

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,
Petitioner

v.

MOSKOWITZ FAMILY LLC,
Patent Owner.

Case IPR2026-00217
Patent No. 10,426,633

PETITIONER'S DISCRETIONARY DENIAL OPPOSITION

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Statutes

35 U.S.C. § 325(d)	2, 5, 6
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LIST OF EXHIBITS

Exhibit No.	Document	Previously Submitted
Ex. 1001	U.S. Patent No. 10,426,633 to Moskowitz et al. (“the ’633 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. 10,426,633	X
Ex. 1005	RESERVED	
Ex. 1006	U.S. Patent Application Publication No. 2008/0249569 A1 to Waugh et al. (“Waugh”)	X
Ex. 1007- Ex. 1012	RESERVED	
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	

Exhibit No.	Document	Previously Submitted
Ex. 1024	U.S. Patent No. 9,585,766 to Robinson (“Robinson”)	X
Ex. 1025- Ex. 1039	RESERVED	
Ex. 1040	Second Amended Complaint, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Minn. filed Jan. 29, 2026), Dkt. 48.	
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.	
Ex. 1043- Ex. 1044	RESERVED	
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	Patent Owner’s Infringement Claim Charts, Exhibit F1, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Minn.), served October 30, 2025.	X
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

Exhibit No.	Document	Previously Submitted
Ex. 1065	Thomas Steffen et al., <i>Cages: designs and concepts</i> , 9 EUR. SPINE J. S89 (2000)	X
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	U.S. Patent No. 6,102,950 to Vaccaro (“Vaccaro”)	X
Ex. 1068- Ex. 1069	RESERVED	
Ex. 1070	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).	X
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.	
Ex. 1072- Ex. 1073	RESERVED	
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 F1, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Minn.), served January 30, 2026.	
Ex. 1077	Patent Owner’s Infringement Claim Charts, Exhibit F2, <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. 10,426,633 ("the '633 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, including all three independent claims 1, 14, and 19, are unpatentable as anticipated

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.

by Palmatier (Ex. 1057). (Petition, 3.) The Examiner, however, overlooked Palmatier, which was buried in a 321-reference Information Disclosure Statement (“IDS”)—nearly thirteen times the size of a typical IDS. (Ex. 1004, 284 (reference no. 311).) *Ecto World LLC v. RAI Strategic Holdings Inc.*, IPR2024-01280, Paper 13 at 5 (Director May 19, 2025) (precedential). Other than the Examiner’s initials on the IDS citing Palmatier, the file history of the ’633 patent includes no evidence that the Examiner considered Palmatier.

The lack of consideration of Palmatier’s teachings, which are anticipatory, demonstrates that the Office erred in performing a complete and thorough review of the prior art. As explained below in Section II.B, Palmatier discloses each of the limitations that the Examiner found missing from the prior art—a fact Moskowitz does not (and cannot) dispute. The Petition therefore demonstrates material error by the Office warranting review. *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 allowable features of the claims”).



[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 (Director Oct. 17, 2025) (holding that a district court trial date four months after the anticipated final written decision date “counsel[s] against discretionary denial”).

Settled Expectations. The ’633 patent’s 2019 issue date cannot overcome the clear Office error in allowing the ’633 patent claims. 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 Examiner initially rejected then-pending claims of the ’633 patent over Vaccaro but allowed them after being persuaded that Vaccaro does not disclose a

“slot” in the claimed “second movable portion,” among other limitations. (Ex. 1004, 245-257, 310-317.) In doing so, the Examiner allowed the claims of the ’633 patent despite the presence of anticipatory prior art (Palmatier) in the file history. This is the type 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, Palmatier (Ex. 1057) was not applied in a rejection, was buried in a 321-reference IDS, and discloses *every* limitation of the challenged independent claims.

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

The Examiner never relied on Palmatier to reject the claims. Nor does the prosecution history of the ’633 patent include any commentary regarding Palmatier suggesting that the Examiner carefully evaluated it. These facts support material error under *Becton Dickinson* factor (c) 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) also supports a finding of material error because the IDS citing Palmatier (and initialed by the Examiner) included 321 references, which is nearly thirteen times the size of a typical IDS. (Ex. 1004, 273-285.) *Ecto*

World, Paper 13 at 7 n.3 (noting that a typical IDS contains fewer than 25 references).

Despite the large volume of references cited, Moskowitz did not provide any “information or assistance regarding the relevance of references” to the Examiner.

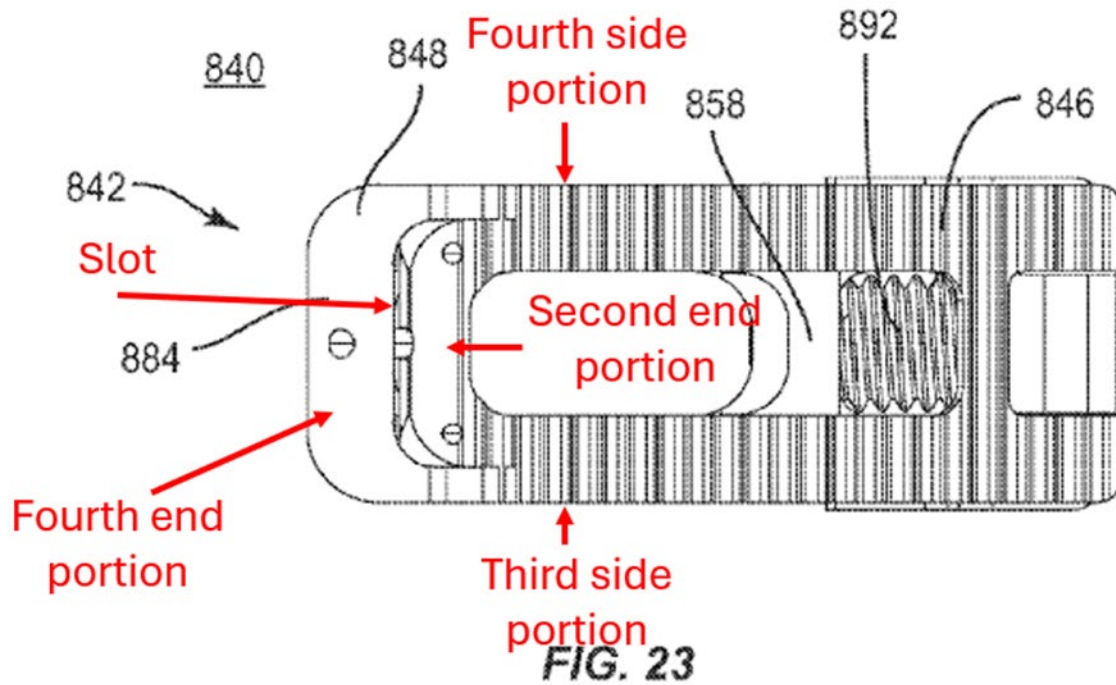
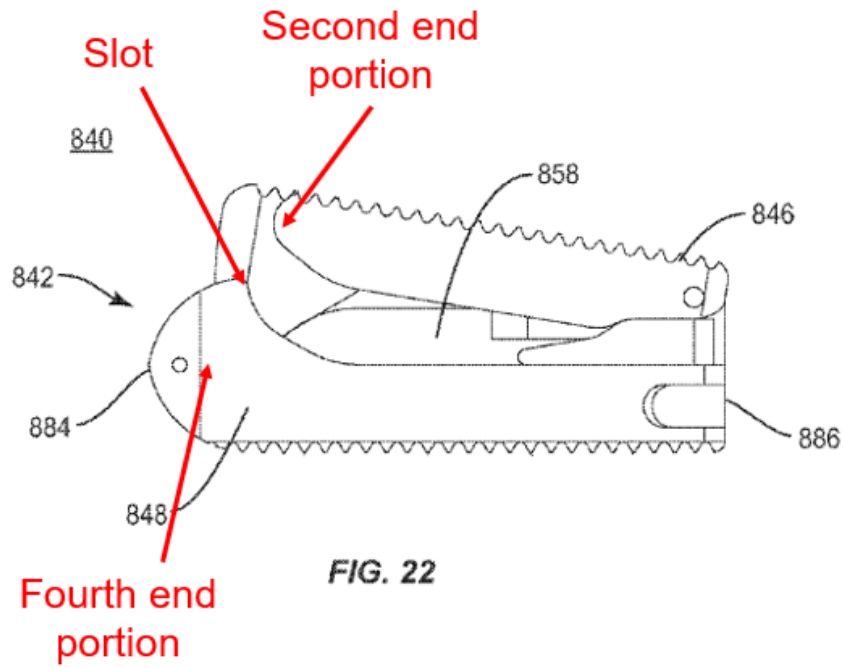
Ecto World, Paper 13 at 6-7. These facts demonstrate that “denial under § 325(d) is not warranted.” *Ecto World*, Paper 13 at 7; *see also Nespresso USA, Inc. v. K-Fee System GmbH*, IPR2022-01574, Paper 12 at 50-52 (P.T.A.B. Apr. 14, 2023) (declining to exercise discretion where asserted art was cited in voluminous IDS and not relied upon by Examiner during prosecution).

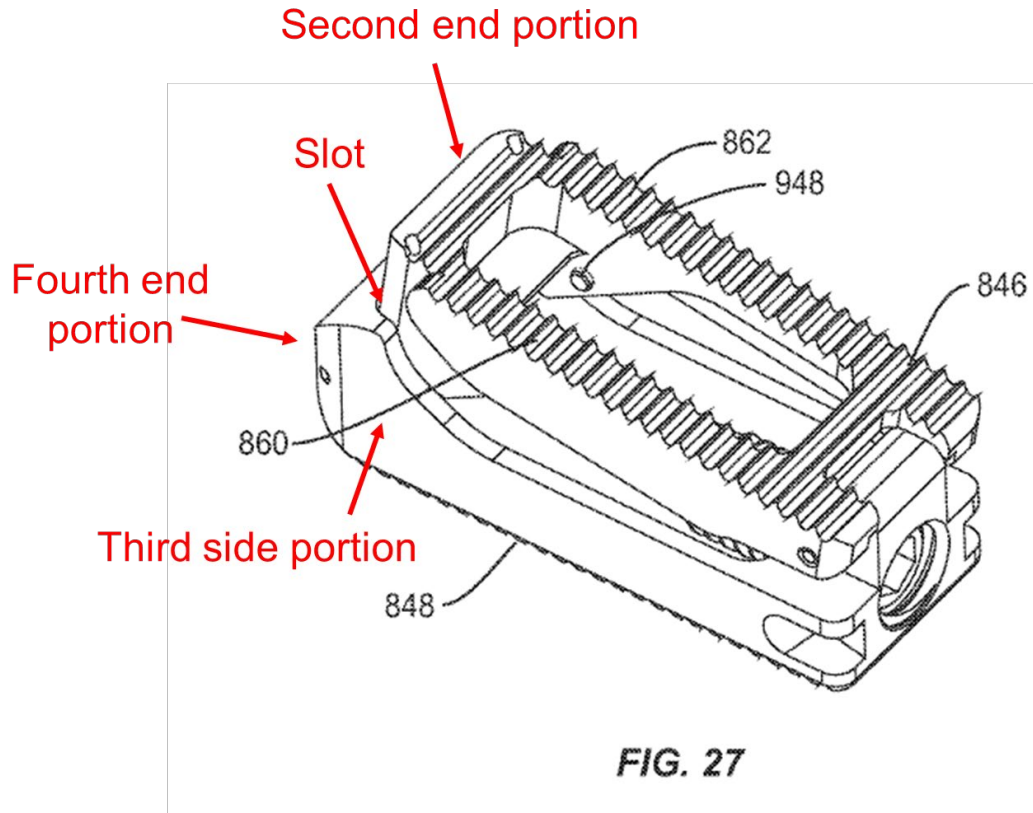
B. *Becton Dickinson* Factor (e) (Examiner Error)

The '633 patent Examiner's failure to evaluate Palmatier's teachings supports a finding of Examiner error under *Becton Dickinson* factor (e) because Palmatier discloses each claim limitation that formed the basis for allowance—a *fact Moskowitz does not dispute*. During prosecution of the '633 patent, the Examiner initially rejected then-pending claims of the '633 patent over U.S. Patent No. 6,102,950 (“Vaccaro”) (Ex. 1067). (Ex. 1004, 245-257.) In response, Moskowitz distinguished Vaccaro by arguing that “Vaccaro has no second movable portion defining a slot as claimed,” “Vaccaro does not have a wedge that is configured to slide in a direction toward the second and fourth ends to hingedly open the first movable portion with respect to the second movable portion,” “Vaccaro does not have a wedge that remains axially confined within the space [defined by the first and

second movable portions in the first and second wedge positions],” and Vaccaro does not disclose the size and positioning relationship between the second and fourth end portions. (*Id.*, 297-298.) The Examiner was persuaded by those arguments. (*Id.*, 316-317.) The Petition, however, demonstrates that Palmatier discloses each of these limitations. (Petition, 11.)

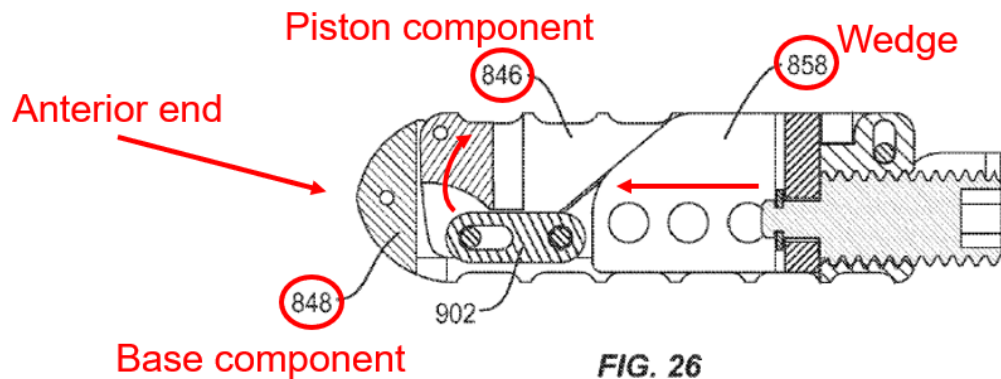
As explained in the Petition, Palmatier discloses an implant 840, which includes a piston component 846 (“first movable portion”) and a base component 848 (“second movable portion”), which has side walls that create a slot to nest part of piston component 846 within base component 848. The claimed slot is illustrated in the figures below, which demonstrate that the slot is in the “fourth end portion” of the “second movable portion” and accommodates the “second end portion” of the “first movable portion.” (*See also* Petition, 24-27, 31-33, 44-47.) Moskowitz does not dispute Petitioner’s above analysis.





(Ex. 1057, Figs. 22, 23, 27 (all annotated).)

The Petition further demonstrates that Palmatier discloses the claimed wedge sliding between the first and second movable portions to hingedly open the first movable portion with respect to the second movable portion. (Petition, 53-56.)



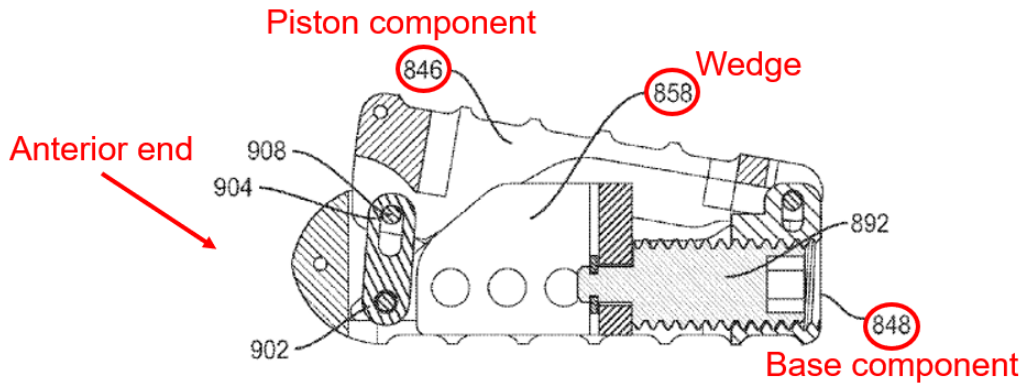


FIG. 24

(Ex. 1057, Figs. 26, 24 (both annotated).) And the Petition demonstrates the claimed size and positional relationship between the second and fourth end portions. (Petition, 78-79.)

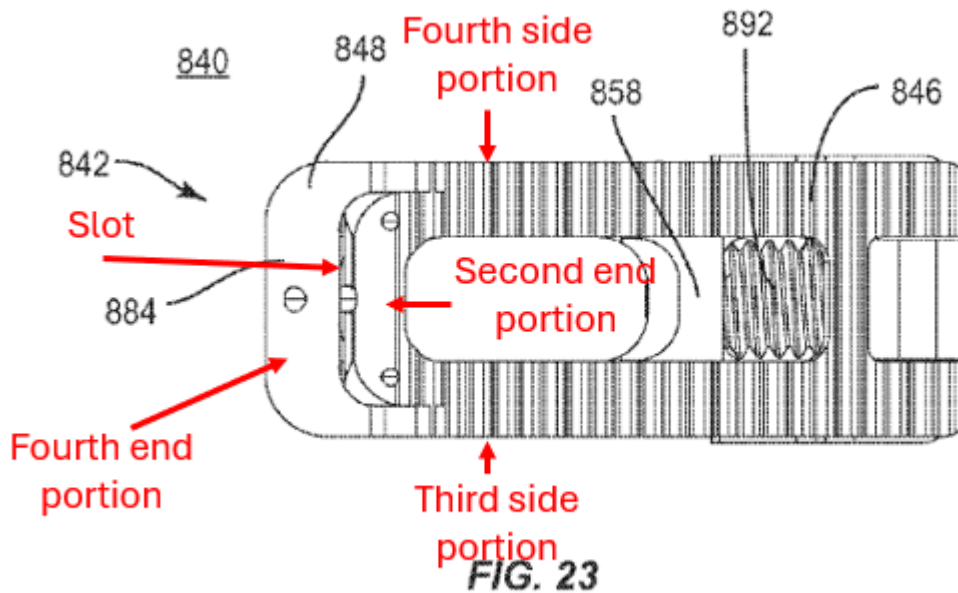


FIG. 23

(Ex. 1057, Fig. 23 (annotated).)

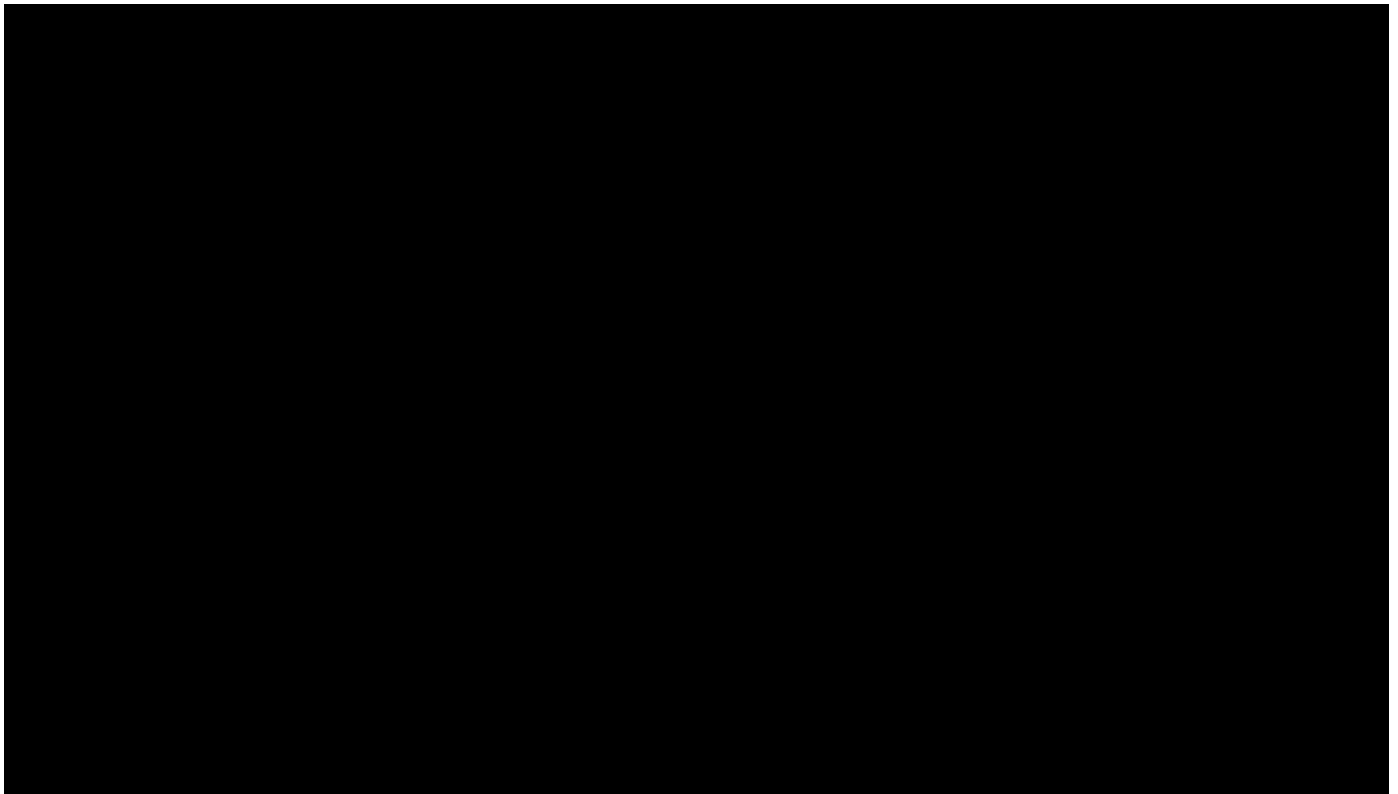
Moskowitz does not dispute any of the above analysis. Instead, Moskowitz invites the Office to look past the Examiner's error because "the Examiner [allegedly]

considered Palmatier as a whole . . . and still allowed the claims.” (DD Req., 15.)

But Moskowitz cannot point to a single citation to Palmatier’s embodiments in the ’633 patent file history.

Moskowitz also contends that the Examiner of related U.S. Patent No. 10,016,284 supports the view that the Office reviewed Palmatier and found it lacking with respect to the “slot” limitation. (DD Req. 16.) But, as explained in the concurrently filed Opposition in IPR2026-00216, the Examiner of the ’284 patent erred in his analysis by ignoring the embodiment of figures 22-26.

The ’633 patent Examiner’s failure to appreciate and apply Palmatier’s disclosures against the challenged claims constitutes material error and warrants review of the Petition.



[REDACTED]

[REDACTED]

[REDACTED] Both of these considerations heavily favor review.

[REDACTED]

[REDACTED] Moskowitz is a non-practicing entity “created to develop human spine related devices and protect and license any resulting inventions and intellectual property.” (Ex. 1040, ¶7.) [REDACTED]

[REDACTED]

[REDACTED]

IV. 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 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. 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 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 10 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.

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., 9.) 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., 11.) 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., 12 (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 2019 issue date of the ’633 patent (*see* DD Req., 3-4) 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 ’633 patent, which is a grandparent 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 ’633 patent. (Ex. 1040, ¶¶49, 183; 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 ’633 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 Office

error in issuing claims 1, 2, 4, 7-14, and 16-20.

Respectfully submitted,

Dated: April 22, 2026

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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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