

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,
Petitioner,
v.

MOSKOWITZ FAMILY LLC,
Patent Owner

IPR2026-00217
Patent No. 10,426,633

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

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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I. INTRODUCTION

Petitioner's Reply turns on two artificial carveouts. For priority, Petitioner carves the tool work out of the diligence timeline, even though the challenged claims recite tools and tool-facing implant features for mating, gripping, inserting, and screw actuation. For *Revvo/Tesla*, Petitioner carves its IPR claim mapping away from its district court claim scope positions, even though both concern the same claimed structures in the same Medtronic development record.

Those carveouts fail. The POPR mapped the challenged claims to the May 2011 conception evidence, the October 25, 2012 provisional, and the diligence record between them. Petitioner identifies no missing limitation in either mapping. And Petitioner's *Revvo/Tesla* problem is concrete: it maps Palmatier broadly here without construction, uses the accused-product infringement charts as confirmation, then denies in district court that those same products infringe the same claims.

On this record, Palmatier is not prior art. And Petitioner has not cured the *Revvo/Tesla* problem. Institution should be denied.

II. ARGUMENT

A. Petitioner's Conception Attack Has a Missing Limitation Problem.

Petitioner's conception attack starts with a label and ends with an omission. It calls the May 2011 materials "sketch-level," but it never identifies a claim limitation missing from Patent Owner's mapping. Conception does not require final manufacturing drawings or a prototype. It requires a definite and permanent

understanding of the complete invention. The May 3 design materials show work on an updated wedge-based expandable implant and related expandable designs. Ex. 2027, 1. The modified wedge drawing showed the claimed wedge-driven expandable architecture. *Id.* at 10.

Petitioner mistakes later development choices for the legal test for conception. The fact that the inventors continued refining alternatives or selected another embodiment for initial prototyping does not erase what the May 2011 record already showed. Nor is that record limited to one drawing. It includes the modified wedge drawing, contemporaneous discussions of tool-engagement and bone-material-receiving features, and Dr. Moskowitz's testimony confirming that those features were intended for the expandable implant embodiments. POPR at 6, 44–47, 76–76; Exs. 2024 ¶¶ 27–36, 41–46; 2027 at 10; 2030; 2031; 2056 at 8, 11; 2059. Together, those materials show a definite understanding of the claimed invention by May 18, 2011. Petitioner never identifies any implementation detail missing from that record that would have prevented a skilled artisan from reducing the invention to practice.

Aptor does not help Petitioner. There, the emails did not identify the attachments or what they disclosed, so inventor testimony had to supply the missing content. 887 F.3d at 1296–97. Here, the May 3 email identified the design materials, and the modified wedge drawing itself depicts the operative architecture. Ex. 2027 at 10. It shows the wedge, pivot, screw, retaining ring, and annotated operation: the

user rotates the screw, the wedge moves axially, and the top pivots upward. *Id.* Dr. Moskowitz’s testimony does not supply missing structure. It explains contemporaneous documents that already provide the corroboration *Apator* found missing. *See Global Health Sols. LLC v. Selner*, 148 F.4th 1363, 1374 (Fed. Cir. 2025). The same architecture appears again in the October 2012 provisional. POPR at 7–75; Ex. 2024 ¶¶ 31–33.

B. Petitioner’s Diligence Gap Depends on Rewriting the Claims.

Petitioner creates an alleged diligence gap by carving the tool out of the claimed system. The ’633 claims recite tool-facing implant features such as indentations grabbed by an insertion tool and tools for gripping and inserting the device, turning the rotation screw, and operating the device by inserting it and turning the screw. Claims 4, 7–9, 13, 18–20. Work on the insertion-and-actuation tool was therefore work on the claimed implant system.

The ’543 tool application confirms that connection. It was filed the same day Andy Moskowitz contacted Mr. Sugalski about the expandable cage project. Ex. 2024 ¶¶ 24–25; Ex. 2025; Ex. 2026 at 1. It claimed a tool assembly with prongs for gripping the implant and a driver/key for actuating the height adjustment mechanism of an “expandable or non-expandable screw box.” Ex. 2026, 8–10. That is not a separate invention for diligence purposes. It is the tool interface and actuation work the challenged claims recite.

The remaining record shows reasonably continuous diligence, not abandonment. The law does not “scour” for undocumented intervals; it asks whether the evidence as a whole shows reasonable continuity. *Perfect Surg. Techniques, Inc. v. Olympus Am., Inc.*, 841 F.3d 1004, 1007–11 (Fed. Cir. 2016). Here, the record shows November–December 2011 drawings and descriptions, January 2012 review and bone-cavity discussions, February–March 2012 tool application work describing tool-actuated expandable embodiments, spring–summer 2012 prosecution, prototype, and application work, and immediate post-allowance continuation work. Ex. 2045 at 1–7, 10, 13, 16, 20; Ex. 2046 at 1–3; Ex. 2024 ¶¶ 102–18; Ex. 2051; *see also* POPR at 76–80; Ex. 2024 ¶¶ 65–118. The October 25 provisional followed shortly thereafter. That is reasonably continuous diligence.

C. Petitioner Has Not Cured the *Revvo/Tesla* Problem.

Petitioner asks the Board to decide validity in view of *Palmatier* under a claim scope Petitioner will not own. In this IPR, Petitioner says no construction is needed and that *Palmatier* invalidates the challenged claims under any reasonable construction. But Petitioner told the district court that its invalidity theories may depend on multiple constructions and that disclosing those theories could create institution problems. Ex. 2063 at 19–23. The Reply does not close that gap. Petitioner still has not committed to that claim scope, disclaimed inconsistent district court positions, or agreed to be bound by its *Palmatier* mapping.

The inconsistency is now concrete. The Petition uses Patent Owner’s accused product infringement charts as a sword. It maps Palmatier broadly to the ’633 claims and repeatedly says that mapping is “consistent with” Patent Owner’s infringement charts for the accused Medtronic products. Petition at 26, 29, 32, 38, 39, 63, 65, 67, 73, 74, 94. But in district court, Petitioner denies that those same products infringe those same claims. Those positions are inconsistent. Petitioner cannot use that claim scope to invalidate here, then deny it to avoid infringement there.

Petitioner’s district court invalidity contentions highlight the problem. Palmatier is not a printed publication theory that disappears if the Board resolves priority for Patent Owner. Petitioner ties Palmatier to Medtronic development work behind the accused products and advances Palmatier-related system-art theories in district court.¹ If the Board institutes, Petitioner gets two opportunities to litigate the same Palmatier-centered story: a printed-publication theory before the Board, and again as system art in district court—with the same priority dispute. That duplication is the forum flexibility *Revvo* and *Tesla* caution against. It would let Petitioner pursue a construction-free Palmatier theory here while preserving narrower claim-scope positions and Palmatier-system-art theories in district court.

¹ Patent Owner does not submit those contentions because no new evidence was authorized, but will provide excerpts if permitted.

Date: June 5, 2026

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S SURREPLY IN SUPPORT OF POPR** was served electronically via e-mail on June 5, 2026, in its entirety on the following counsel of record for Petitioner:

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