

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,
Petitioner

v.

MOSKOWITZ FAMILY LLC,
Patent Owner.

Case IPR2026-00163
Patent No. 11,376,136

PETITIONER'S DISCRETIONARY DENIAL OPPOSITION

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Exhibit No.	Document	Previously Submitted
Ex. 1001	U.S. Patent No. 11,376,136 to Moskowitz et al. (“the ’136 patent”)	X
Ex. 1002	Declaration of Brad Culbert	X
Ex. 1003	Curriculum Vitae of Brad Culbert	X
Ex. 1004	File History for U.S. Patent No. 11,376,136	X
Ex. 1005	RESERVED	
Ex. 1006	U.S. Patent Application Publication No. 2008/0249569 A1 to Waugh et al. (“Waugh”)	X
Ex. 1007- Ex. 1011	RESERVED	
Ex. 1012	U.S. Patent Application Publication No. 2006/0253201 A1 to McLuen (“McLuen”)	X
Ex. 1013	U.S. Patent Application Publication No. 2005/0278026 A1 to Gordon et al. (“Gordon”)	X
Ex. 1014	International Publication No. WO 02/062272 A2 to Michelson (“Michelson”)	X
Ex. 1015- Ex. 1019	RESERVED	
Ex. 1020	Phulchand Prithvi Raj, <i>Intervertebral Disc: Anatomy-Physiology-Pathophysiology-Treatment</i> , 8(1) PAIN PRACT. 18 (2008)	X

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Ex. 1021	Fabio Galbusera et al., <i>Ageing and degenerative changes of the intervertebral disc and their impact on spinal flexibility</i> , 23(3) EUR. SPINE J. 324 (2014)	X
Ex. 1022	Dil Patel et al., <i>Interbody options in lumbar fusion</i> , 5(1) J. SPINE SURG. S19 (2019)	X
Ex. 1023- Ex. 1036	RESERVED	
Ex. 1037	Daniel Orr et al., <i>Expandable interbody cages for lumbar spinal fusion: a systematic review</i> , 25(8) SPINE J. 1773 (2025)	X
Ex. 1038- Ex. 1039	RESERVED	
Ex. 1040	Amended Complaint, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Minn. filed May 23, 2025), Dkt. 27.	
Ex. 1041	Answer to Amended Complaint, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Minn. filed June 27, 2025), Dkt. 29.	
Ex. 1042	Sotera Stipulation, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Minn. filed Jan. 6, 2026), Dkt. 41.	
Ex. 1043	Second Amended Complaint, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Minn. filed Jan. 29, 2026), Dkt. 48.	

Exhibit No.	Document	Previously Submitted
Ex. 1044	Plaintiff's Responses to Defendants' First Set of Interrogatories (Nos. 1-12), <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Minn. Jan. 5, 2026).	
Ex. 1045	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. 1046	Patent Owner's Request for Discretionary Denial, Paper 6 (December 8, 2025), <i>Medtronic, Inc. v. Moskowitz Family LLC</i> , IPR2025-01598	
Ex. 1047	RESERVED	
Ex. 1048	Time to Trial in Delaware District, Docket Navigator	
Ex. 1049	File History for U.S. Patent No. 10,478,319	
Ex. 1050	File History for U.S. Patent No. 10,307,268	
Ex. 1051	Petitioner's Discretionary Denial Opposition in IPR2026-00124	
Ex. 1052	RESERVED	
Ex. 1053	U.S. Patent No. 7,846,188 to Moskowitz et al. ("the '188 patent")	X

I. INTRODUCTION

Patent Owner Moskowitz Family LLC's ("Moskowitz") request for discretionary denial (Paper 6 ("DD Req.)) of this IPR involving U.S. Patent No. 11,376,136 ("136 patent") is largely premised on the same arguments it made in support of its discretionary denial request in a companion IPR involving related U.S. Patent No. 9,005,293 ("the '293 patent"). The Director considered those arguments and referred the IPR to the Board for an adjudication on the merits. *See* IPR2025-01598, Paper 9 at 2. The reasons for instituting this IPR are even stronger.

No Settled Expectations. The '136 patent issued in July 2022, less than three-and-a-half years before this IPR Petition was filed. Since the '136 patent "has not been in force for a significant amount of time," Medtronic's "[e]arly challenge favor[s] robust, predictable patent rights and weigh[s] against discretionary denial." *Google LLC v. Cellular South, Inc.*, IPR2025-00875, Paper 10 at 2 (Director Oct. 17, 2025) (denying request for discretionary denial of a 2021 issued patent).

Moskowitz's contention that Medtronic's knowledge of the ancestor patents (including the '293 patent) since 2015 creates "settled expectations" favoring a discretionary denial (DD Req., 2, 7-9) ignores Medtronic's express rejection of Moskowitz's demand to license the ancestor patents (among others) in January 2016. (Ex. 1040, ¶48; Ex. 1041, ¶48). That rejection is dispositive because Moskowitz did not take any action against Medtronic until 2025, while suing Medtronic's

competitors in the interim (*e.g.*, Globus in 2019, ZimVie in 2022). (DD Req., 6.) Moskowitz remained silent for a decade while Medtronic “continued to develop and commercialize” the allegedly infringing technology in that intervening time period. (Ex. 1046, 9-10.) Moskowitz’s *decade*-long silence following Medtronic’s express rejection negates any claim of settled expectations 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) (informative). Moreover, Moskowitz’s reliance on the ’293 patent (DD Req., 7-9) is misplaced, to say the least, given that the Director referred the ’293 patent for merits review.

Judicial Efficiency. The district court’s ready-for-trial date (February 2028) is eight months after the Board’s anticipated final written decision date, which “reduc[es] the risk of duplication of efforts and inconsistent outcomes.” *See Google*, Paper 10 at 2 (holding that a district court trial date three months after the anticipated final written decision date “counsel[s] against a discretionary denial”). While the ’136 patent is also at issue against another party (NuVasive) in Delaware, a February 2027 scheduled trial date in that case, which is only four 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).

Office Error. The ’136 patent issued because the Office overlooked relevant prior art that was before it during prosecution, in no small part due to Patent Owner burying those references in a series of Information Disclosure Statements (IDSs) totaling **410** references. Medtronic’s IPR challenges claims 9-12, 14-18, and 20—the claims of the ’136 patent asserted against Medtronic—on the following Grounds:

Ground 1: Anticipated and/or obvious over Gordon (Ex. 1013);

Ground 2: Obvious over McLuen (Ex. 1012) and Gordon;

Ground 3: Obvious over Gordon and Michelson (Ex. 1014); and

Ground 4: Obvious over McLuen, Gordon, and Michelson.

(Paper 1 (“Pet.”), 4.) While Gordon and McLuen were listed on an IDS, “[they were] not a basis for rejection during examination [and] include[] specific teachings that ‘impact patentability of the challenged claims,’” which is material error that warrants *inter partes* review. *Ecto World LLC v. RAI Strategic Holdings Inc.*, IPR2024-01280, Paper 13 at 5 (Director May 19, 2025) (precedential) (*quoting Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020) (precedential)). Additionally, Gordon and McLuen were buried amongst 410 references, more than sixteen times the size of a typical IDS. Nor did Moskowitz provide any “information or assistance regarding the relevance

of references” to the Examiner, which further confirms that “denial under § 325(d) is not warranted.” *Ecto World*, Paper 13 at 6-7. The record is also silent regarding the extent to which Gordon and McLuen were considered, as the Office did not provide any statement for reasons of allowance. Additionally, Michelson was not cited or considered during prosecution. Thus, the Office materially erred in allowing the challenged claims, and Section 325(d) does not bar review of this error.

Complexity of the parties’ dispute. The district court litigation involves 12 patents from numerous continuation-in-part applications (“CIPs”) covering diverse subject matter with different specifications, as demonstrated by their *varying priority dates* (see Ex. 1044, at 9-12). Institution is warranted because “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 at 3 (Director Aug. 29, 2025) (citing *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 at 2-3 (Director June 13, 2025) (informative)) (referring petitions where the parallel litigation involved 12 patents spanning 6 families).

IPR should be instituted for the above reasons, as explained further below.

II. MOSKOWITZ CANNOT CLAIM “SETTLED EXPECTATIONS”

The ’136 patent issued in July 2022 (Ex. 1001, Cover), less than three-and-a-half years before this IPR petition was filed in December 2025. Therefore, it has not been in force for a significant amount of time to create strong settled expectations of

patent validity. *See, e.g., Google*, IPR2025-00875, Paper 10 (denying request for discretionary denial for 2021 issued patent); *Webgroup Czech Republic, A.S. v. Dish Techs. LLC*, IPR2025-00467, Paper 14 at 2 (Director July 16, 2025) (finding that “Patent Owner has not developed strong settled expectations” in patents “issued in 2019, 2021, 2022, and 2023”). Nor has Moskowitz explained “how an extraordinary amount of investment, time, and resources dedicated to research, development, . . . correlates to [its alleged] settled expectations.” *Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00603, Paper 9 at 2 (Director July 24, 2025) (informative). (*See generally* DD Req., 4-10.)

Moskowitz’s reliance on Medtronic’s notice of “ancestor patents” (including the ’293 patent) does not support a discretionary denial. (DD Req., 4-5, 7-9.) To the contrary, Moskowitz’s reliance on these ancestor patents supports institution given that the ’293 patent was referred to the Board for merits review. If the ’293 patent is the barometer for settled expectations, then Moskowitz’s misconduct (including withholding key prior art during prosecution of the ’293 patent) and the clear Office error in issuing the ’293 patent, *see* IPR2025-01598, Paper 7, apply with equal force here and similarly warrant merits review of the ’136 patent.

Furthermore, settled expectations arising from the age of a parent patent do not necessarily carry over to a child patent; each patent is reviewed for settled expectations based on its own issue date. *See Tanklogix, LLC v. Sitepro, Inc.*,

IPR2025-00647, -00648, -00649, -00650, -00651, -00652, -00653, Paper 10 (July 31, 2025) (finding that U.S. Patent No. 10,488,871, which issued in 2019, did not have settled expectations even though its grandparent, U.S. Patent No. 9,342,078, issued in 2016 and had settled expectations). Moskowitz’s cited authority does not warrant a different conclusion because, in those cases, a younger patent avoided review for efficiency purposes, not due to settled expectations. (DD Req., 5, citing *Samsung Elecs. Co. v. iCashe, Inc.*, IPR2025-00641, Paper 12 at 3 (P.T.A.B. Aug. 14, 2025); *Amazon.com, Inc. v. Audio Pod IP, LLC*, IPR2025-00757, Paper 15 at 3 (Director Aug. 14, 2025).) For example, in *Amazon*, the Acting Director found that it “would be an inefficient use of Board resources” to review one out of six challenged patents when the other five challenged patents were subject to discretionary denials. *Amazon.com*, IPR2025-00757, Paper 15 at 3. Similar reasons were cited in denying review of two out of six challenged patents in *Samsung*. *Samsung*, IPR2025-00641, Paper 12 at 3. Here, no such efficiency reasons exist, as the ’293 patent was referred to the Board, and Medtronic’s challenges to nine out of twelve asserted patents are pending before the Office and the Director.

Moskowitz’s remaining arguments based on Medtronic’s notice of the older ’293 patent family are essentially the same as those considered by the Director in IPR2025-01598. (*Compare* DD Req., 4-10 *with* IPR2025-01598, Paper 6, 4-11.) As explained by Medtronic in the -01598 IPR, Medtronic, not Moskowitz, has settled

expectations with respect to the '293 patent and its progeny (like the '136 patent). 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.) Under *Apple* (designated as informative by the Director), Medtronic’s rejection of a license put the onus on Moskowitz to either sue or hold its peace. *Apple Inc.*, IPR2025-00856, Paper 11 at 3.¹ Yet Moskowitz chose not to sue Medtronic for almost 10 years after the January 2016 license refusal even though Medtronic continued to commercialize the allegedly infringing technology. (Ex. 1051, 7.) Moskowitz’s decision to sue Medtronic’s competitors (Globus in 2019 and ZimVie in 2022), but ignore Medtronic, *see* DD Req. 6, strengthened the expectation that Moskowitz would not sue Medtronic for infringement of the '293 patent or other patents from the '293 patent family.

¹ Moskowitz’s attempt at distinguishing *Apple* collapses under the weight of his own inconsistency. Specifically, Moskowitz argues that *Apple* is distinguishable because at the time of Medtronic’s license refusal in 2016, “the '136 patent had not issued, no infringement was alleged, and no accused products existed.” (DD Req., 8.) But if the '136 patent’s actual issue date and the alleged existence of the accused products are controlling factors, then Moskowitz cannot rely on older patents and communications to argue for settled expectations.

Medtronic’s knowledge of Moskowitz’s patent portfolio since 2015 (DD Req., 5-8) is not dispositive and does not create settled expectations for Moskowitz. Like the petitioner in *Apple*, Medtronic advised Moskowitz that it did not require a license, and Moskowitz then waited nearly a decade to sue despite continued commercialization, supporting Medtronic’s expectations of non-enforcement. *Apple Inc.*, IPR2025-00856, Paper 11 at 3.

Moskowitz’s arguments about meetings with Medtronic regarding purported “presentations” and “prototype demonstrations” before the ’136 patent issued, only backed by bare allegations in Moskowitz’s complaint, are unpersuasive. (DD Req., 5-6.) Moskowitz does not explain how any alleged “presentations” and “prototype demonstrations” relate to the scope of the challenged claims. Vague commercial discussions from over a decade ago, unmoored from the patent rights at issue, cannot give rise to any “settled expectations” of patent validity relevant to the ’136 patent.

III. THE FINTIV FACTORS STRONGLY FAVOR INSTITUTION

The *Fintiv* factors strongly favor institution.

A. Factor 1: Stay

Medtronic recently sought a stay of the parallel litigation. During an oral hearing on March 6, the magistrate judge denied Medtronic’s stay request without prejudice but expressly noted the Court will revisit the issue if Medtronic renews the motion following a decision on institution of one or more patents at issue in this

case.² Thus, depending on the Director's institution decisions in this and other cases, a stay is a likely possibility.

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

This factor strongly favors institution. Medtronic's Petition was accorded a filing date in December 2025 (*see* Paper 3), meaning the Board's final decision is due in June 2027. Meanwhile, the Minnesota Action is scheduled to be ready for trial eight months later, in February 2028 (*see* Ex. 2001, 16), which is earlier than the district's median time-to-trial. (Ex. 1045, 58.) Institution will allow the Board to issue a final decision at least eight months before any verdict in the district court.

A February 2027 trial date for the '136 patent in a Delaware Action involving a different party (NuVasive) (DD Req., 13-14) 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. 1045, 14) and 44 months for

² A formal transcript of the hearing is unavailable. Medtronic is willing to submit the transcript once it is available, if the Director deems it will be helpful.

patent cases specifically (Ex. 1048, 1). Based on Moskowitz filing its complaint against Nuvasive in June 2025, the median time-to-trial statistics show that a trial, if any, is likely to occur substantially later than February 2027, *i.e.*, in late 2028 (if not in 2029). Thus, 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 favor institution. 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 other cases involving many patents, district court trials were scheduled to occur before the Board's final decision. *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 at 2 (“[T]he scheduled trial date precedes the projected final written decision due date”) (Director June 13, 2025); *Shenzhen Tuozhu Technology Co., Ltd. v. Stratasys, Inc.*, IPR2025-00438, Paper 10 at 2 (Director July 17, 2025) (“[I]t is unlikely that a final written decision in these proceedings will issue before the district court trial occurs.”). Even so, the Office ordered institution, holding that the “large number and vast scope” of asserted patents “tip[s] the balance” in favor of Board review. *Tesla* at 2-3; *see also Shenzhen* 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 twelve-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. Moskowitz recently amended its complaint to assert a twelfth patent on January 29, 2026. (Ex. 1043, ¶¶22, 34, 304-305.) Medtronic’s deadline to serve invalidity contentions is not until April 28, 2026. 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 Inc.*, IPR2025-00856, Paper 11 at 2.

Moskowitz’s recent addition of a twelfth asserted patent ensures that the case remains in its infancy. Contrary to Moskowitz’s assertions (DD Req., 12), extensions to the schedule were necessitated by this eleventh-hour addition to the complaint and jointly agreed to by the parties. (Ex. 2005; Ex. 2016.)

D. Factor 4: The Sotera Stipulation Supports Institution

Medtronic’s *Sotera* stipulation (Ex. 1042) “mitigates any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions.” *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (P.T.A.B. Dec. 1, 2020) (precedential).

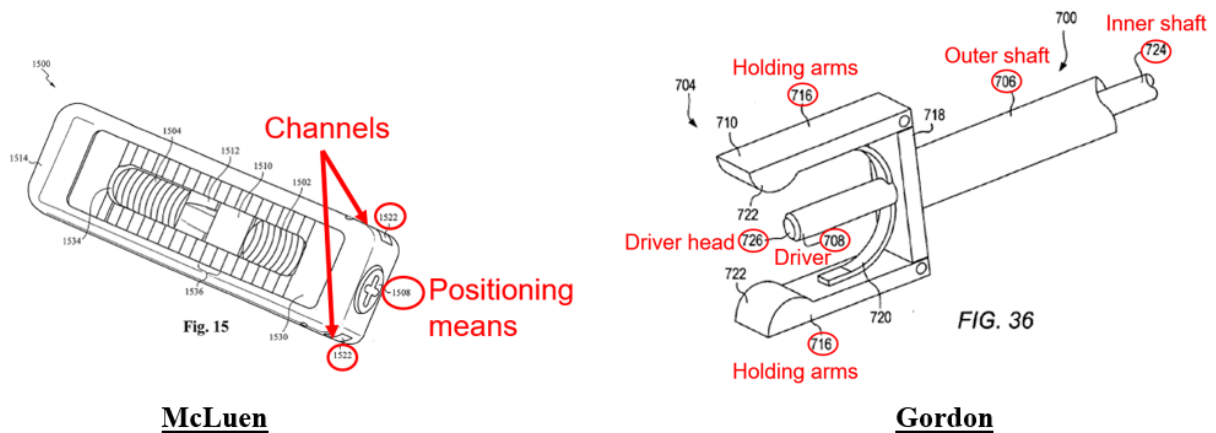
E. Factor 5: Early FWD Supports Institution

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 a strong, focused challenge of claims 9-12, 14-18, and 20, the only claims asserted against Medtronic in the litigation, based on anticipation and obviousness grounds. Moskowitz’s assertion that these “anticipation and obviousness theories [] undermine any claim of compelling strength” (DD Req., 17) is unavailing. Medtronic explained how Gordon, a reference that was in front of the Examiner during prosecution, plainly anticipates the challenged claims. (*See, e.g.*, Pet., 16-34.) Moskowitz’s *attorney* argument that the anticipation ground “relies on different embodiments of Gordon for different claim elements” (DD Req., 17) similarly misses the mark, as the Petition explains the relationship between the figures. (*See, e.g.*, Pet., 29 (“As shown in figure 38 below, implant 484 is c-shaped, *just like the implant shown in figure 15 . . .*”) (emphasis added).)

There is also no “heavy dependence on expert reconstruction” (DD Req., 17-18) of the asserted prior art under the obviousness grounds, as Moskowitz alleges. To the contrary, the combination of McLuen and Gordon is supported by the references’ express teachings. For example, as shown below, McLuen’s spinal implant includes channels 1522 for engagement with Gordon’s tool with holding arms 716 for securely holding McLuen’s implant (e.g., at the target site during expansion of the implant), an objective expressly stated by McLuen. (Pet, 55-57.)



(Ex. 1012, Fig. 15 (annotated); Ex. 1013, Fig. 37 (annotated).)³

Moskowitz also attempts to discredit the challenge by mislabeling it as an

³ Moskowitz does not try to rebut the obviousness grounds based on Michelson’s disclosure of the claimed “**second adjusting tool.**” (See, e.g., Pet., 79-83.)

inequitable conduct challenge. (DD Req., 16-17.) That Gordon and McLuen were buried in IDS filings with over 400 other references is also a reason to refer for further consideration, not to deny institution, as discussed in Section IV below. Referring this IPR for consideration of institution is the best way to rectify Office error perpetuated by Moskowitz's prosecution tactics.

IV. MATERIAL ERROR BY THE OFFICE, PERPETUATED BY MOSKOWITZ'S CONDUCT, WARRANTS REVIEW

The Office allowed the '136 patent claims without issuing a single prior art rejection, even though the record included highly relevant art. This type of error warrants institution on the merits notwithstanding § 325(d). *Ecto World*, Paper 13 at 5 (holding that Petitioner may articulate Office error "with reference to *Becton Dickinson* factors (c), (e), and (f)") (citing *Becton, Dickinson and Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17-18 (P.T.A.B. Dec. 15, 2017) (precedential as to Section III.C.5, first paragraph)). As explained, Medtronic's prior art references, Gordon, McLuen, and Michelson, were not applied in a rejection, Gordon and McLuen were buried in IDS submissions totaling 410 references, and Michelson was never cited or considered.

A. *Becton Dickinson* Factors (c) and (f) (Prior Consideration of Asserted Art and Additional Facts Warranting Review)

The Office never relied on Gordon, McLuen, or Michelson, let alone any prior art, to reject the claims. After the application issuing as the '136 patent was filed in

January 2020, but before the Office issued a first Office Action, Moskowitz filed four Information Disclosure Statements citing a total of 410 references, including Gordon and McLuen. (Ex. 1004, 10 (application filed), 92-102 (first IDS filed January, 2020, citing 227 references, including Gordon as citation no. 150), 134-135 (second IDS filed May 2020, citing 36 references, including McLuen as citation no. 31), 225-234 (third IDS filed September 2020, citing 141 references), 281-282 (fourth IDS filed February 2021, citing 6 references), 286-290 (first Office Action).)

Examiner Pedro Philogene indicated consideration of all 410 references in one fell swoop with the first Office Action. (Ex. 1004, 295-334.) The first Office Action did not include any prior art rejections, but instead the claims were rejected for nonstatutory obviousness-type double patenting based on related Moskowitz patents, namely U.S. Patent Nos. 10,478,319 (“’319 patent”) and 10,307,268 (“’268 patent”). (*Id.*, 288-290.) Moskowitz filed a terminal disclaimer to overcome the double patenting rejections (*id.*, 356-358), and the application was subsequently allowed by a *new* Examiner (Ellen Hammond) without any further rejections (*id.*, 363-368).

Merely listing Gordon and McLuen amongst hundreds of references does not mean the Office meaningfully considered those references. Rather, the prosecution history indicates the references were cited but not evaluated for their teachings. These facts support material error under *Becton Dickinson* factor (c) (“the extent to which the asserted art was evaluated during examination, including whether the prior

art was the basis for rejection”) because “the asserted prior art was not a basis for rejection during examination . . . and includes specific teachings that ‘impact patentability of the challenged claims.’” *See Ecto World*, Paper 13 at 5.⁴

Becton Dickinson factor (f) “considers the extent to which additional evidence and facts warrant reconsideration of the prior art.” *Ecto World*, Paper 13 at 6. One such additional factor is “the volume of the references submitted to the Office during examination and any applicant information or assistance regarding the relevance of references.” *Id.* at 6-7 n.3 (noting that a typical IDS contains fewer than 25 references). Here, the IDS submissions citing Gordon and McLuen that Examiner Philogene collectively considered included 410 references, which is *more than sixteen times* the size of a typical IDS. (Ex. 1004, 295-334.) Despite the large volume of references cited, Moskowitz did not provide any “information or assistance regarding the relevance of references” to the Examiner. (*Id.*, 92-102, 134-135, 225-234, 281-282); *Ecto World*, Paper 13 at 6-7. These facts demonstrate that “denial under § 325(d) is not warranted.” *Ecto World*, Paper 13 at 7; *see also*

⁴ Moskowitz admits that the third reference “Michelson was not before the Examiner.” (DD Req., 19.) Moskowitz’s *attorney* argument that the Allen reference is cumulative to Michelson (*id.*) should be rejected as it does not meaningfully explain or compare the relevant teachings of the two references.

Nespresso USA, Inc. v. K-Fee System GmbH, IPR2022-01574, Paper 12 at 50-52 (Apr. 14, 2023) (declining to exercise discretion where asserted art was cited in voluminous IDS and not relied upon by Examiner during prosecution).

B. *Becton Dickinson* Factor (e) (Examiner Error)

After examiners changed mid-prosecution, the challenged claims were allowed by Examiner Hammond *without any statement of reasons for allowance*. (Ex. 1004, 363–368.) There is no examiner analysis to defer to, and the prosecution record is silent as to how the Office evaluated highly relevant references such as Gordon and McLuen. Moreover, there was no substantive back-and-forth between Moskowitz and the Office regarding prior art, *i.e.*, no indication in the record of the basis on which the claims were deemed patentable. (*See generally* Ex. 1004.)⁵

Under these circumstances, the Office materially erred in allowing the claims

⁵ While the Office noted the substantial similarity between the challenged claims and the '319 and '268 patents claims forming the basis of the double patenting rejections (Ex. 1004, 288-290), the Office overlooked the anticipatory disclosures of Gordon with respect to the '319 and '268 patent claims—despite Gordon being cited during prosecution of those patents. (Ex. 1049, 165-173 (citation no. 81); Ex. 1050, 256-264.) The Examiner also did not provide any reasons for allowing the '319 and '268 patents. (Ex. 1049, 211-215, 249-250; Ex. 1050, 343-348.)

where “the record of the Office’s previous consideration of the art is not well developed or silent.” *Advanced Bionics, LLC*, IPR2019-01469, Paper 6 at 10–11. Moskowitz does not dispute that Gordon anticipates the challenged claims. (DD Req., 18–20; *see also supra* Section III.F.) Nor does he dispute that the combination of McLuen and Gordon renders the challenged claims obvious. (*Id.*) The Office therefore clearly erred in allowing the claims without addressing whether Gordon alone, or in combination with McLuen, discloses or suggests the challenged claims. Because the Examiner never substantively engaged with Gordon or McLuen (and Michelson was not considered at all), this is also not a case where Medtronic merely “disagree[s] with the examiner’s judgment.” (*Contra* DD Req., 20.)

In short, the Office materially erred by allowing the challenged claims while overlooking the teachings of Gordon, McLuen, and Michelson. That error was compounded by Moskowitz’s decision to bury Gordon and McLuen in voluminous IDS submissions without explaining their relevance to the Examiner. Institution of this IPR is therefore warranted.

V. THE COMPLEXITY OF THE DISPUTE FAVORS INSTITUTION

When a district court litigation involves a large number of patents spanning multiple families (as here), the Board is the preferred forum for resolving validity disputes. 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, Inc.*, IPR2025-00217, Paper 9 at 2-3. The Office similarly referred petitions where the parallel litigation involved 12 patents asserted against multiple parties in multiple jurisdictions, finding the Board was “better suited” to review such a large portfolio. *American Airlines, Inc.*, IPR2025-00785, Paper 11 at 3. The Office also referred petitions in other cases with similarly complex disputes. *Shenzhen Tuozhu Technology Co., Ltd.*, IPR2025-00438, Paper 10 (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).

Here, the parallel litigation involves 12 patents, with the twelfth patent formally added by Moskowitz about a month ago. (Ex. 1043, ¶¶22, 34, 304-305.) Contrary to Moskowitz’s assertion that the asserted patents “arise from a common lineage and share overlapping disclosures and technology” (DD Req., 9), these

patents issued from applications in distinct branches of a fractured priority chain. Specifically, the portfolio comprises patents from numerous continuation-in-part applications, resulting in patents that claim diverse subject matter, as demonstrated by the fact that they have different priority dates and disclosures. (*See* Ex. 1044, 9-12.) These are the types of “complex” litigations where the Office has found the Board’s expertise most valuable. Institution 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.

Moskowitz’s position regarding the Board not being better suited to review these patents is based on the unsupported premise that “[r]eviewing a newer family member [*i.e.*, the ’136 patent] *in isolation* would not streamline the dispute.” (DD Req., 9 (emphasis added).) But the Director has already referred the older ’293 patent to the Board, and Medtronic’s other eight IPRs are pending the Director’s review. Instituting Medtronic’s IPRs, including this one, would promote efficiency and assist the district court in narrowing the scope of issues it needs to decide.

VI. CONCLUSION

Given that the discretionary denial considerations support institution as discussed above, Medtronic requests institution of this IPR.

Respectfully submitted,

Dated: March 9, 2025

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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 March 9, 2026:

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