UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,
Petitioner

v.

MOSKOWITZ FAMILY LLC,
Patent Owner.

Case IPR2026-00124
Patent No. 11,096,797

PETITIONER'S DISCRETIONARY DENIAL OPPOSITION

MEDTRONIC EXHIBIT 1051
Medtronic, Inc. v. Moskowitz Family LLC
IPR2026-00163

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LIST OF EXHIBITS

Exhibit No.	Document	Previously Submitted
Ex. 1001	U.S. Patent No. 11,096,797 to Moskowitz et al. ("the '797 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. 11,096,797	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	U.S. Patent No. 7,118,579 to Michelson ("Michelson")	X
Ex. 1015	U.S. Patent Application Publication No. 2005/0182416 A1 to Lim et al. ("Lim")	X
Ex. 1016-Ex. 1019	RESERVED	
Ex. 1020	Phulchand Prithvi Raj, *Intervertebral Disc: Anatomy-Physiology-Pathophysiology-Treatment*, 8(1) PAIN PRACT. 18 (2008)	X

Exhibit No.	Document	Previously Submitted
Ex. 1021	Fabio Galbusera et al., *Ageing and degenerative changes of the intervertebral disc and their impact on spinal flexibility*, 23(3) EUR. SPINE J. 324 (2014)	X
Ex. 1022	Dil Patel et al., *Interbody options in lumbar fusion*, 5(1) J. SPINE SURG. S19 (2019)	X
Ex. 1023-Ex. 1036	RESERVED	
Ex. 1037	Daniel Orr et al., *Expandable interbody cages for lumbar spinal fusion: a systematic review*, 25(8) SPINE J. 1773 (2025)	X
Ex. 1038	RESERVED	
Ex. 1039	U.S. Patent No. 5,658,335 to Allen ("Allen")	X
Ex. 1040	Amended Complaint, *Moskowitz Family, LLC v. Medtronic, Inc.*, No. 0:25-cv-00769 (D. Minn. filed May 23, 2025), Dkt. 27.	
Ex. 1041	Answer to Amended Complaint, *Moskowitz Family, LLC v. Medtronic, Inc*., No. 0:25-cv-00769 (D. Minn. filed June 27, 2025), Dkt. 29.	
Ex. 1042	Sotera Stipulation, *Moskowitz Family, LLC v. Medtronic, Inc.*, No. 0:25-cv-00769 (D. Minn. filed Jan. 6, 2026), Dkt. 41.	
Ex. 1043	Second Amended Complaint, *Moskowitz Family, LLC v. Medtronic, Inc.*, 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), *Moskowitz Family, LLC v. Medtronic, Inc.*, 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), *Medtronic, Inc. v. Moskowitz Family LLC*, IPR2025-01598	
Ex. 1047	Defendants' Motion to Stay, *Moskowitz Family, LLC v. Medtronic, Inc.*, No. 0:25-cv-00769 (D. Minn. filed Feb. 20, 2026), Dkt. 59	
Ex. 1048-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. 11,096,797 ("'797 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 '797 patent issued a little over four years ago, in August 2021. Because the '797 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 for a 2021 issued patent).

Moskowitz's contention that Medtronic's knowledge of the ancestor '293 patent since 2015 creates "settled expectations" favoring a discretionary denial (DD Req., 1) ignores that Medtronic expressly rejected Moskowitz's demand to license the '293 patent (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 (*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 Moskowitz's 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 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 nine 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").

Office Error. The '797 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 323-reference Information Disclosure Statement (IDS). Medtronic's IPR challenges claims 16 and 19—the only claims of the '797 patent asserted against Medtronic—as being obvious over McLuen (Ex. 1012) and Michelson (Ex. 1014). (Paper 1 ("Petition"), 3.) While McLuen and Michelson

were listed on an IDS, "[they were] not a basis for rejection during examination," which is evidence of material error. *Ecto World LLC v. RAI Strategic Holdings Inc.*, IPR2024-01280, Paper 13 at 5 (Director May 19, 2025) (precedential). And they were buried in a 323-reference IDS, which is thirteen times the size of a typical IDS. (Ex. 1004, 92 (reference no. 85), 94 (reference no. 134)[1]; Petition, 5.) Moskowitz did not 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.

More significantly, denial is not warranted under § 325(d) because the Petition demonstrates that Michelson discloses the ***precise claim limitations that formed the basis for allowing the challenged claims***—a fact that Moskowitz does not dispute. *Carbyne, Inc. v. Tritech Software Systems*, IPR2025-00959, Paper 11 at 2 (Director Oct. 3, 2025) (rejecting Patent Owner's § 325(d) argument because Petitioner's prior art was "cited on an IDS during prosecution" and "appears to disclose the purportedly missing claim limitations"); *FreightCar America, Inc. v. National Steel Car Limited*, IPR2025-01046, Paper 20 at 3-4 (Director Oct. 10, 2025) (finding "material error by the Office" because the prior art "appear[s] to disclose the

[1] The patent that issued from the McLuen publication is cited in the IDS.

allowable features of the claims"). (*See infra* Section IV.B.)

Complexity of the parties' dispute. The parallel district court litigation involves 12 patents stemming 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). Thus, 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 '797 patent issued in August 2021 (Ex. 1001, Cover), less than four-and-a-half years before this IPR petition was filed in November 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." (*See generally* DD Req., 4-11.) *Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00603, Paper 9 at 2 (Director July 24, 2025) (informative).

Moskowitz's reliance on Medtronic's notice of "ancestor patents" (specifically, the '293 patent) does not support exercise of discretion either. (DD Req., 4-5.) To the contrary, Moskowitz's reliance on the '293 patent 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 review of the '797 patent.

Furthermore, settled expectations arising from the age of a parent patent do not necessarily carry over to a younger child patent. Rather, 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. (DD Req., 4, 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).) Specifically, 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. The Acting Director cited similar efficiency reasons in denying review of two out of six challenged patents. *Samsung*, IPR2025-00641, Paper 12 at 3. Here, the '293 patent was referred to the Board, and Medtronic's challenges to eight 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., 4-11 *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 '797 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. v. Ferid Allani*, IPR2025-00856, Paper 11 at 3.[2] 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. (DD Req., 7.) Moskowitz's strategic choice in suing Medtronic's competitors (Globus in 2019 and ZimVie in 2022), while ignoring Medtronic, *see* DD Req. 5-6, further strengthened Medtronic's expectation that Moskowitz would not sue Medtronic for infringement of the '293 patent or other patents from the '293 patent family.[3]

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[2] 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 '797 patent had not issued, no infringement was alleged, and no accused products existed." (DD Req., 7-8.) But if the '797 patent's later issue date is controlling, then Moskowitz cannot rely on older patents and earlier communications to argue for settled expectations.

[3] Moskowitz's reliance on *DataDome S.A. v. Arkose Labs Holding, Inc*., IPR2025-00693, Paper 13 (Director Aug. 14, 2025) is unavailing. In *DataDome*, "patent

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. v. Ferid Allani*, IPR2025-00856, Paper 11 at 3.

Moskowitz's arguments about meetings with Medtronic regarding purported "presentations" and "prototypes" before the '797 patent issued, which are backed by only the bare allegations in Moskowitz's complaint, are unpersuasive. (DD Req., 5.) Moskowitz does not bother to explain how any of his alleged "presentations" and "prototypes" relate to the specific scope of the challenged claims. Vague commercial discussions from over a decade ago, unmoored from the specific patent rights at issue, cannot give rise to any "settled expectations" of patent validity relevant to the '797 patent.

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owner asserted the patent two years after the parties' discussion," a fact the Director distinguished when declining to exercise discretion to deny institution in *Apple*. IPR2025-00856, Paper 11 at 3. Like in *Apple*, Moskowitz's 10-year delay, however, counsels against discretionary denial.

III. THE FINTIV FACTORS STRONGLY FAVOR INSTITUTION

The *Fintiv* factors strongly favor institution.

A. Factor 1: Medtronic Will Request a Stay

Medtronic will be requesting a stay. (Ex. 1047.) Moskowitz argues a stay is "unlikely" and "impractical." (DD Req., 11.) But the Minnesota court has granted stays when a significant number of patents are subject to review by the Office. *See, e.g., Vascular Solutions LLC v. Medtronic, Inc.,* No. 0:19-cv-01760-PJS-TNL (D. Minn.), ECF No. 276 (July 7, 2020) (granting Medtronic's motion to stay pending thirteen IPRs). Moskowitz's cited cases are inapposite because, in those cases, the courts denied a stay as IPRs were not yet instituted and involved fewer asserted patents. Here, Medtronic has filed IPRs challenging eight patents and anticipates challenging more patents; therefore, there is a high likelihood of a stay. Given the complexity of the dispute, instituting review is the most effective way to encourage a stay and conserve judicial resources.

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

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

to issue a final decision at least nine months before any verdict in the district court.

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. v. Ferid Allani,* IPR2025-00856, Paper 11 at 2.

Moskowitz's recent addition of a twelfth asserted patent against Medtronic further ensures that the case remains in its infancy. Contrary to Moskowitz's insinuation regarding Medtronic delaying the schedule (DD Req., 13), extensions to the schedule were necessitated by Moskowitz's eleventh-hour amendment 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

While the parties in the Minnesota Action 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 16 and 19 based on a two-reference obviousness combination of McLuen and Michelson under 35 U.S.C. § 103. Moskowitz's conclusory assertion that the single obviousness ground presented in the petition "lacks indicia of strength" (DD Req., 17) is unavailing. There is no dispute that Michelson discloses the claimed three-part tool (Petition, 21-41), which formed the basis of the Office's allowance of claims 16 and 19. The minor modification proposed to Michelson's engagement prongs such that they would have securely engaged McLuen's implant would have been well within the routine skill of a POSITA. (*Id*., 27-29.) Moskowitz's ***attorney*** argument that this is a "heavily engineered" combination (DD Req., 17) wholly ignores the simplicity of the combination. (Ex. 1002, ¶¶66-68, 74-75.)

Moskowitz also attempts to discredit the challenge by mislabeling it as an inequitable conduct challenge. (DD Req., 16-17.) While it is true that McLuen and Michelson were buried in a voluminous IDS among 320-plus references, that is a

reason to refer for further consideration, not to deny institution. 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 Examiner allowed the claims of the '797 patent without issuing a single rejection, even though highly relevant art was part of the record. This is the sort of error that 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 below, Medtronic's prior art references, McLuen (Ex. 1012) and Michelson (Ex. 1014), were not applied in a rejection, were buried in a 323-plus reference IDS, and disclose the very limitations that formed the basis for allowing challenged claims 16 and 19.

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

The Examiner never relied on McLuen or Michelson, let alone any prior art, to reject the claims, and instead allowed the claims on a ***first-action*** allowance. Nor does the prosecution history of the '797 patent include any commentary regarding McLuen or Michelson that would suggest the references were carefully evaluated by

the Office. 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.

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 citing McLuen and Michelson included more than 320 references, which is almost thirteen times the size of a typical IDS. (Ex. 1004, 88-101.) Despite the large volume of references cited, Moskowitz did not provide any "information or assistance regarding the relevance of references" to the Examiner. (*Id.*, 88-101); *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 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)

Challenged claim 16 recites a system including an expandable intervertebral fusion device and a three-part tool ("first tool," "second tool," and "third adjustment tool") configured to hold and deliver the intervertebral fusion device to a target site in the body. (Ex. 1001, 17:34–18:11.) Claim 19 depends from claim 16. The Examiner allowed claims 16 and 19 by way of a first-action allowance, *i.e.*, without issuing any rejections. (Ex. 1004, 140-147.) As shown below in an excerpt of the Notice of Allowance, the Examiner determined that "the prior art fails to disclose or reasonably teach" the claimed three-part tool. (*Id*., 145.) The Examiner's reasoning based on the "linkage connector" features is inapplicable to claims 16 and 19, which do not recite such features. (*Compare* Ex. 1001, 15:5-16:6 (unchallenged claim 1), *with* 17:34-18:11 (challenged claim 16).)

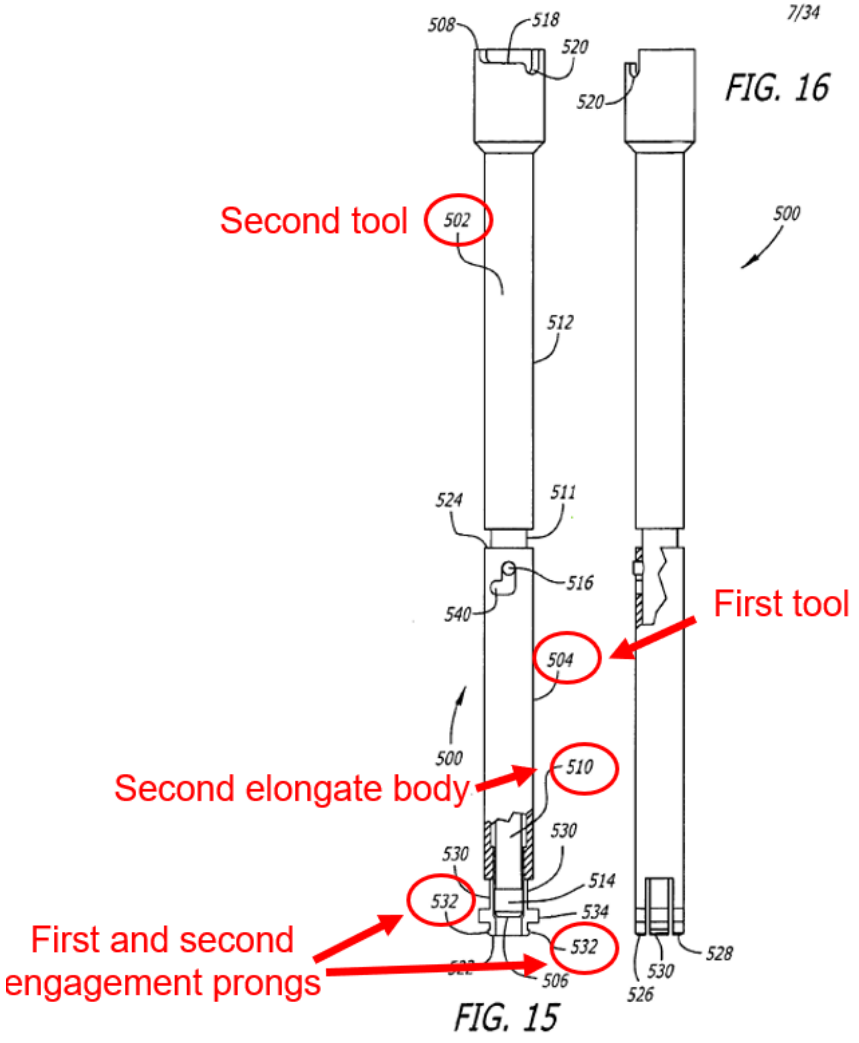
Reasons for Allowance

The following is an examiner's statement of reasons for allowance: the prior art fails to disclose or reasonably teach an expandable intervertebral fusion device comprising a linkage connector positioned inside a space defined between the first and second movable portions, wherein the linkage connector is operably connected to the rotation screw, wherein the linkage connector is operably connected to a first end of a first linkage arm of the plurality of linkage arms such that the first end of the first linkage arm is pivotably connected to the linkage connector and a second end of the first linkage arm is pivotably connected to the first and second linkage arm connection holes of the first movable portion, and wherein rotation of the rotation screw forces the linkage connector to move along the rotation screw axis and pivot the first linkage arm to push the first movable portion away from the second movable portion to expand the expandable intervertebral fusion device. A first tool having a first proximal end, a first distal end and a first elongate body, wherein the first tool includes first and second engagement prongs positioned at the distal end on opposite sides of the first tool axis; a second tool having a second elongate body and defining a second tool passage, and wherein an outer diameter of the second elongate body is less than the an inner diameter of the first tool passage; and a third adjusting tool having a third proximal end and a third distal end, and a third handle positioned at a third proximal end, a screw engagement portion positioned at a third distal end and a third shaft wherein an outer diameter of the third shaft is less than an inner diameter of the second tool passage. Thus the examiner has allowed claims 21-40.

(Ex. 1004, 145 (annotated).)

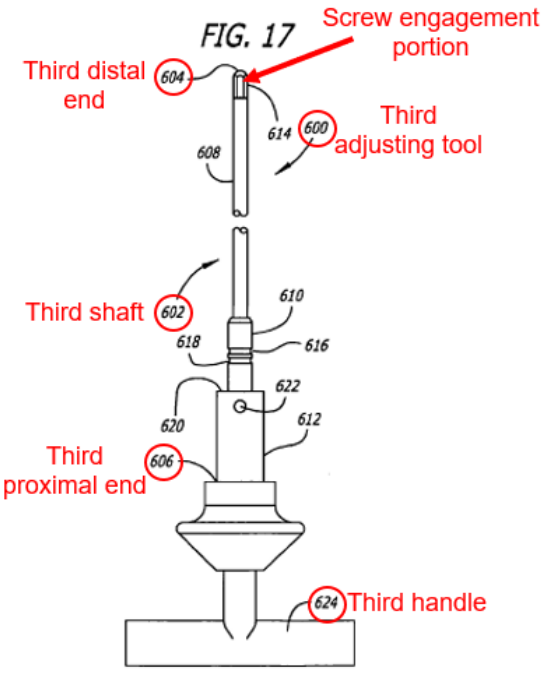
The Examiner's finding that the prior art did not disclose a three-part tool was a clear error. Moskowitz does not dispute that the Petition establishes that Michelson discloses the claimed three-part tool. (Petition, 21-41.) For example, as explained in the Petition and shown below, Michelson discloses an implant holder 500 with an

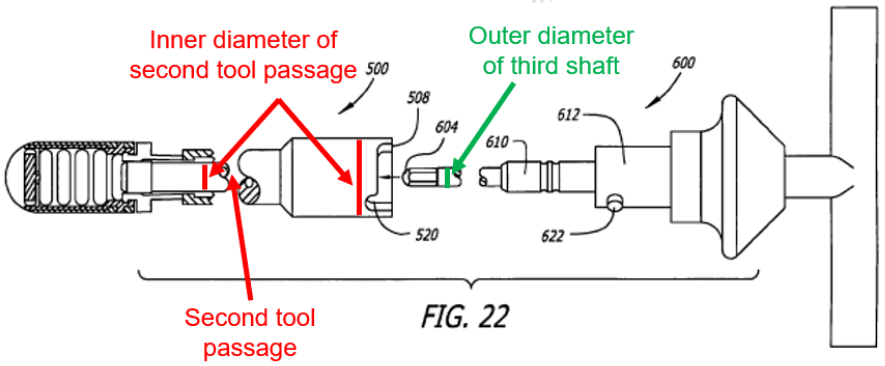
outer sleeve 504 (a "first tool") with flanges 532 ("engagement prongs") for engaging with an implant. (Petition, 29-30.) Michelson further discloses, as shown in Figure 15 below, that the outer sleeve 504 is hollow to allow a shaft 502 ("second tool") with a reduced portion 510 ("second elongate body") and having a diameter smaller than the inner diameter of outer sleeve 504 to pass therethrough. (Petition, 31-32, 37.)



(Ex. 1014, Fig. 15 (annotated).)

An expander driver 600 ("third adjustment tool") passes through shaft 502, and the driver 600 has a T-shaped handle 624 ("third handle") and a tip 614 ("screw engagement portion") at a distal end of the driver 600. (Petition, 38-39.)





(Ex. 1014, Figs. 17, 22 (both annotated).)

Given Michelson's figures readily show relevant teachings material to the claimed three-part tool, "it is an appropriate use of Office resources to review the

potential error" in issuing claims 16 and 19. *FreightCar*, IPR2025-01046, Paper 20 at 3-4 (finding Office error because the prior art "appear[s] to disclose the allowable features of the claims"). Because the Examiner did not engage with McLuen and Michelson at all, this is not a situation where Medtronic is merely "disagreeing with the examiner's judgment." (*Contra* DD Req., 19.)

In summary, the Office materially erred in allowing challenged claims 16 and 19 by overlooking the relevant teachings of Michelson (and McLuen), and this error was perpetuated by Moskowitz's burying of these key references in a voluminous IDS without providing any explanation to the Examiner regarding the references' relevance. Therefore, institution of this IPR is warranted.

V. THE COMPLEXITY OF THE DISPUTE FAVORS INSTITUTION

When a district court litigation involves a large number of patents spanning multiple families, as is the case here, the Board is the preferred forum for resolution of validity disputes. 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 across 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. v. Stratasys, Inc.*, IPR2025-00438, Paper 10 (Director July 17, 2025) (denying request for discretionary denial where the parallel litigation involved 9 patents and specifically noting that "the large number and vast scope of the patents . . . weighs against discretionary denial."); *Harbor Freight Tools USA Inc. et al. v. Champion Power Equipment, Inc.*, IPR2025-00805, Paper 20 (Director Sept. 19, 2025) (referring petitions where the parallel litigation involved 13 patents asserted against multiple parties across multiple jurisdictions, finding that resolving the dispute at the Office "would be more efficient"); *Apple Inc. v. Apex Beam Technologies LLC*, IPR2025-00896, Paper 10 (Director Sept. 3, 2025) (referring petitions where the parallel litigation involved 17 patents, again confirming the Board's role in managing high-volume patent validity challenges). Institution is similarly warranted here.

Here, the parallel litigation involves 12 patents, with the 12th patent added by Moskowitz less than 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 precisely the type of "complex" litigations where the Office has found the Board's expertise most valuable. Institution here allows the Board to apply its specialized technical expertise to specific validity issues, thereby streamlining massive district court actions and preventing the waste of judicial resources on invalid claims.

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 '797 patent] *in isolation* would not streamline the dispute." (DD Req., 10 (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 to allow the Board to correct Office error in issuing claims 16 and 19.

Respectfully submitted,

Dated: February 20, 2026 By: /Naveen Modi/
Naveen Modi (Reg. No. 46,224)

Counsel for Petitioner

CERTIFICATE OF SERVICE

I certify that I caused to be served on the counsel identified below a true and correct copy of the foregoing Petitioner's Discretionary Denial Opposition by electronic means on February 20, 2026:

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