

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,
Petitioner

v.

MOSKOWITZ FAMILY LLC,
Patent Owner.

Case IPR2026-00216
Patent No. 10,016,284

PETITIONER'S DISCRETIONARY DENIAL OPPOSITION

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LIST OF EXHIBITS

Exhibit No.	Document	Previously Submitted
Ex. 1001	U.S. Patent No. 10,016,284 to Moskowitz et al. (“the ’284 patent”)	X
Ex. 1002	Declaration of Brad Culbert	X
Ex. 1003	Curriculum Vitae of Brad Culbert	X
Ex. 1004- Ex. 1005	RESERVED	
Ex. 1006	U.S. Patent Application Publication No. 2008/0249569 A1 to Waugh et al. (“Waugh”)	X
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Ex. 1013	U.S. Patent Application Publication No. 2005/0278026 to Gordon et al. (“Gordon”)	X
Ex. 1014- Ex. 1019	RESERVED	
Ex. 1020	Phulchand Prithvi Raj, <i>Intervertebral Disc: Anatomy-Physiology-Pathophysiology-Treatment</i> , 8(1) PAIN PRACT. 18 (2008)	X
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	RESERVED	

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Ex. 1024	U.S. Patent No. 9,585,766 to Robinson (“Robinson”)	X
Ex. 1025- Ex. 1039	RESERVED	
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Ex. 1041	Answer to Second Amended Complaint, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Minn. filed Feb. 19, 2026), Dkt. 57.	
Ex. 1042	Sotera Stipulation, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Minn. filed Feb. 20, 2026), Dkt. 58.	
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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	RESERVED	
Ex. 1047	U.S. Patent No. 6,342,074 to Simpson (“Simpson”)	X
Ex. 1048- Ex. 1052	RESERVED	
Ex. 1053	Anne Polikeit et al., <i>The importance of the endplate for interbody cages in the lumbar spine</i> , 12(6) EUR. SPINE J. 556 (2003)	X

Exhibit No.	Document	Previously Submitted
Ex. 1054- Ex. 1055	RESERVED	
Ex. 1056	File History for U.S. Patent No. 10,016,284	X
Ex. 1057	U.S. Patent No. 9,445,919 to Palmatier et al. (“Palmatier”)	X
Ex. 1058	U.S. Pub. No. 2011/0319997 to Glerum et al. (“Glerum”)	X
Ex. 1059	RESERVED	
Ex. 1060	Senthil Eswaran et al., <i>The micro-mechanics of cortical shell removal in the human vertebral body</i> , 31 COMPUT. METHODS APPL. MECH. ENGRG. 3025 (2007)	X
Ex. 1061	Vivek Palepu et al., <i>Biomechanics of Disc Degeneration</i> , ADV. ORTHOP (2012)	X
Ex. 1062	Kai-Uwe Lewandrowski, <i>Surgical Technique of Endoscopic Transforaminal Decompression and Fusion with a Threaded Expandable Interbody Fusion Cage and A Report of 24 Cases</i> , 7(2) J. SPINE 1 (2018)	X
Ex. 1063	Erik Emstad et al., <i>The VariLift(®) Interbody Fusion System: expandable, standalone interbody fusion</i> , 8 MED. DEVICES (AUKL.) 219 (2015)	X
Ex. 1064	Gstoettner Michaela et al., <i>Footprint mismatch in lumbar total disc arthroplasty</i> , 17(11) EUR. SPINE J. 1470 (2008)	X
Ex. 1065	Thomas Steffen et al., <i>Cages: designs and concepts</i> , 9 EUR. SPINE J. S89 (2000)	X

Exhibit No.	Document	Previously Submitted
Ex. 1066	Thomas Lowe et al., <i>A Biomechanical Study of Regional Endplate Strength and Cage Morphology as It Relates to Structural Interbody Support</i> , 29(21) SPINE 2389 (2004)	X
Ex. 1067	RESERVED	
Ex. 1068	Patent Owner's Infringement Claim Charts, Exhibit C1, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Minn.), served October 30, 2025.	X
Ex. 1069	Patent Owner's Infringement Claim Charts, Exhibit C2, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Minn.), served October 30, 2025.	X
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Ex. 1071	Transcript of Motions Hearing before Magistrate Judge Douglas L. Micko, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Minn.), held March 6, 2026.	
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Ex. 1074	U.S. Patent No. 12,011,367 to Moskowitz et al. ("the '367 patent")	
Ex. 1075	Declaration of Jamie Hartman	
Ex. 1076	Patent Owner's Infringement Claim Charts, Exhibit C1, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Minn.), served January 30, 2026.	

Exhibit No.	Document	Previously Submitted
Ex. 1077	Patent Owner's Infringement Claim Charts, Exhibit C2, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Minn.), served January 30, 2026.	

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. 10,016,284 ("the '284 patent") is premised on similar arguments it made in support of its discretionary denial request in companion IPRs involving related U.S. Patent Nos. 9,005,293 ("the '293 patent") and 12,011,367 ("the '367 patent"). Those arguments have already been considered by the Director, who granted institution in the former and referred the latter to the Board for adjudication on the merits. *See* IPR2025-01598, Paper 11 at 2; IPR2026-00162, Paper 10 at 2.¹ As was the case in those IPRs, Office error alone is sufficient to warrant institution here. Institution is further warranted because of Medtronic's [REDACTED] complexity of the parties' dispute, judicial efficiency, and settled expectations.

Office Error. The Petition demonstrates that most of the challenged claims,

¹ Thus far, the Director has considered whether discretionary denial is appropriate in five Medtronic petitions challenging Moskowitz's patents. Each time, the Director had referred the petitions. The Director has instituted review in three previously referred IPRs. *See* IPR2025-01598, Paper 11 at 2; IPR2026-00121, Paper 11 at 2; IPR2026-00124, Paper 11 at 2. The instant petition warrants the same action.

including both independent claims 1 and 19, are unpatentable as anticipated by Palmatier (Ex. 1057). (Petition, 3-4.) As explained below in Section II (addressing Office error), the Examiner initially rejected then-pending claims of the '284 patent over Palmatier, but allowed them after being persuaded that Palmatier does not disclose a “slot” in the claimed “second housing.” (Ex. 1056, 144-149, 195; DD Req., 17.) In allowing the claims, the Examiner focused specifically on an embodiment presented in Figures 17-21. (Ex. 1056, 146-148). But the Examiner failed to appreciate that the embodiment of Palmatier discussed with respect to Figures 22-26 describing implant 840 is anticipatory and discloses the claimed “slot”—*a fact Moskowitz does not dispute*. Indeed, Moskowitz only contends that it will “dispute[]” Palmatier’s status as prior art in this IPR even though it did not do so during prosecution. (DD Req., 13.) Moskowitz’s failure to dispute Palmatier’s disclosure of the claimed “slot” confirms Office error, which alone is sufficient to warrant review. *See Taiwan Semiconductor Manufacturing Comp. Ltd. v. Marlin Semiconductor Ltd.*, IPR2025-00847, Paper 11 at 3-4 (Director Sept. 3, 2025) (“TSMC”) (referring petition challenging patent that had been “in force for *fifteen years*” because Petitioner demonstrated that the Examiner “overlooked” relevant disclosures in the prior art disclosing limitations that the Examiner “indicated were not taught by the prior art of record”) (emphasis added).

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Moskowitz

is merely a patent assertion entity with no similar [REDACTED]

[REDACTED]

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. 1070, 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) (“*Tesla*”)) (referring petitions where the parallel litigation involved 12 patents spanning 6 families).

Judicial Efficiency. The district court’s ready-for-trial date (February 2028) is seven months after the Board’s anticipated final written decision date, which “reduc[es] the risk of duplication of efforts and inconsistent outcomes.” *See Google LLC v. Cellular South, Inc.*, IPR2025-00875, Paper 10 at 2 (Acting Chief APJ Oct. 17, 2025) (holding that a district court trial date four months after the anticipated final written decision date “counsel[s] against discretionary denial”). While the ’284 patent is also at issue against *another party* (NuVasive) in Delaware, an earlier trial date in that case does not warrant denial of institution given the numerous other strong considerations (discussed herein) favoring review.

Settled Expectations. The ’284 patent’s 2018 issue date cannot overcome the clear Office error in allowing the ’284 patent claims. *See TSMC*, Paper 11 at 3-4. Moreover, Moskowitz has previously represented that Moskowitz’s patent license offer in 2015 to Moskowitz’s portfolio should form the basis for all settled expectations analysis, including for patents issuing post-2015. (*See* IPR2026-00162, Paper 6 at 5-6.) That license offer was expressly rejected by Medtronic in January 2016 and 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). (*See* IPR2026-00162, Paper 7 at 7-8.) Moskowitz’s *decade*-long silence negates its claim of settled expectations because a patent owner cannot use its own delay to shield a patent from institution.

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

II. MATERIAL ERROR BY THE OFFICE WARRANTS REVIEW

The Petition demonstrates that the Examiner allowed the claims because he overlooked relevant disclosure in *Palmatier*, which anticipates most of the challenged claims. (*See* Petition, 16-18.) As explained below, Moskowitz does not dispute that *Palmatier* anticipates both independent claims; nor does Moskowitz dispute that *Palmatier* discloses the “slot” limitation, which formed the basis for the Examiner’s allowance of the ’284 patent claims over *Palmatier*. The Office thus erred in allowing the ’284 patent claims and review is warranted to correct this Office error. *TSMC*, Paper 11 at 3-4.² This Office error also confirms that a discretionary

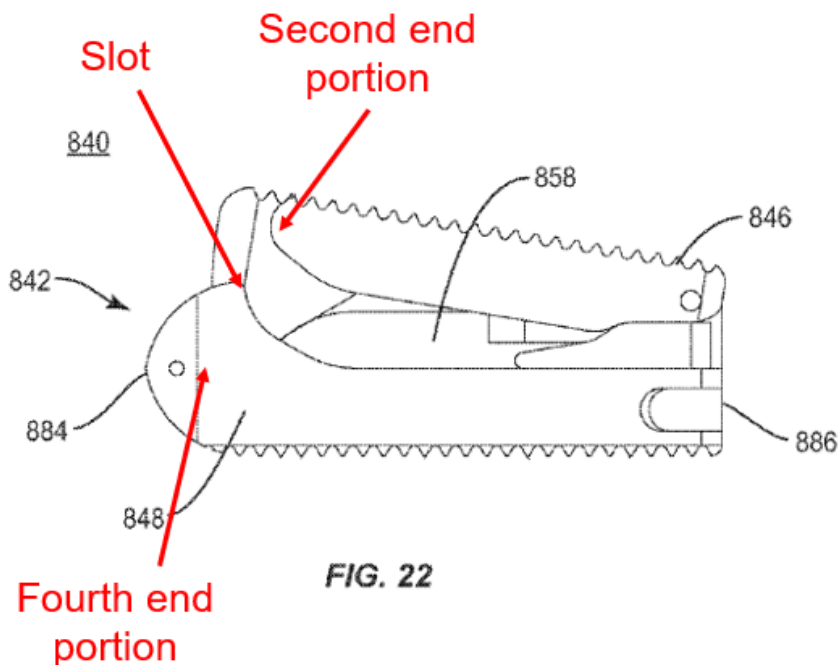
² In *TSMC*, the Examiner applied a certain prior art (*Chien770*) to reject the claims but subsequently withdrew the rejection and allowed the claims. *TSMC*, Paper 11 at 3-4. The Director determined that Petitioner “appears to show a material error by the Office” because Petitioner demonstrated that the “patent examiner overlooked certain teachings in *Chien770* that appear to disclose the claimed features that the patent examiner indicated were not taught by the prior art of record, including *Chien770*.” *Id.* This case presents a similar factual scenario and warrants the same finding of material error.

denial is not appropriate under 35 U.S.C. § 325(d) because Medtronic has demonstrated material error under the second part of *Advanced Bionics* by showing that “the previously presented art teaches the limitations of the challenged claims, and that no reasonable examiner could have found otherwise.” *Ecto World LLC v. RAI Strategic Holdings Inc.*, IPR2024-01280, Paper 13 at 5-6 (Director May 19, 2025) (precedential) (analyzing the two-part framework set forth in *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020) (precedential)); *contra* DD Req., 15-19.

During prosecution of the '284 patent, the Examiner initially issued an anticipation rejection based on Palmatier's implant 540, shown in Figures 17-21. (Ex. 1056, 146-148; *see* Petition, 16-18.) Moskowitz argued, *inter alia*, that “Palmatier does not teach . . . ‘the second housing defines a slot in the fourth end portion between the third and fourth side portions that is sized to receive the second end portion of the first housing such that the second end of the first housing and the fourth end of the second housing are axially aligned.’” (Ex. 1056, 182.) The Examiner was persuaded by that argument and allowed the claims. (*Id.*, 195, 231.) The Examiner, however, overlooked that the claimed “slot” is disclosed by the figures 22-26 embodiment of Palmatier describing implant 840.

Palmatier's implant 840 differs from implant 540, shown in Figures 17-21, because, as shown in figures 22 and 23 below, base component 848 has side walls

that create a slot to nest part of piston component 846 within base component 848. According to Palmatier, “[b]ase component 848 protects wedge 858 and screw 892 as intervertebral implant 840 is inserted into an intervertebral disc space.” (Ex. 1057, 18:46-48.) The claimed slot is illustrated in the figures below, which demonstrates that the slot is in the “fourth end portion” of the “second housing” and accommodates the “second end portion” of the “first housing.” (*See also* Petition, 50-52.) Again, Moskowitz does not dispute Petitioner’s above analysis.



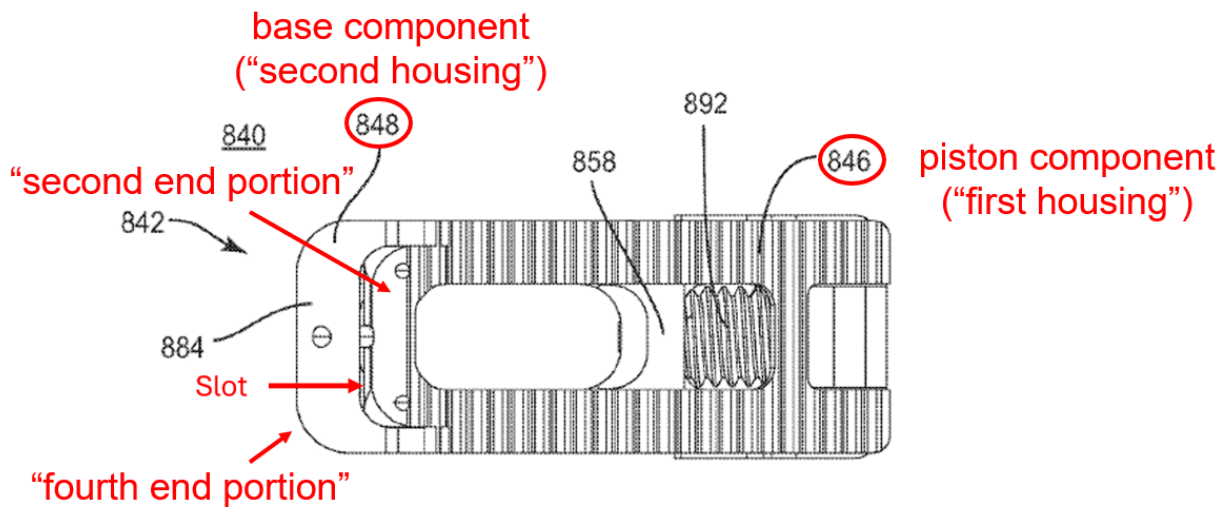


FIG. 23

(Ex. 1057, Figs. 22, 23 (both annotated).)

Unable to show error in Medtronic's analysis, Moskowitz invites the Board to look past the Examiner's error because "the Examiner [allegedly] considered Palmatier as a whole . . . and still allowed the claims." (DD Req., 16-17.) But Moskowitz cannot point to a single citation to figures 22-26 in the Examiner's analysis. (*See id.*) Even if there was such a citation, it cannot detract from the undeniable fact that the figures 22-26 embodiment expressly discloses the very "slot" limitation the Examiner believed was missing from Palmatier. No reasonable examiner could have concluded otherwise. *See TSMC*, Paper 11 at 3-4. The Examiner's failure to appreciate that disclosure and reject the claims based thereupon constitutes material error and warrants review of the Petition.

[REDACTED]

[REDACTED] Both of these considerations heavily favor review.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

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 the *Tesla* decision that was recently designated as informative, the Office referred petitions where the parallel litigation involved 11 patents, recognizing “[t]he large number and vast scope of the patents asserted in the district court litigation” as weighing against discretionary denial. *Tesla, Inc.*, IPR2025-00217, Paper 9 at 2-3. Notably, in *Tesla*, the complexity of the case overrode concerns that the trial date preceded the FWD, a significant *Fintiv* factor which is not even present here. 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. Stratasy, Inc.*, IPR2025-00438, Paper 10 (Director July 17,

2025) (“*Shenzhen*”) (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 twelfth patent added by Moskowitz less than three months ago. (Ex. 1040, ¶¶22, 34, 304-305.) 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. 1070, 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 "[i]nstitution *here* would not streamline the dispute." (DD Req., 2 (emphasis added).) But the Director has already instituted *inter partes* review of three patents, including the older '293 patent, and referred two other petitions for merits review. Moreover, four IPRs, including the instant IPR, remain pending before the Director. Instituting Medtronic's IPRs, including this one, would promote efficiency and assist the district court in narrowing the disputed issues by potentially reducing the number of claims left to adjudicate upon conclusion of the IPRs.

V. 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 that 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. (See Ex. 1071, 42:17-43:10.) Since then, the Director has referred two additional IPRs to the Board for adjudication on the merits and has instituted review

in three previously referred IPRs. *See* IPR2025-01598, Paper 11 at 2; IPR2026-00121, Paper 11 at 2; IPR2026-00124, Paper 11 at 2; IPR2026-00162, Paper 10 at 2; IPR2026-00163, Paper 10 at 2. Given the current trajectory of the IPRs, a stay is likely.

B. Factor 2: The Final Decision Will Issue Months Before Trial

This factor strongly favors institution. Medtronic's Petition was accorded a filing date in January 2026 (*see* Paper 3), meaning that the Board's final decision is due in July 2027. Meanwhile, the Minnesota Action is scheduled to be ready for trial seven 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 seven months before any verdict in the district court.

A February 2027 trial date for the '284 patent in a Delaware Action involving a different party (NuVasive) (DD Req., 8) 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 patent cases specifically (Ex. 1073, 1). Based on the filing of the NuVasive complaint in June 2025, the median time-to-trial statistics in Delaware show that a trial, if any, is likely

to occur substantially later than February 2027—in late 2028 (if not in 2029). As such, the current Delaware trial date in the NuVasive case is not entitled to much weight. *See Amazon.com, Inc. et al. v. NL Giken, Inc.*, IPR2025-00250, Paper 14 (Director May 16, 2025).

Even if the scheduled trial date of the Delaware Action holds, Office error, Medtronic’s [REDACTED] and the complexity of the parties’ dispute support institution. In both *Tesla* and *Shenzhen*, which also involved many asserted patents, the district court trials were scheduled to occur before the Board’s final decision. *Tesla*, IPR2025-00217, Paper 9 at 2; *Shenzhen*, IPR2025-00438, Paper 10 at 3. Even so, in both instances, the Office ordered institution, holding that the “large number and vast scope” of asserted patents “tip[s] the balance” in favor of Board review despite the scheduling conflict. *Tesla* at 2-3; *see also Shenzhen* at 3. Here, where the Board’s final decision will issue many months before trial in the Minnesota Action, the case for institution is undeniable.

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. 1040, ¶¶22, 34, 304-305.) That addition ensured that the case remained in its infancy at this time.

Although Moskowitz blames Medtronic for extensions to the district court schedule (DD Req., 7-8), those extensions were necessitated by Moskowitz's eleventh-hour addition of a new patent to the complaint and jointly agreed to by the parties. (Ex. 2005; Ex. 2016.)

D. Factor 4: The *Sotera* Stipulation Supports Institution

Medtronic's filing of a *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," at least as to claims 1, 2, 4, 7-14, and 16-20. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (P.T.A.B. Dec. 1, 2020) (precedential). Moskowitz contends that instituting review will not result in "simplification" of the issues for the district court because Medtronic's petition does not challenge "one asserted claim" and has not yet challenged the '088 patent recently asserted against Elevate and Catalyft. (DD Req., 10-11.) But the instant IPR can (and likely will) meaningfully simplify the district court proceeding by reducing the number of claims left for the district court to resolve. The district court observed as much during the hearing on the motion to stay. (*See* Ex. 1071 at 24:8-21 (noting that 60 claims "seems like an awful lot less than 150 to me").) Moreover, Moskowitz omits that the '088 patent was formally added less than three months ago (Ex. 1040, ¶¶22, 34, 304-305) and Medtronic is not statutorily barred from challenging it.

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

Moskowitz’s contention that “the Petition does not present compelling merits” is based solely on its claim that it will be able to antedate Palmatier by showing prior conception of the claims coupled with a diligent reduction to practice. (DD Req., 13.) Setting aside the fact that Moskowitz did not challenge Palmatier’s prior art status during prosecution, Moskowitz has yet to produce any evidence of prior conception and diligence sufficient to antedate Palmatier. (DD Req., 14 (noting that it “will elaborate . . . more fully” this antedating theory in its forthcoming preliminary response).) While Moskowitz did present certain evidence in IPR2026-00162, that evidence concerns a different patent with different claims—and nonetheless fails to carry Patent Owner’s burden of proof. Regardless, the evidence cannot antedate Palmatier *pre-institution*. *See* IPR2026-00162, Paper 10 at 2.

VI. SETTLED EXPECTATIONS FAVOR INSTITUTION

Moskowitz’s settled expectations based on the 2018 issue date of the ’284 patent (*see* DD Req., 4-5) do not warrant denial of review given the clear evidence

of Office error and other factors (discussed above) that strongly favor review. Moreover, Moskowitz’s arguments in prior IPRs confirm that the settled expectations doctrine favors review (not denial thereof).

Moskowitz previously argued that settled expectations with respect to Medtronic’s IPRs should be judged from the vantage point of a “portfolio-wide notice” provided to Medtronic by Moskowitz in 2015. *See* IPR2026-00162, Paper 6 at 5-6. Moskowitz argued that the 2015 notice triggers settled expectations for even those patents, which issued *after* the 2015 notice. *Id.* For example, Moskowitz argued that U.S. Patent No. 12,011,367 (“the ’367 patent”) (Ex. 1074), which issued almost ten years later on June 18, 2024, had settled expectations because the 2015 notice covered “ancestors of the ’367 patent.” *Id.* Under that logic, the 2015 notice also applies to the ’284 patent, which is a great-grand parent of the ’367 patent. (Ex. 1074, cover.) This matters because Medtronic expressly stated in January 2016 that it “does not wish to pursue acquisition or license of” Moskowitz’s portfolio, including the ancestor applications of the ’284 patent. (Ex. 1040, ¶¶49, 117; Ex. 1041, ¶49.) Medtronic’s refusal and Moskowitz’s subsequent failure to sue Medtronic until a decade later confirms that settled expectations do not warrant denial of review.

The Director’s decision in *Apple Inc. v. Ferid Allani*, IPR2025-00856, Paper 11 (Director Sept. 5, 2025) (informative) is instructive. In *Apple*, the settled

expectations of a 13-year-old patent were outweighed by the fact that the Patent Owner waited 11 years to sue after the Petitioner declined a license. *Apple*, IPR2025-00856, Paper 11 at 3. Like in *Apple*, Medtronic's rejection of a license put the onus on Moskowitz to either sue or hold its peace. Moskowitz chose not to sue Medtronic for almost 10 years since the January 2016 license refusal even though Medtronic continued commercialization of the allegedly infringing technology. In fact, while it sued Medtronic's competitors (Globus in 2019 and ZimVie in 2022), *see* IPR2026-00162, Paper 7 at 7-8, Moskowitz ignored Medtronic, which strengthened Medtronic's expectation that Moskowitz would not sue Medtronic for infringement of the '284 patent. Moskowitz's failure to sue in a timely manner negates any claim that it has settled expectations of patent validity.

VII. CONCLUSION

Given that the discretionary denial considerations support institution as discussed above, Medtronic requests institution to allow the Board to correct the Office's error in issuing claims 1, 2, 4, 7-14, and 16-20.

Respectfully submitted,

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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 April 22, 2026:

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