

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,
Petitioner,
v.

MOSKOWITZ FAMILY LLC,
Patent Owner

IPR2026-00162
Patent No. 12,011,367

**PATENT OWNER’S SURREPLY IN SUPPORT OF PATENT OWNER
PRELIMINARY RESPONSE**

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Patent Trial and Appeal Board
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Cases

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<i>Tesla, Inc. v. Intellectual Ventures II LLC</i> , IPR2025-00340, Paper 18(Director Nov. 5, 2025)	5

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 (parent of the '367 patent) in Medtronic U.S. Patent Application No. 17/246,968 (May 3, 2021)
2011	Information Disclosure Statement citing '293 patent (great-great-great-great-grandparent of the '367 patent) in Medtronic U.S. Patent Application No. 17/246,968 (May 3, 2021)
2012	Notice of References Cited in Notice of Allowance citing earlier publication (U.S. Pat. App. Pub. No. 2008/0033440) of '903 patent (great-great-great-great-great-grandparent of the '367 patent) in Medtronic U.S. Patent Application No. 13/440,241 (September 3, 2015)
2013	Patent Trial And Appeal Board Standard Operating Procedure 1 (Revision 16) Assignment Of Judges To Panels
2014	<i>Intentionally Left Blank</i>
2015	<i>Intentionally Left Blank</i>
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	Second Amended Complaint, <i>Moskowitz Family LLC v. Medtronic, Inc. et. al.</i> , No. 0:25-CV-00769-PJS-DLM, ECF No. 48 (Dist. Of

	Minn. January 29, 2026)
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	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.)
2024	Declaration of Dr. Nathan C. Moskowitz
2025	Email correspondence between inventors Andy Moskowitz and Eric Sugalski regarding new prototyping project, dated April 11, 2011
2026	Certified File Wrapper for U.S. Patent No. 8,353,913
2027	Email correspondence between inventors Eric Sugalski, Andy Moskowitz, and David Schoon regarding wedge fusion device, dated May 3, 2011
2028	Email correspondence between inventors Eric Sugalski, Andy Moskowitz, and David Schoon regarding fusion devices, dated May 5, 2011
2029	Email correspondence between inventors Eric Sugalski, Andy Moskowitz, and David Schoon regarding fusion device prototyping, dated May 18, 2011

2030	Email correspondence between inventors Eric Sugalski and Andy Moskowitz regarding fusion device prototype revisions, dated May 19, 2011
2031	Email correspondence between inventors Eric Sugalski, Andy Moskowitz, and David Schoon regarding fusion device e-drawings, dated May 23, 2011
2032	Email correspondence between inventors Nathan Moskowitz, Andy Moskowitz, and Eric Sugalski regarding fusion device screws, dated May 25, 2011
2033	Email correspondence between inventors Eric Sugalski, Nathan Moskowitz, Andy Moskowitz, and David Schoon regarding design updates, dated May 31, 2011
2034	Email correspondence between inventors Nathan Moskowitz and Eric Sugalski confirming design updates, dated June 1, 2011
2035	Email correspondence between inventors Nathan Moskowitz and Eric Sugalski instructing prototyping to proceed, dated June 1, 2011
2036	Email correspondence between inventors Eric Sugalski and Nathan Moskowitz regarding design length, dated June 3, 2011
2037	Email correspondence between inventors Eric Sugalski, Nathan Moskowitz, and David Schoon regarding prototype pictures, dated June 22, 2011
2038	Email correspondence between inventors Eric Sugalski, Nathan Moskowitz, and Andy Moskowitz regarding prototype updates, dated July 24, 2011
2039	Email correspondence between inventors Eric Sugalski, Nathan Moskowitz, and Andy Moskowitz regarding prototype expansion

	evaluation, dated July 25, 2011
2040	Email correspondence between inventors Nathan Moskowitz, Eric Sugalski, and Andy Moskowitz regarding prototype expansion via screwdrivers, dated August 8, 2011
2041	Email correspondence between inventors Andy Moskowitz and Nathan Moskowitz regarding draft claims, dated October 11, 2011
2042	Email correspondence between inventors Nathan Moskowitz and Andy Moskowitz regarding expandable cage claims, dated November 7, 2011
2043	Email correspondence from inventor Andy Moskowitz requesting edrawings, dated November 11, 2011
2044	Email correspondence from inventor Andy Moskowitz detailing requested edrawings, dated November 13, 2011
2045	Email correspondence to inventor Andy Moskowitz with requested edrawings, dated January 2, 2012
2046	Email correspondence between inventors Andy Moskowitz and Nathan Moskowitz regarding received edrawings, dated January 2, 2012
2047	Email correspondence to inventor Andy Moskowitz regarding machining company inquiry, dated April 11, 2012
2048	Inventor calendar blocked out for prototyping, dated August 17, 2012
2049	Email correspondence from inventor Nathan Moskowitz to patent attorney regarding examiner interview, dated February 21, 2012 (attorney-client privilege portions redacted)
2050	Email correspondence from patent attorney to inventor Nathan

	regarding examiner interview, dated March 11, 2012
2051	Email correspondence between patent attorney and inventor Nathan regarding notice of allowance, dated September 13, 2012
2052	Email correspondence between inventors Andy Moskowitz and Eric Sugalski regarding keeping fusion device confidential until patenting, dated September 25, 2012
2053	File History for U.S. Provisional Patent Application No. 61/718,707, filed October 25, 2012
2054	Calendar of Dr. Nathan Moskowitz between March 1, 2012 and October 19, 2012 (irrelevant patient-identifying information redacted to comply with patient privacy laws)
2055	Dr. Nathan Moskowitz Emergency on Call Calendar for June, July, August, and December 2012
2056	Email correspondence between inventors Andy Moskowitz and Eric Sugalski regarding CAD drawings, dated April 15, 2011
2057	Email correspondence between inventors Nathan Moskowitz, Andy Moskowitz, and Eric Sugalski regarding maintaining ridges, dated April 17, 2011
2058	Email correspondence between inventors Andy Moskowitz and Eric Sugalski regarding side notches in final diagram, dated April 17, 2011
2059	Email correspondence between inventors Nathan Moskowitz and Eric Sugalski stressing importance of ridges and side notches, dated May 28, 2011
2060	Email correspondence between inventors Eric Sugalski and Nathan Moskowitz regarding prototype shipping, dated July 6, 2011

2061	Medtronic’s Memorandum of Law in Support of Motion to Stay, <i>Moskowitz Family LLC v. Medtronic, Inc. et. al.</i> , No. 0:25-CV-00769-PJS-DLM, ECF No. 61 (Dist. Of Minn. February 20, 2026)
2062	Moskowitz’ Opposition to Medtronic’s Motion to Stay, <i>Moskowitz Family LLC v. Medtronic, Inc. et. al.</i> , No. 0:25-CV-00769-PJS-DLM, ECF No. 65 (Dist. Of Minn. February 27, 2026)
2063	Transcript of Motion to Stay Hearing, <i>Moskowitz Family LLC v. Medtronic, Inc. et. al.</i> , No. 0:25-CV-00769-PJS-DLM (Dist. Of Minn. March 6, 2026)

Palmatier is not prior art to the '367 Patent, which renders the Petition moot. In the POPR, Patent Owner established (1) conception prior to Palmatier's filing date and (2) diligent reduction to practice through its provisional filing date, based on contemporaneous documentary evidence and corroborated inventor testimony.

Petitioner's arguments rest on the flawed premise that every claimed feature must appear in a single embodiment or depiction. That is not the law and misrepresents how a POSITA would understand the record. The documentary evidence shows expandable implants, including wedge-driven configurations, and identifies ridges as important features intended for incorporation into those designs.

Petitioner also distorts Patent Owner's claim construction argument. The point is not whether constructions exist, but that Petitioner is strategically withholding them in the District Court to avoid adverse consequences here. Shielding material positions in one forum to influence the outcome in another supports denial.

I. CONCEPTION AND REDUCTION TO PRACTICE PROVED PRIOR TO INSTITUTION CAN RESULT IN PETITION DISMISSAL

Petitioner alleges that antedating arguments cannot be resolved pre-institution. Paper 11 at 1, 4. But prior Boards have done so, even without declarant cross-examination. *Roofr Inc. v. Eagle View Technologies, Inc.*, IPR2023-00437, Paper 14 at 13-15 (PTAB Aug. 1, 2023); *Par-Kan Company, LLC v. Unverferth Manufacturing Company*, IPR2024-01426, Paper 10 (PTAB Mar. 19, 2025). Because the evidence establishes conception and reduction to practice before

Palmatier’s filing date, there is no reasonable likelihood that Palmatier is prior art.

II. MOSKOWITZ PROVED PRIOR CONCEPTION

Patent Owner established conception through contemporaneous documentary evidence and inventor testimony. The record includes drawings depicting expandable implants, including a wedge-driven one, and emails detailing the implant features. Ex. 2027. Those emails expressly discuss adding “ridges” to the implant surfaces and the benefits thereof. Ex. 2057 (“need to maintain something like ridges to help engage bone”); Ex. 2028 at 1 (“[r]idges will also be placed on the top and bottom surfaces of the fusion wedges to maintain grip while inserted into spinal region”); Ex. 2059 (“[t]he ridges are very important for bone integration”). Dr. Moskowitz’s testimony further shows that ridges were contemplated across expandable implants. Ex. 2024 ¶¶ 15, 19–22, 28–34, 38–39, 41–42.

Petitioner argues that the modified-wedge drawing lacks ridges and that the discussions of ridges are untethered to that drawing. But conception does not require every claimed feature to appear in a single depiction. It is evaluated based on the record and is complete once the invention is sufficiently definite for a POSITA to reduce it to practice without undue experimentation. *Spansion, Inc. v. Int’l Trade Comm’n*, 629 F.3d 1331, 1356 (Fed. Cir. 2010); *Medtronic, Inc. v. Teleflex Innovations S.À.R.L.*, 68 F.4th 1298, 1307 (Fed. Cir. 2023); *Burroughs Wellcome Co. v. Barr Labs., Inc.*, 40 F.3d 1223, 1228 (Fed. Cir. 1994).

Here, the drawings disclose expandable implants, including wedge-based expansion mechanisms, while the contemporaneous emails expressly describe ridges, their function, and their importance in the expandable designs. Read together, these disclosures would inform a skilled artisan that the ridges are intended for use with the disclosed expandable devices—not confined to a particular embodiment. And Petitioner does not contend that incorporating ridges into the disclosed expandable designs would require anything beyond ordinary skill.

Petitioner’s reliance on *Apator* is equally misplaced. There, the emails lacked attachments or disclosure of their contents, so the alleged conception depended entirely on the inventor’s later testimony. *Apator Miitors ApS v. Kamstrup A/S*, 887 F.3d 1293, 1296–97 (Fed. Cir. 2018). Here, by contrast, the emails include the attachments and describe the devices and features—including ridges—along with identifying information (sender, recipient, dates, subject, and attachment name). The emails and drawings speak for themselves, require no separate corroboration, and establish conception. They also corroborate Dr. Moskowitz’s testimony.

III. MOSKOWITZ PROVED REDUCTION TO PRACTICE

Petitioner does not dispute diligence, but argues no reduction to practice based on the absence of ridges in Figures 6A-6D and asserts that the disclosed ridges are for “a totally different device.” Paper 11 at 4-5. But the question is whether the provisional as a whole conveys possession of the claimed invention—not whether a

single embodiment or figure shows all features. *Hologic, Inc. v. Smith & Nephew, Inc.*, 884 F.3d 1357, 1362, 1364 (Fed. Cir. 2018).

A skilled artisan would understand that the ZP-EIS embodiments are variations within the same class of inventions and that disclosed features can be applied across them. The provisional consistently describes all embodiments, including Figures 6A-6D and the embodiment Petitioner labels “totally different,” as “Zero-Profile Expandable Intervertebral Spacer (ZP-EIS) devices.” Ex. 2053 at, e.g., ¶¶ 3-10, 19. It further discloses shared benefits, tools, and surgical methods applicable to all ZP-EIS embodiments. *Id.* at ¶¶ 38-49.

The provisional further explains that “[a]ll the ZP-EIS embodiments ... may obviate the need for supplemental pedicle screw fixation” and “promot[e] segmental spinal fusion.” *Id.* ¶¶ 6, 9. It also discloses ridges that “facilitate[] the ZP-EIS device ... incorporation into and fusion with the superior and inferior vertebral bodies.” *Id.* ¶¶ 23, 26. Nothing in the provisional limits these known, fusion-promoting features to a subset of the embodiments. To the contrary, a skilled artisan would understand ridges as a conventional structural feature for enhancing fusion and therefore applicable across ZP-EIS embodiments designed for that purpose.

The provisional further describes ZP-EIS devices as “a continued evolution of [] zero-profile ... spacers described in our previous patents and co-pending patent applications,” and incorporates those disclosures by reference, including devices

with ridges. *Id.* ¶¶ 1-2, 8, 10; *see Paice LLC v. Ford Motor Co.*, 881 F.3d 894, 907–08 (Fed. Cir. 2018) (disclosures incorporated by reference provide written description support). Taken together, the provisional reasonably conveys possession of ZP-EIS embodiments, including the Figure 6 embodiment, with ridges.

IV. PETITIONER’S GAMESMANSHIP SUPPORTS PETITION DENIAL

Petitioner tells the Board that claim construction is unnecessary, yet admits in District Court that its invalidity theories depend on competing constructions. *Compare* Pet. at 21 (“[t]he Board need not construe any claims”) *with* Ex. 2063 at 21 (“In a typical world, we would put down our invalidity theories under [multiple constructions], but now doing that might well result in the USPTO director deciding we have been inconsistent and deciding not to institute our IPRs.”). Rather than stand on its purported position, Petitioner sought multiple extensions and a stay to delay disclosure of its constructions. Exs. 2002-2003, 2005, 2063 at 2. This is a strategic effort to withhold material positions from the Board to avoid an adverse ruling.

Petitioner’s reliance on *Samsung* is misplaced. *Samsung* excuses construction only where it is immaterial to the dispute. Here, Petitioner admits its invalidity contentions hinge on claim construction. Ex. 2063 at 19-23. Petitioner is strategically withholding material constructions to avoid *Revvo* or *Tesla*. This gamesmanship—shielding dispositive positions in one forum to evade Director precedent in another—should not be rewarded. The Board should deny institution.

Date: April 17, 2026

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S SURREPLY IN SUPPORT OF POPR** and associated exhibit (Exhibit 2063) were served electronically via e-mail on April 17, 2026, in their entireties on the following counsel of record for Petitioner:

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