool passage of the second tool. *Id* at Figs. 8E-8F.

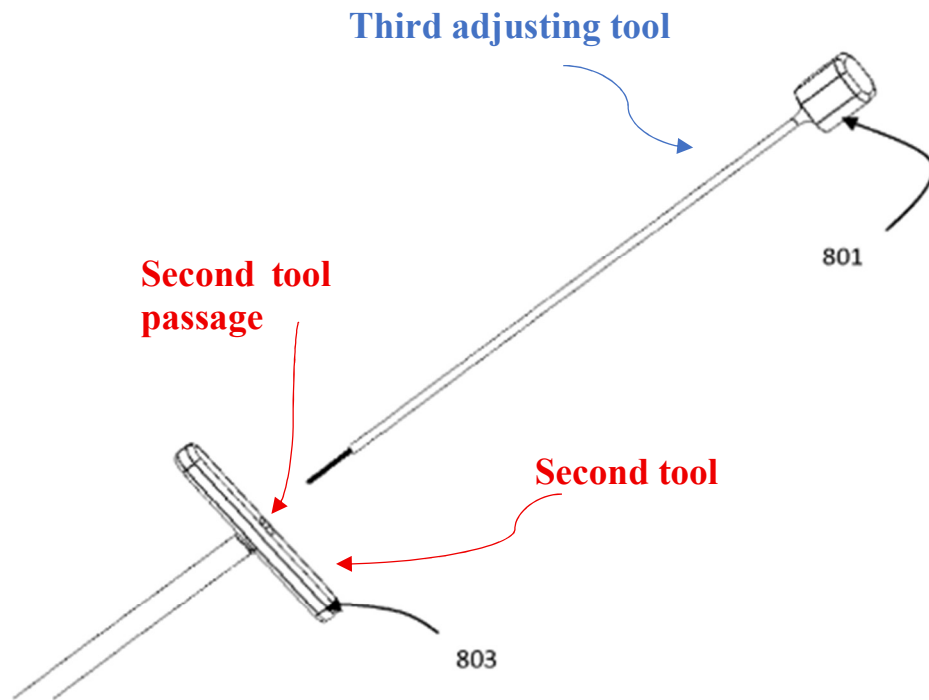


Fig. 8E

Ex. 1001, Fig. 8E

And Figures 8F-8G illustrate how the second tool fits within the first tool passage of the first tool. *Id.* at Figs. 8F-8G.

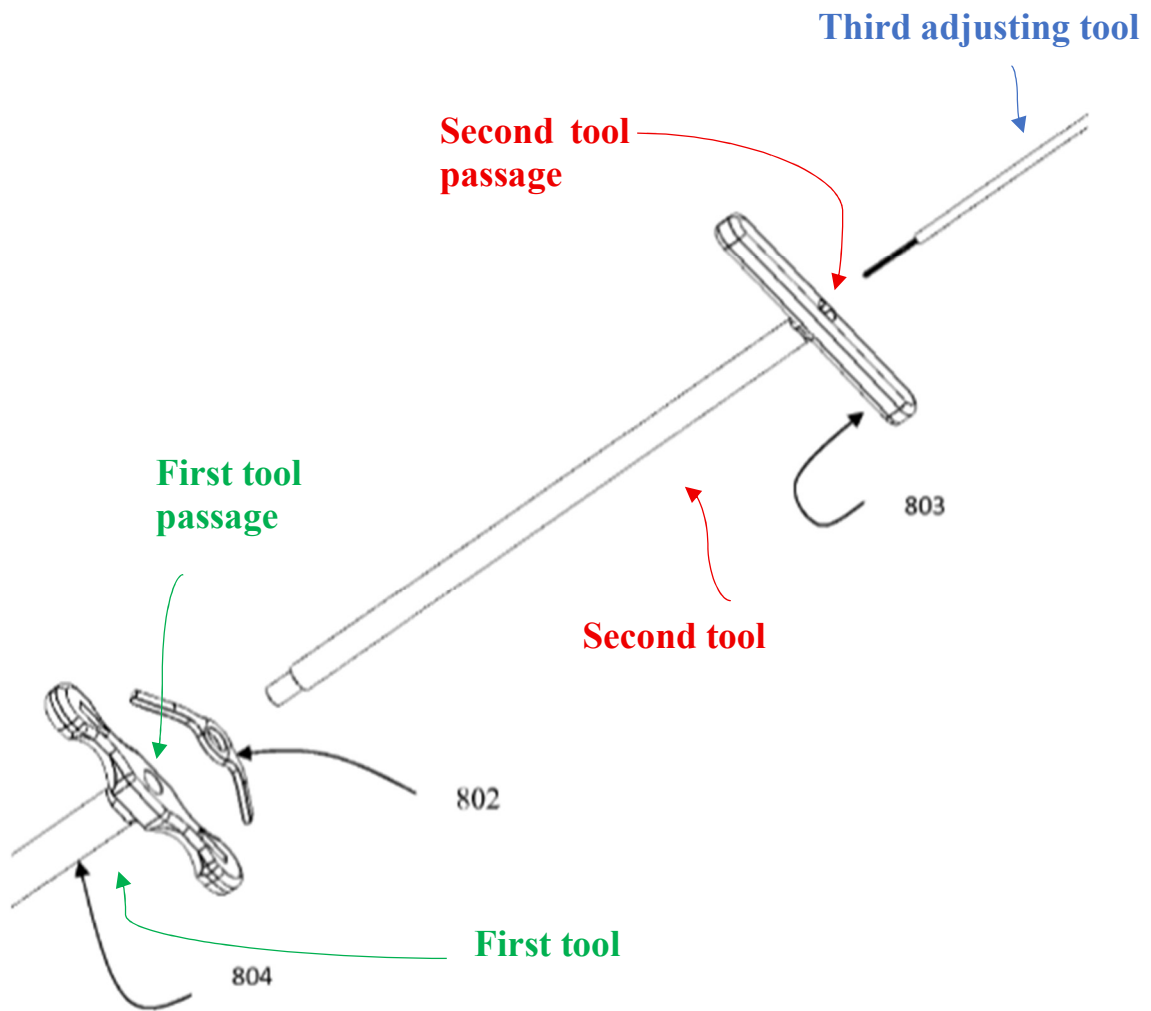


Fig. 8F

Ex. 1001, Fig. 8F

Accordingly, the plain language and intrinsic record confirm that the first tool, second tool, and third adjusting tool are separate tools arranged in a nesting configuration, not subcomponents of a single device.

V. GROUND 1: MCLUEN IN VIEW OF MICHELSON FAILS TO ESTABLISH OBVIOUSNESS OF CLAIMS 16 & 19

Petitioner fails to carry its burden on Ground 1.

A. Petitioner Fails to Establish a Proper Motivation to Combine McLuen and Michelson.

The Petition does not establish a reasoned motivation to combine McLuen and Michelson. McLuen already identifies and solves the slippage concern on which Petitioner relies. The only “gap” Petitioner identifies in McLuen is the absence of an illustration—not the absence of a technological solution. And the proposed pivot to Michelson is unsupported by any identified deficiency in McLuen’s disclosure. At bottom, the combination is claim-driven, not problem-driven, and the Petition does not demonstrate a reasonable expectation of success.

1. McLuen already solves the identified slippage concern and provides no reason to look to Michelson.

Petitioner shows no technological gap in McLuen that would have prompted a POSITA to look to Michelson. Petitioner contends that a POSITA would have been motivated to use Michelson’s tool assembly with McLuen’s implant to prevent tool slippage during expansion. Pet. at 24. But McLuen expressly recognizes that concern and immediately provides its own solution:

Screw drivers unfortunately have the ability to slip out of place. When performing surgery near someone's spine, it is preferable to prevent or at least minimize the slipping ability. To do so, channels 1522 are implemented to receive a tool (not shown). The tool (not shown) has attachments that fit within the channels 1522 to secure the tool (not shown) in place.

Ex. 1012 at 76–77.

McLuen thus discloses a keyed attachment-channel interface specifically configured to prevent or minimize slippage during actuation of positioning means 1508. Petitioner does not contend that this solution is inadequate, incomplete, or incapable of practice.

The only deficiency Petitioner identifies in McLuen is the absence of an illustration—not the absence of a technological solution. Petitioner asserts that “McLuen . . . does not illustrate its complete tool assembly.” Pet. at 21. But Petitioner does not argue that the absence of an illustration renders McLuen inoperable or unusable. Nor does Petitioner criticize McLuen’s disclosed attachment-channel tool engagement structure. The only articulated deficiency is the lack of a drawing—not the lack of a technological solution.

McLuen’s background further undermines any suggestion that a POSITA would pivot to Michelson. McLuen discusses prior “fusion cage devices” and expressly references earlier Michelson work describing “a fusion implant

comprising a cylindrical member having a series of threads on the exterior of the cylindrical member for engaging the vertebrae to maintain the implant in place and a plurality of openings in the cylindrical surface.” Ex. 1012 ¶ 6; *see id.* ¶¶ 3–12. The Michelson reference relied upon in the Petition is directed to similar threaded cylindrical implants. *E.g.*, Ex. 1014, Figs. 41–68. McLuen distinguishes such devices, yet Petitioner offers no explanation why a POSITA starting from McLuen would reverse course and turn to Michelson’s tool assembly.

Without identifying a technological shortcoming in McLuen, Petitioner turns to Michelson because it provides illustrated components that can be arranged to track claim 16. That is not a reasoned motivation to combine; it is hindsight. *See ActiveVideo Networks, Inc. v. Verizon Commc’ns, Inc.*, 694 F.3d 1312, 1327 (Fed. Cir. 2012) (rejecting conclusory motivation based on the “modular” nature of references and hindsight reasoning).

2. The proposed modifications to Michelson mirror McLuen’s already described tools and is driven by the structure of Claim 16.

Even if a POSITA were to consult Michelson, Petitioner’s theory still fails because the proposed modifications merely recreate what McLuen already discloses and supply no identified technological improvement.

Michelson does not provide any technological improvement over McLuen. Petitioner asserts that Michelson “offers the advantage of a tool assembly that can

both deliver the implant to its desired location and securely expand it when the implant is in position.” Pet. at 24. But Petitioner does not contend that McLuen’s disclosed screwdriver and attachment-channel engagement interface lack those capabilities. Nor does Petitioner identify any deficiency in McLuen that Michelson purportedly corrects. The Petition identifies no technological improvement that Michelson’s modified tool would provide over McLuen’s own solution.

Instead, Petitioner proposes reshaping Michelson to duplicate what McLuen already teaches. First, Petitioner argues that a POSITA would have “shaped Michelson’s tip 14 like a screw driver so it can expand McLuen’s implant.” Pet. at 25. But McLuen already discloses turning “the positioning means 1508” with a screwdriver to expand the implant. Ex. 1012 at 74–76. Petitioner does not explain why a POSITA would be motivated to locate a different tool and modify it to perform the same turning function McLuen already discloses.

Modifying Michelson’s holding mechanism to engage McLuen’s outer-wall channels would merely duplicate what McLuen already discloses. Petitioner argues that a “POSITA would have modified Michelson’s holding mechanism (e.g., side extensions 530 on the distal end of holder 500)” to have prongs that engage channels 1522 located on the outer wall of McLuen’s implant. Pet. at 27–28. But McLuen already discloses a tool with “attachments that fit within the channels 1522 to secure the tool” during actuation. Ex. 1012 at 76. Petitioner does not explain why a POSITA

would replace McLuen's disclosed attachment-channel engagement interface with a redesigned Michelson holder that performs the same securing function.

With these modifications, the alleged combination does not improve upon McLuen; it recreates it. The only discernible benefit is that the modified Michelson components can be mapped onto the separately recited tools of claim 16. That is not a technological rationale for combination—it is a claim-driven one.

Petitioner's motivation analysis is also limited to element 16.c. For elements 16.d, 16.e, 16.f, 16.g, 16.h, and 16.i, Petitioner relies on Michelson's teachings without explaining if, how, or why those additional structural features would be incorporated into the proposed combination—particularly after the substantial modifications Petitioner contends are required to adapt Michelson's holder to McLuen's implant. Petitioner acknowledges that Michelson's outer sleeve 504 would need to be modified. Pet. at 27–28. Michelson's teachings therefore cannot be applied wholesale.

An obviousness analysis must address the claim as a whole and must demonstrate both a motivation to combine and a reasonable expectation of success. Petitioner provides no articulated rationale—and no explanation of how the modified system would operate as a cohesive whole—to arrive at claim 16 in its entirety. That same deficiency necessarily infects dependent claim 19.

3. The proposed redesign undermines Michelson's integrated holding mechanism.

Petitioner's proposed modification does not merely supplement Michelson—it alters the way Michelson's holder assembly operates. Michelson's implant holder 500 secures its implant through coordinated interaction between shaft 502 and outer sleeve 504. As Michelson explains:

As shown in FIGS. 19 and 20, the distal end of implant holder 500 is inserted into trailing end 104 of implant 100 such that flanges 532 of outer sleeve 504 are positioned for engagement with slots 126 of implant 100. In FIG. 20, shaft 502 is moved to an extended position within outer sleeve 504 by linearly advancing reduced portion 510 of shaft 502 through outer sleeve 504. This allows shoulder 514 to contact ramp portion 538 of each side extension 530 and force apart each side extension 530 until flanges 532 engage slots 126 of implant 100 to engage outer sleeve 504 to implant 100.

Ex. 1014 at 14:65–15:17; *see also id.* at 12:53–59, 13:14–19.

The purpose of shaft 502 is thus to force apart the side extensions of outer sleeve 504 to achieve internal engagement with implant 100. When the shaft is retracted, the side extensions collapse inward to permit disengagement. *Id.* at 17:65–18:2. Shaft-driven expansion and contraction of the side extensions is the mechanism by which Michelson's holder engages and releases the implant.

Redesigning Michelson's holding mechanism to engage outer-wall channels would fundamentally change how Michelson's holder operates. Petitioner proposes modifying Michelson's holding mechanism "to have prongs that could engage channels 1522 located on an outer wall of McLuen's implant." Pet. at 27–28. That proposed redesign changes the nature of engagement from internal expansion into inwardly facing slots to external engagement with outer-wall channels.

Petitioner does not explain how Michelson's shaft 502 would continue to function under that altered configuration. If engagement no longer depends on forcing side extensions outward into internal slots, the role of shaft 502 in driving that expansion becomes unclear. Nor does Petitioner address how the holder would achieve disengagement consistent with Michelson's described operation.

A proposed modification is improper where it renders the prior art reference inoperable for its intended purpose. *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992); *see also* MPEP § 2143.01(V–VI). Michelson's holder assembly is expressly designed around shaft-driven internal engagement. Petitioner provides no explanation of how the redesigned structure would preserve that mode of operation.

Michelson's cited "adapted" language does not support external prong engagement. Petitioner attempts to rely on Michelson's statement that "the implant holder may be adapted so that the side extensions may be forced toward one another to lock the implant to the implant holder." Pet. at 28; Ex. 1014 at 15:8–13. But the

very next sentence states that “[s]uch an embodiment is described below with relation to FIG. 67.” Ex. 1014 at 15:12–13.

Figure 67 describes a different holder embodiment (implant holder 1800) with flanges 1820 that are forced toward one another and *then released* to outwardly expand and engage inwardly facing slots 1752 of implant 1700. Ex. 1014 at 25:32–55; Fig. 67. That embodiment still relies on internal engagement with inwardly facing slots—not engagement with outer-wall channels like McLuen’s. Moreover, implant holder 1800 is materially different from implant holder 500, on which Petitioner otherwise relies, and Petitioner provides no motivation to combine these disparate embodiments.

Petitioner’s reference to other instruments with “mechanisms like prongs or arms that secured the outer sides of the implant during delivery” does not cure this defect. Pet. at 28. Petitioner does not explain how such unspecified instruments would resolve the incompatibilities described above, nor does Petitioner rely on those instruments in any ground of unpatentability.

Thus, Petitioner’s proposed redesign would alter the way Michelson’s holder achieves engagement and disengagement, yet the Petition provides no explanation of how the modified structure would operate consistently with Michelson’s described mechanism, which Petitioner continues to rely upon for later claim elements. Without a supported rationale showing that the redesigned system would

remain operable for its intended purpose—and without a reasoned motivation to make that redesign—the asserted combination fails.

The Petition’s theory therefore depends on reshaping Michelson to mirror McLuen while stripping Michelson’s holder of the mechanism that makes it work—an unsupported, claim-driven reconstruction.

B. McLuen in View of Michelson Fails to Disclose, Teach, or Suggest the Three Distinctly Claimed Tools.

Institution should also be denied because the asserted references do not disclose, teach, or suggest the three distinct tools recited in claim 16. In its only asserted ground, Petitioner does not rely on McLuen to satisfy any of the claimed tool limitations. *See* Pet. at 21–41. Although McLuen discloses both a screwdriver and a tool configured to engage channels 1522 of its implant, Petitioner does not contend that those tools correspond to the claimed first tool, second tool, or third adjusting tool. Instead, Petitioner relies entirely on Michelson to supply all three recited tools. *Id.* Ground 1 therefore rises or falls on whether Michelson discloses three distinct tools as claimed. It does not.

Michelson discloses only two tools: an implant holder 500 and an expander driver 600. Petitioner nevertheless divides Michelson’s implant holder into two separate tools by treating outer sleeve 504 as one tool and shaft 502 as another. But Michelson expressly describes shaft 502 and outer sleeve 504 as components of the

same implant holder 500—not as separate instruments. Ex. 1014 at 12:45–46 (“Implant holder 500 has a shaft 502 and an outer sleeve 504.”).

Michelson explains that shaft 502 is operatively coupled to outer sleeve 504 via an outwardly extending peg 516 disposed within L-shaped slot 540 of the outer sleeve. *Id.* at 12:64–67; Figs. 15–16. Because peg 516 is captured within slot 540, shaft 502 may move only within the constraints of that slot and cannot be removed from outer sleeve 504 without disengaging or breaking the peg. *See id.* at 15:14–21 (“shaft 502 is rotated relative to outer sleeve 504 such that peg 516 moves to a locked position within L-shaped slot 540 of outer sleeve 504, thereby locking shaft 502 into an extended position within outer sleeve 504” so that “implant holder 500 [is] lockably engaged to implant 100”); 17:63–65 (“Shaft 502 of the implant holder 500 is then rotated relative to outer sleeve 504 to move peg 516 into an unlocked position in L-shaped slot 540.”).

Michelson thus discloses a single implant holder assembly comprised of mechanically interlocked components—not two distinct, independently usable tools.

Michelson further confirms that shaft 502 and outer sleeve 504 function cooperatively to perform the single purpose of implant holder 500—engaging and disengaging the implant. As Michelson explains, shaft 502 is advanced within outer sleeve 504 so that shoulder 514 contacts ramp portions 538 of the side extensions 530, forcing those extensions outward until flanges 532 engage slots 126 of implant

100. Ex. 1014 at 15:1–8. When shaft 502 is retracted, the side extensions collapse inward, allowing implant holder 500 to be separated from implant 100. *Id.* at 17:65–18:2. Shaft-driven expansion and contraction of the sleeve’s side extensions is the mechanism by which the holder secures and releases the implant.

Because shaft 502 is mechanically interlocked with outer sleeve 504 and operates only in coordination with it to achieve engagement and disengagement, Michelson does not disclose two separate tools. It discloses a single implant holder assembly composed of interdependent components. Petitioner’s characterization of shaft 502 as a distinct “second tool” and outer sleeve 504 as a separate “first tool” depends on disaggregating a unified instrument into subcomponents.

Without that division, Michelson discloses only two tools: the implant holder 500 and the expander driver 600. It therefore does not disclose, teach, or suggest the three distinct tools recited in claim 16. Because claim 16 is not met, dependent claim 19 likewise cannot be met. The Petition thus does not demonstrate a reasonable likelihood of prevailing on Ground 1.

VI. PETITIONER’S EXPERT DECLARATION DOES NOT CURE THE PETITION’S STRUCTURAL DEFECTS

The deficiencies in the Petition are not remedied by Petitioner’s expert declaration (Ex. 1002).

Petitioner relies heavily on the Declaration of Brad Culbert as purported technical support for its obviousness theory. But expert testimony must provide

reasoned technical analysis grounded in the record—not merely restate attorney argument. 37 C.F.R. § 42.65(a); *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 19–20 (PTAB Aug. 24, 2022) (precedential) (expert testimony lacking sufficient factual support is entitled to little weight).

Here, the declaration does not supply independent engineering analysis addressing the structural gaps identified above. Instead, it largely mirrors the Petition’s limitation-by-limitation mapping, repeating the same conclusions that the prior art “discloses” the claimed features without explaining how the cited structures satisfy the specific mechanical requirements of the claims.

A comparison of the Petition and Ex. 1002 confirms the overlap. The Petition’s background and detailed explanation of grounds track the same limitation-by-limitation structure and substantive content contained in the declaration’s corresponding sections and appendices. *See, e.g.*, Pet. §§ VI, IX; Ex. 1002 §§ V, VIII, Appendix. The declaration does not meaningfully expand upon those assertions with additional technical reasoning.

That omission matters. The disputed issues here are structural and mechanical. Whether the prior art discloses three distinct tools arranged in a nested configuration is not established by quotation alone. It requires explanation of mechanical interaction, structural relationships, and expected operation—particularly where

Petitioner's theory depends on treating interlocked components of a unitary holder assembly as separate tools.

Yet Ex. 1002 primarily cites passages from the prior art followed by conclusory statements that the limitation is "disclosed," in the same manner as the Petition. *Compare, e.g.,* Pet. at 18–20 *with* Ex. 1002 ¶¶ 58–60. The declaration likewise repeats the same asserted motivation to combine without supplying additional technical analysis. *Compare* Pet. at 21–29 *with* Ex. 1002 ¶¶ 61–72.

Because the declaration does not independently address the structural deficiencies in Michelson, the absence of three distinct tools, or the lack of a supported motivation to combine, it does not cure the Petition's failure of proof. Without that evidentiary support, Petitioner has not demonstrated a reasonable likelihood of prevailing on any challenged claim.

VII. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Director deny institution of the Petition.

Date: February 20, 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

CERTIFICATE OF COMPLIANCE WITH WORD COUNT

I certify that this paper complies with the type-volume limitations of 37 C.F.R. §42.24(b)(1) because it contains 4,770 words (determined by the word-processing system used to prepare this paper), excluding the parts of the paper exempted by 37 C.F.R. §42.24(a).

Date: February 20, 2026

Respectfully submitted,

/Eric A. Zelepugas/

Eric A. Zelepugas

Registration No. 73,302

Lead Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S PRELIMINARY RESPONSE** was served electronically via e-mail on February 20, 2026, in their entirety on the following counsel of record for Petitioner:

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

Date: February 20, 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