

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,
Petitioner

v.

MOSKOWITZ FAMILY LLC,
Patent Owner

Case No. IPR2026-00265
Patent No. 10,064,738

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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PATENT OWNER’S EXHIBIT LIST

Exhibit	Description
2001	Pretrial Scheduling Order, <i>Moskowitz Family LLC v. Medtronic, Inc. et. al.</i> , No. 0:25-CV-00769-PJS-DLM, ECF No. 36 (Dist. Of Minn. September 10, 2025) (Micko, D.)
2002	Stipulation Extending Time For Defendants To Respond To Plaintiff’s Complaint, <i>Moskowitz Family LLC v. Medtronic, Inc. et. al.</i> , No. 0:25-CV-00769-PJS-DLM, ECF No. 15 (Dist. Of Minn. March 19, 2025)
2003	Stipulation Extending Time For Defendants To Respond To Plaintiff’s Complaint, <i>Moskowitz Family LLC v. Medtronic, Inc. et. al.</i> , No. 0:25-CV-00769-PJS-DLM, ECF No. 24 (Dist. Of Minn. May 22, 2025)
2004	Minute Entry re Hearing on Motion to Stay, <i>Moskowitz Family LLC v. Medtronic, Inc. et. al.</i> , No. 0:25-CV-00769-PJS-DLM, ECF No. 68 (Dist. Of Minn. March 6, 2026)
2005	Stipulation to Amend Case Scheduling Concerning Contentions and Claim Construction, <i>Moskowitz Family LLC v. Medtronic, Inc. et. al.</i> , No. 0:25-CV-00769-PJS-DLM, ECF No. 42 (Dist. Of Minn. January 16, 2026)
2006	October 3, 2025 Update to USPTO Interim Director Discretionary Process
2007	March 24, 2025 Guidance on USPTO’s rescission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District court Litigation”

2008	USPTO FAQs for Interim Processes for PTAB Workload Management (Archived)
2009	Amended Pretrial Scheduling Order, <i>Moskowitz Family LLC v. Medtronic, Inc. et. al.</i> , No. 0:25-CV-00769-PJS-DLM, ECF No. 44 (Dist. Of Minn. January 20, 2026)
2010	Second Amended Complaint, <i>Moskowitz Family LLC v. Medtronic, Inc. et. al.</i> , No. 0:25-CV-00769-PJS-DLM, ECF No. 48 (Dist. Of Minn. January 29, 2026)
2011	Complaint, <i>Moskowitz Family LLC v. Medtronic, Inc. et al.</i> , No.0:25-cv-00769, ECF No. 1 (Dist. Of Minn February 28, 2025)
2012	<i>Uniloc USA, Inc. v. Motorola Mobility LLC</i> , Case No. 2:16-CV-00992-JRG, ECF No. 125 (E.D. Tex. Apr. 5, 2017)) (Gilstrap, J.)
2013	Transcript of Motion to Stay Hearing, <i>Moskowitz Family LLC v. Medtronic, Inc. et. al.</i> , No. 0:25-CV-00769-PJS-DLM (Dist. Of Minn. March 6, 2026)

I. INTRODUCTION

The Director should deny institution because this Petition would not provide an efficient alternative to the parallel district court litigation. The '738 patent has been in force for nearly eight years. The same parties are already litigating it in Minnesota. And the Petition does not present a straightforward case of overlooked prior art. It depends on a multi-step theory involving disputed priority, alleged written-description gaps, later prosecution statements from a different patent, and obviousness combinations that Petitioner will continue to litigate in district court. Those circumstances favor discretionary denial.

First, the '738 patent carries strong settled expectations. It issued in 2018 and has been in force for almost eight years—well beyond the six-year period the Director has recognized as supporting discretionary denial. Petitioner did not seek early review. It waited until after Patent Owner sued and then filed this Petition near the statutory deadline. Petitioner may point to a 2015 licensing discussion involving earlier family members, but that discussion cannot erase settled expectations in the later-issued '738 claims. Those claims are assessed based on their own issue date, public life, and settled expectations.

Second, Petitioner's district-court conduct confirms that institution would not promote efficiency. Petitioner sought extensions and a stay while acknowledging that its district court contentions under different claim constructions could create

problems for institution. Petitioner now asks the Board to institute while preserving room to advance positions in district court that this proceeding will not resolve. The Director should not encourage that approach.

Third, the Minnesota litigation is active and will remain active regardless of institution. The case has been pending for more than a year. The parties have served contentions, exchanged written discovery, and produced substantial documents. The litigation also involves twelve asserted patents, numerous asserted claims, multiple accused product lines, and invalidity theories Petitioner expressly reserves for district court. Institution would not materially simplify that case.

Finally, the Petition does not present compelling merits or clear Office error. Petitioner's theory requires the Board to accept a disputed priority challenge, treat Patent Owner's own family disclosure as prior art, rely on later statements from another prosecution, and combine multiple references to reach the challenged claims. That is not the kind of clear, compelling showing that overcomes settled expectations and parallel-litigation concerns.

Each point supports denial. Together, they make discretionary denial appropriate.

II. THE DIRECTOR SHOULD EXERCISE DISCRETION UNDER § 314(a) TO DENY INSTITUTION.

The Director has broad discretion to deny institution even when a petition satisfies the threshold for review. The USPTO "is permitted, but never compelled,

to institute” an IPR. *Nautilus Hyosung Inc. v. Diebold, Inc.*, IPR2017-00426, Paper 17 at 11 (PTAB June 22, 2017). That discretion is especially important where Board review would duplicate, rather than streamline, a parallel district-court case. *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019).

The traditional *Fintiv* factors guide that analysis. They include whether the district court has granted or is likely to grant a stay, the proximity of trial to the Board’s projected final written decision, the parties’ and court’s investment in the parallel case, the overlap between the proceedings, whether the parties are the same, and other circumstances bearing on discretion, including the merits. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020).

Recent Director guidance also confirms that settled expectations are central to the discretionary-denial analysis. Relevant considerations include “the length of time the claims have been in force.” Director’s March 26, 2025 Mem., *Interim Processes for PTAB Workload Management*, at 2-3. Decisions applying that guidance have denied institution where mature patent rights, delayed petitions, and parallel litigation made Board review an inefficient use of agency resources—even when certain *Fintiv* factors pointed the other way. *Dabico Airport Solutions Inc. v. AXA Power APS*, IPR2025-00408, Paper 21 at 3 (Acting Director Stewart June 18, 2025);

iRhythm Techs., Inc. v. CardioNet, LLC, IPR2025-00363, Paper 10 at 3 (Acting Director Stewart June 6, 2025).

Those considerations point in one direction here: denial. The '738 patent issued nearly eight years ago, yet Petitioner did not seek early review. Petitioner waited until after Patent Owner filed suit, and then until near the statutory deadline, to seek review. The Minnesota litigation has heavy investments, involves the same parties, and will continue regardless of institution. And the Petition does not present a clear, compelling challenge that could justify reopening settled patent rights in a duplicative forum. Discretionary denial is warranted.

A. The '738 Patent's Settled Expectations Strongly Favor Discretionary Denial.

The nearly eight years that '738 patent has been in force matters. Director guidance recognizes that settled expectations grow stronger with “the length of time the claims have been in force,” and recent decisions applying that guidance have treated patents of similar age as creating strong settled expectations. *Dabico Airport Solutions Inc. v. AXA Power APS*, IPR2025-00408, Paper 21 at 3 (Acting Director Stewart June 18, 2025) (“[T]he longer the patent has been in force, the more settled expectations should be,” and finding a nearly eight-year-old patent created settled expectations); *Amgen Inc. v. BristolMyers Squibb Company*, IPR2025-00601-602, Paper 9 at 3 (July 24, 2025) (finding “strong settled expectations” for patents in force for seven and six years).

Those expectations are not displaced merely because Petitioner now wants Board review. The Director has denied institution based on settled expectations even where a final written decision would issue before trial, and even where the district court case was stayed. *OnePlus Tech. Co., Ltd. v. Pantech Corp.*, IPR2025-00637, Paper 17 at 2 (August 14, 2025) (denying institution despite vacated trial date); *Kahoot! AS v. Interstellar Inc.*, IPR2025-00696, Paper 12 at 2 (July 31, 2025) (denying institution despite a stay based on a 6-year-old patent).

Petitioner has tried in related proceedings to avoid settled expectations by pointing to a 2015 licensing discussion involving earlier Moskowitz family members. *E.g., Medtronic, Inc. v. Moskowitz Family LLC*, IPR2026-00216, Paper 9 at 4 (Apr. 22, 2026). That argument does not fit this patent. The application underlying the '738 patent was filed in 2017, and the patent issued in 2018. Whatever the parties discussed in 2015, those discussions do not eliminate the settled expectations developed thereafter by the later-issued '738 claims. Petitioner itself has recognized that “each challenged patent is reviewed for settled expectations based on its own issue date.” *Medtronic, Inc. v. Moskowitz Family LLC*, IPR2026-00162, Paper 7 at 6 (Mar. 9, 2026) (citing *Tanklogix, LLC v. SitePro, Inc.*, IPR2025-00647, Paper 10 (July 31, 2025)).

Petitioner did not seek early review here. In *Tanklogix*, the acting Director stated that “early challenges favor robust, predictable patent rights.” *Tanklogix* at 3.

But Petitioner did not challenge the '738 patent during its first year, or its second, or its third. It waited until the very last minute after Patent Owner sued. That delay weighs against institution. *iRhythm Techs., Inc. v. CardioNet, LLC*, IPR2025-00363, Paper 10 at 3 (Acting Director Stewart June 6, 2025) (petitioner's "failure to seek early review of the patents favors denial and outweighs" other considerations).

The result is straightforward. The '738 patent is a mature patent, long in force, that Petitioner chose not to challenge until well after litigation began. The settled expectations are substantial. They favor discretionary denial.

B. Petitioner Withheld Claim-Scope Positions That Director Precedent Required It to Disclose.

Petitioner asks the Board to review the '738 patent while preserving different claim construction positions for district court. That approach conflicts with the disclosure obligation governing IPR petitions and with recent Director precedent addressing inconsistent claim construction positions across forums.

A petition must identify "[h]ow the challenged claim is to be construed." 37 C.F.R. § 42.104(b)(3). That requirement carries particular force because the Board applies the same *Phillips* standard used in district court. The Office adopted that standard to reduce forum-dependent claim scope and to require petitioners to choose the construction that best reflects the claims' meaning, rather than pursuing one scope for invalidity before the Board and another in litigation.

Recent Director decisions enforce that principle. In *Revvo*, the Director held that when a petitioner advances different claim-construction positions across forums, the petition must sufficiently explain why those different positions are warranted. *Revvo Techs. v. Cerebrum Sensor Techs.*, IPR2025-00632, Paper 20 at 4–5 (Director Nov. 3, 2025). In *Tesla*, the Director denied institution where a petitioner treated a limitation as definite enough for IPR while arguing in district court that the same limitation was indefinite, without adequately explaining the inconsistency. *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 at 3–4 (Director Nov. 5, 2025). And in *Generac*, the Director again denied review where the petitioner advanced materially different claim-scope positions across forums without sufficient explanation. *Generac Power Sys., Inc. v. Champion Power Equip., Inc.*, IPR2025-00805, Paper 40 at 4–5 (Director Feb. 3, 2026).

Petitioner did not satisfy that requirement here. The Petition states that, except for certain alleged means-plus-function terms, “the Board need not construe any claim terms.” Pet. at 13. It then asserts that the claims are unpatentable under “any reasonable construction,” while expressly reserving “all rights to raise claim construction and other arguments in other venues,” including arguments concerning claim scope and district-court-only grounds. *Id.* at 13 n.3. Petitioner is not merely preserving abstract rights; it is preserving different claim-scope positions for the

parallel litigation while asking the Board to institute without knowing what those positions are.

Petitioner's rejected stay request confirms the problem. In district court, Petitioner sought to halt the case before its invalidity, noninfringement, and claim-construction positions had to be fully disclosed. At the stay hearing, Petitioner acknowledged that claim construction would affect its contentions and explained that, in a "typical world," it would disclose theories under multiple possible constructions. Ex. 2013 at 19–23. Petitioner then explained why it did not want to do that while the IPR petitions were pending: disclosing those positions could lead the Director to view Petitioner's PTAB and district-court positions as inconsistent and deny institution. *Id.* at 20.

That is precisely the concern *Revvo*, *Tesla*, and *Generac* address. A petitioner cannot ask the Board to institute under an undefined or broad claim scope while withholding narrower claim-scope or indefiniteness positions for district court. If Petitioner intends to pursue different claim constructions or indefiniteness theories in Minnesota, those positions should have been disclosed and explained in the Petition. They were not.

Institution would therefore encourage the very forum-dependent claim-scope strategy the Director has rejected. Petitioner should not be permitted to avoid

disclosure in the Petition, seek a stay to delay disclosure in district court, and then preserve inconsistent positions for later. This favors discretionary denial.

C. The Asserted Patent Family Does Not Present the Kind of Complexity That Favors Institution.

Petitioner has argued in related proceedings that the Minnesota litigation is too complex for district-court resolution and therefore favors institution. That argument overreads *Tesla* and similar decisions. *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 (June 13, 2025). The relevant question is not whether the district case involves many patents. It is whether Board review would make the dispute more efficient. Here, it would not.

Petitioner's complexity argument rests largely on the number of asserted patents and the fact that some patents arise from continuation-in-part applications with different priority dates. But different priority dates do not, by themselves, create the kind of technological or case-management complexity that supports institution.

This case involves a related patent family, not a collection of unrelated technologies. The asserted patents share overlapping disclosures, inventorship, terminology, accused products, prior art, and claim-construction issues. Continuations-in-part may add new matter, but they also retain substantial portions of the parent disclosures. The resulting issues are therefore cross-cutting. Priority,

written description, claim scope, and invalidity will need to be assessed across related patents and related disclosures.

That is the wrong kind of complexity for multiple parallel PTAB proceedings. Institution would not assign discrete, unrelated validity disputes to the Board for efficient resolution. It would fragment overlapping issues across multiple IPRs, potentially before different panels, while the district court continues to address the same patent family, the same products, the same claim-construction disputes, and the same non-IPR invalidity theories.

The district court is better positioned to manage that integrated dispute. It can coordinate claim construction across the asserted patents, address shared priority and written-description issues in a single forum, and ensure consistent treatment of overlapping disclosures and accused products. Multiple IPRs cannot do that. They would add proceedings, not simplify the case.

The number of asserted patents therefore does not favor institution here. The asserted patents form a cohesive, interdependent family. Their overlapping issues are best managed together, not divided across parallel Board proceedings.

D. *Fintiv* Factor 1 Favors Denial Because the District Court Denied Petitioner's Stay Request.

Factor 1 favors discretionary denial. Petitioner asked the district court to stay the paralegal litigation based on its pending IPR petitions, and the court denied that request. Ex. 2004. The court declined to pause the case based on un-instituted

petitions and allowed the litigation to proceed, permitting renewal only if circumstances materially change.

Petitioner may argue that a stay is now more likely because other petitions have since been instituted. But that prediction does not change the existing record. Petitioner requested a stay, and the court denied it. The Board should not speculate that the district court will later grant a renewed motion. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (PTAB May 13, 2020) (informative) (cautioning against speculating whether the district court would grant a stay); *see also Catalyst Orthoscience Inc. v. Shoulder Innovations, Inc.*, PGR2025-00001, Paper 8 at 11-12 (April 24, 2025).

Nor would a stay materially simplify the litigation. The district court action involves twelve asserted patents, numerous asserted claims, and multiple accused product lines. Ex. 2010. Petitioner's IPR filings address only part of that dispute. Several asserted patents are not subject to any IPR, and others cannot be challenged because of the statutory time bar. The case therefore will proceed regardless of institution here.

That matters for Factor 1. Even if this Petition were instituted, the district court would still need to resolve claim construction, infringement, damages, non-IPR invalidity theories, and substantial portions of the asserted patent portfolio. Discovery would remain broad because the same accused products, related patents,

and overlapping technical issues would stay in the case. A stay would delay resolution without eliminating the work the district court must do.

Courts routinely deny stays where IPRs have not been instituted or would not materially narrow the case. *E.g.*, *Hutchinson Tech. Inc. v. Nitto Denko Corp.*, No. 17-CV-1992, 2018 WL 5984873, at *14–15 (D. Minn. Sept. 19, 2018); *Stratasys, Inc. v. Microboards Tech., LLC*, No. 13-3228, 2015 WL 1608344, at *2 (D. Minn. Apr. 10, 2015); Ex. 2012 at 3; *Dane Techs., Inc. v. Gatekeeper Sys., Inc.*, No. 12-2730 ADM/AJB, 2013 WL 4483355, at *2-3 (D. Minn. Aug. 20, 2013).

Here, the district court already denied Petitioner’s stay request, and the structure of the case confirms that a stay would not promote meaningful efficiency. Factor 1 favors denial.

E. *Fintiv* Factors 2 and 3 Favor Denial Because the District Court Case is Already Substantially Underway.

Factors 2 and 3 favor discretionary denial because the district court case is already moving through the stages that define the issues for trial. That work will continue regardless of whether this IPR is instituted.

The Minnesota action has been pending for more than a year. Ex. 2011. Discovery is underway. The parties have responded to written discovery and produced 168,773 pages of documents. Patent Owner has served infringement contentions, and Medtronic’s invalidity and noninfringement contentions are due imminently. By the expected August 26, 2026 institution decision, the parties also

will have exchanged claim-construction terms. Ex. 2009. At that point, the parties will have committed substantial resources to the same patent family, the same accused products, and overlapping validity issues. Institution would not avoid that work. It would follow it.

Petitioner also should not be allowed to minimize the district court's progress by relying on a schedule it helped create. Petitioner obtained a 60-day extension to respond to the complaint, followed by additional extensions tied to its request that Patent Owner amend the complaint. Exs. 2001–2003. Later, after a continuation patent issued in December 2025, Petitioner conditioned its consent to adding that patent on a three-month extension of invalidity, non-infringement, and claim-construction deadlines. Exs. 2005, 2009. Those extensions pushed back milestones that otherwise would have occurred earlier.

The practical point is straightforward. The district court case is not waiting for this IPR. The parties are investing in discovery, contentions, and claim construction now, and that work will remain necessary regardless of institution. Petitioner should not benefit from delays it requested and then use the resulting schedule to argue that the district case is insufficiently advanced. Factors 2 and 3 favor denial.

F. *Fintiv* Factor 4 Favors Denial Because Institution Would Not Eliminate Overlap or Meaningfully Simplify the District Court Case.

Factor 4 favors denial because institution would not materially narrow the district court case. Petitioner's IPR campaign leaves most of the dispute intact, ensuring that overlapping issues will proceed in parallel regardless of whether this Petition is instituted.

The remaining district court case is substantial. Petitioner has not challenged all asserted claims across the asserted portfolio. Its IPR petitions leave 60 of the 150 asserted claims for the district court to resolve. They also leave seven of the eight accused product lines in the case regardless of institution—including systems central to the dispute, such as Divergence, Sovereign, Elevate, Catalyft PL, PL40, and the Endoskeleton TAS and TCS platforms. Institution therefore would not remove the bulk of the products, patents, claims, or technical issues from the district court.

The overlap is also not limited to the challenged '738 claims. The same prior art, structural limitations, claim-scope disputes, and priority issues recur across the asserted patent family. Because related patents and claims will remain in the district court case regardless of institution, Petitioner can continue litigating overlapping art and arguments there even if estoppel later applies to the '738 patent. Board review would not replace the district court's work. It would proceed alongside it.

Petitioner’s lack of a timely *Sotera* stipulation confirms the limited simplification here. Although Petitioner has filed *Sotera* stipulations for other patents, it has not filed one for the ’738 patent or submitted one in this proceeding. The Office’s Interim Director Discretionary Process instructs petitioners to file such stipulations “as soon as practicable.” Ex. 2006 at 3. Petitioner should not be permitted to wait until after Patent Owner files this discretionary denial brief, submit a belated stipulation, and then claim reduced overlap without giving Patent Owner a fair opportunity to address the stipulation’s scope.

In any event, even a *Sotera* stipulation would not eliminate the duplication here. Director guidance makes clear that such stipulations are “not dispositive” where other invalidity theories remain available. Ex. 2007 at 2–3. Petitioner remains free to pursue system prior art, public-use and on-sale theories, and combinations involving non-printed publications—none of which are subject to IPR estoppel. *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1365–66 (Fed. Cir. 2025). Where those theories remain in play, any efficiency gained from Board review is necessarily limited. Ex. 2008 at 3.

The Petition itself underscores the point. Petitioner expressly “reserves all rights to raise . . . other arguments in other venues,” including “grounds that can only be raised in district court.” Pet. at 13 n.3. It also repeatedly invokes issues that cannot be resolved in IPR, including alleged written-description deficiencies and

related priority disputes. Pet. at 7–8, 21, 26–27. Those issues will remain for the district court even if the Board institutes review.

This IPR therefore is not a true alternative to district court. It is an additional proceeding addressing only part of a broader, overlapping dispute. The Office has denied institution in similar circumstances, including where a *Sotera* stipulation was offered. *SAP Am., Inc. v. Cyandia, Inc.*, IPR2024-01495, Paper 13 at 8–9 (Apr. 7, 2025); *Motorola Sols. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3–4 (PTAB Mar. 28, 2025).

Because institution would not materially simplify the district court case and would instead duplicate overlapping issues, Factor 4 favors denial.

G. *Fintiv* Factor 5 Favors Denial Because the Same Parties are Litigating the Same Disputes in District Court.

Factor 5 favors denial because Petitioner is the defendant in the parallel district-court action. The same parties are already litigating the '738 patent, the related patent family, and overlapping invalidity issues in Minnesota. *Fintiv*, at 13–14; *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020). Factor 5 favors discretionary denial.

H. *Fintiv* Factor 6 Favors Denial Because the Petition Does Not Present Compelling Merits or Clear Office Error.

Factor 6 favors denial because the Petition does not present the kind of clear, compelling merits showing that could outweigh settled expectations and parallel-

litigation concerns. The question is not whether the Petition is facially plausible. It is whether the merits are strong enough to justify institution despite duplication, inefficiency, and the maturity of the challenged patent. *Fintiv*, Paper 15 at 15. Even petitions that appear plausible may be denied where those concerns predominate. *Samsung Elecs. Co., Ltd. v. SiOnyx, LLC*, IPR2025-00065, Paper 16 at 19–20 (PTAB June 6, 2025).

This Petition is not compelling. Nor does it present a straightforward case of Office error. Petitioner’s theory depends on a series of contested steps: that the challenged claims are not entitled to priority before May 22, 2009; that Moskowitz ’440 therefore qualifies as prior art; that later prosecution statements from a different patent should control how figures in Moskowitz ’440 are interpreted; and that Waugh and Michelson ’019 should be combined with Moskowitz ’440 to supply limitations Petitioner cannot find in a single reference. That layered theory is not the type of clear examiner oversight that warrants institution despite discretionary-denial concerns.

The Petition also depends on issues that are not themselves cognizable IPR grounds. Petitioner repeatedly asserts alleged written-description deficiencies to support its priority theory. *See, e.g.*, Pet. at 7–8, 21, 26–27. But IPR is limited to challenges based on prior art patents and printed publications. Petitioner’s reliance on written-description allegations underscores that this proceeding would not be a

self-contained prior-art review. It would require the Board to address priority and written-description disputes that Petitioner has expressly reserved for district court.

Petitioner's limitation-by-limitation showing is likewise not compelling. For limitations 1.i–1.k, Petitioner relies on an unsupported symmetry assumption. It contends that “Moskowitz ’440’s implant is substantially symmetrical,” and from that premise asks the Board to infer a second slot with the claimed configuration. Pet. at 39–41. But Petitioner does not cite any disclosure in Moskowitz ’440 describing the implant as symmetrical or explaining that such symmetry would be required or desirable. Its cited prosecution materials, Ex. 1043 at 231 and 239, do not state that the sidewalls depicted in Figures 2A–2C are identical. Nor does Petitioner separately identify and illustrate the alleged second slot under its symmetry theory. The challenged limitations require specific configurations of both slots. Petitioner's inference does not supply the particularized showing required for institution.

The obviousness combinations add further weaknesses. Petitioner relies on Waugh's faceplate to supply the claimed screw-locking bracket, but its motivation-to-combine analysis does not adequately address the structural differences between Waugh's curved faceplate and Moskowitz ’440's screw box. The curvature of Waugh's faceplate would create a gap when applied to Moskowitz ’440, undermining the very purpose Petitioner identifies for the combination: preventing

screw back-out and loosening over time. Petitioner does not explain how a POSITA would modify the faceplate to avoid that problem while preserving the claimed fit and function.

Petitioner's reliance on Waugh's locking tabs is similarly underdeveloped. The Petition does not address how the tabs would fit the alleged slots in Moskowitz '440, how manufacturing tolerances or variances would affect that fit, or how the proposed structure would avoid pivoting that could expose the screws and increase the risk of back-out. A conclusory assertion that Waugh's tabs could be applied to Moskowitz '440 does not establish a reasoned motivation to combine with a reasonable expectation of success.

The Michelson '019 ground fails no better. Petitioner introduces Michelson '019 to address the "larger than and coaxial with the internal bore" limitation, yet also asserts that Moskowitz '440 already discloses the same feature. Pet. at 86. If the feature is already present in Moskowitz '440, the Petition does not identify a reason a POSITA would have modified Moskowitz '440 in view of Michelson '019. The backup ground therefore does not strengthen the Petition; it highlights the uncertainty in Petitioner's mappings.

The Petition rests on disputed priority and written-description premises, unsupported figure inferences, and underdeveloped obviousness combinations. That is not a clear or compelling merits showing. Factor 6 favors denial.

III. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Director exercise discretion to deny institution.

Date: April 27, 2026

Respectfully submitted,

AVANTECH LAW, LLP
80 S 8th St, Suite 900
Minneapolis, MN 55402
(312) 487-2185

/Eric A. Zelepugas/
Eric A. Zelepugas
Registration No. 73,302
Lead Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** and associated exhibits (Exhibits 2001-2013) were served electronically via e-mail on April 27, 2026, in their entirety on the following counsel of record for Petitioner:

Naveen Modi (Lead Counsel)
Young Park (Back-up Counsel)
Chetan Bansal (Back-up Counsel)
naveenmodi@paulhastings.com,
youngpark@paulhastings.com,
chetanbansal@paulhastings.com,
PH-Medtronic-Moskowitz-IPR@paulhastings.com.

Date: April 27, 2026

Respectfully submitted,
AVANTECH LAW, LLP
80 S 8th St, Suite 900
Minneapolis, MN 55402
(312) 487-2185

/Eric A. Zelepugas/
Eric A. Zelepugas
Registration No. 73,302
Lead Counsel for Patent Owner