

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,
Petitioner

v.

MOSKOWITZ FAMILY LLC,
Patent Owner.

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

PETITIONER'S DISCRETIONARY DENIAL OPPOSITION

Table of Contents

I.	INTRODUCTION	1
II.	MATERIAL ERROR BY THE OFFICE WARRANTS REVIEW	5
III.	THE COMPLEXITY OF THE DISPUTE FAVORS INSTITUTION	10
IV.	THE FINTIV FACTORS STRONGLY FAVOR INSTITUTION	12
A.	Factor 1: Stay.....	13
B.	Factor 2: The Final Decision Will Issue Months Before Trial	13
C.	Factor 3: The Minnesota Action Is in Its Infancy	13
D.	Factor 4: The <i>Sotera</i> Stipulation Supports Institution	15
E.	Factor 5: Early FWD Supports Institution	15
F.	Factor 6: Strong Merits Support Institution	16
V.	SETTLED EXPECTATIONS FAVOR INSTITUTION	17
VI.	MEDTRONIC HAS NOT TAKEN INCONSISTENT POSITIONS	19
VII.	CONCLUSION.....	20

TABLE OF AUTHORITIES

Cases	Page(s)
<i>Allied Erecting & Dismantling Co. v. Genesis Attachments, LLC</i> , 825 F.3d 1373, 1381 (Fed. Cir. 2016)	16
<i>American Airlines, Inc. v. Intellectual Ventures I LLC</i> , IPR2025-00785, Paper 11 (Director Aug. 29, 2025).....	3, 11
<i>Apple Inc. v. Apex Beam Technologies LLC</i> , IPR2025-00896, Paper 10 (Director Sept. 3, 2025)	11
<i>Apple Inc. v. Ferid Allani</i> , IPR2025-00856, Paper 11 (Director Sept. 5, 2025)	18
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020).....	18
<i>Carbyne, Inc. v. Tritech Software Systems</i> , IPR2025-00959, Paper 11 (Director Oct. 3, 2025).....	3, 9
<i>Ecto World LLC v. RAI Strategic Holdings Inc.</i> , IPR2024-01280, Paper 13 (Director May 19, 2025)	2
<i>FreightCar America, Inc. v. National Steel Car Limited</i> , IPR2025-01046, Paper 20 (Director Oct. 10, 2025).....	3, 9
<i>Google LLC v. Cellular South, Inc.</i> , IPR2025-00875, Paper 10 (Director Oct. 17, 2025).....	4
<i>Harbor Freight Tools USA Inc. et al. v. Champion Power Equipment, Inc.</i> , IPR2025-00805, Paper 20 (Director Sept. 19, 2025)	11
<i>NeuMoDx Molecular, Inc. v. HandyLab, Inc.</i> , IPR2020-01133, Paper 23 (P.T.A.B. Aug. 6, 2021).....	16
<i>Samsung Display Co., Ltd. v. Pictiva Displays International Ltd.</i> , IPR2024-01222, Paper 12 (P.T.A.B. Mar. 6, 2025).....	16
<i>Shenzhen Tuozhu Technology Co., Ltd. v. Stratasys, Inc.</i> , IPR2025-00438, Paper 10 (Director July 17, 2025).....	11

<i>Sotera Wireless, Inc. v. Masimo Corp.</i> , IPR2020-01019, Paper 12 (P.T.A.B. Dec. 1, 2020)	15
<i>Tesla, Inc. v. Intellectual Ventures II LLC</i> , IPR2025-00217, Paper 9 (Director June 13, 2025)	3, 10, 11

LIST OF EXHIBITS

Exhibit No.	Document	Previously Submitted
Ex. 1001	U.S. Patent No. 10,064,738 to Moskowitz et al. (“the ’738 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. 10,064,738	X
Ex. 1005	U.S. Patent Application Publication No. 2008/0033440 A1 to Moskowitz et al. (“Moskowitz 440”)	X
Ex. 1006	U.S. Patent Application Publication No. 2008/0249569 A1 to Waugh et al. (“Waugh”)	X
Ex. 1007- 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- Ex. 1029	RESERVED	
Ex. 1030	U.S. Patent No. 6,716,247 to Michelson (“Michelson ’247”)	X

Exhibit No.	Document	Previously Submitted
Ex. 1031- 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 May 1, 2026), Dkt. 74.	
Ex. 1043	File History for U.S. Patent No. 11,903,849	X
Ex. 1044	U.S. Patent No. 9,889,022 to Moskowitz et al. (“the ’022 patent”)	X
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	U.S. Patent No. 11,903,849 to Moskowitz et al. (“the ’849 patent”)	X
Ex. 1049	U.S. Patent No. 6,972,019 to Michelson (“Michelson 019”)	X
Ex. 1050- Ex. 1058	RESERVED	

Exhibit No.	Document	Previously Submitted
Ex. 1059	Patent Owner’s Infringement Claim Charts, Exhibit D1, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Minn.), served October 30, 2025.	X
Ex. 1060	Office Action citing Waugh in related U.S. Patent Application No. 13/418,335 (September 9, 2013)	X
Ex. 1061	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.), served January 5, 2026.	X
Ex. 1062	Patent Owner’s Preliminary Response, <i>Globus Medical, Inc., v. Moskowitz Family LLC</i> , IPR2020-01308 (October 28, 2020)	X
Ex. 1063	U.S. Patent Application Publication No. 2003/0208275 A1 to Michelson (“Michelson ’275”)	X
Ex. 1064- Ex. 1073	RESERVED	
Ex. 1074	U.S. Patent No. 12,011,367 to Moskowitz et al. (“the ’367 patent”)	

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. 10,064,738 ("the '738 patent") is largely premised on the arguments it has previously set forth in *seven* companion IPRs. Moskowitz's arguments have consistently failed.¹ This IPR does not warrant a different outcome. Like in several of those companion IPRs, Office error alone is sufficient to warrant institution here. Complexity of the parties' dispute, judicial efficiency, and settled expectations provide even more reasons to institute review.

Office Error. The Petition demonstrates that the Examiner overlooked Moskowitz's own prior art publication, Moskowitz 440, which discloses the very limitations that formed the basis for allowance. Moskowitz 440 was before the Examiner but was buried in an Information Disclosure Statement ("IDS") containing

¹ Thus far, the Director has considered discretionary denial in seven companion IPRs. The Director has *referred* all seven IPRs. Amongst the seven IPRs, the Director has instituted review in five IPRs. *See* IPR2025-01598, Paper 11 at 2; IPR2026-00121, Paper 11 at 2; IPR2026-00124, Paper 11 at 2; IPR2026-00162, Paper 13 at 2; IPR2026-00163, Paper 11 at 2. The other two IPRs are pending pre-institution merits review. *See* IPR2026-00216 and -00217.

142 references—almost six times the size of a typical IDS. (Ex. 1004, 100-105.)

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 Moskowitz 440 (*see* Ex. 1004, 163-168), the file history of the ’738 patent includes no evidence that the Examiner considered Moskowitz 440. There is no Office Action addressing Moskowitz 440’s teachings, let alone rejecting any then-pending claims over Moskowitz 440.

The Examiner’s failure to consider and apply Moskowitz 440’s teachings against the claims during prosecution demonstrates that the Office erred in performing a complete and thorough review of the prior art. This failure was material because, as explained below in Section II, Moskowitz 440 discloses each of the limitations that the Examiner found missing from the prior art—***a fact Moskowitz does not (and cannot) dispute.***² Office error, like in this case, warrants review and

² The Office’s error in not thoroughly evaluating Moskowitz 440 appears to have been the result of Moskowitz’s deployment of questionable prosecution tactics to hinder effective examination. These tactics include filing multifarious continuations and continuations-in-part applications that obfuscate the effective filing date of the claims making it extremely difficult for the Examiner to determine whether a

underscores that a discretionary denial is inappropriate. *Carbyne, Inc. v. Tritech Software Systems*, IPR2025-00959, Paper 11 at 2 (Director Oct. 3, 2025) (finding material error by the Office 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”).

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. 1061, 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))

reference is even prior art. See *infra* Section II. Here, it is unclear whether the Examiner even considered Moskowitz 440 as prior art because it is listed in the priority chain of the ’738 patent.

(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 six 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”). Moskowitz’s assertion that the “Minnesota litigation is active and will remain active regardless of the litigation,” (DD Req., 2), ignores the distinct likelihood of a stay given the institution of five IPRs. *See infra* Section IV.A. Moreover, the district court case is in early fact discovery, and the district court has issued no substantive orders with respect to any of the patents. The district court case thus remains in its infancy.

Settled Expectations. The ’738 patent’s 2018 issue date cannot overcome the clear Office error in allowing the ’738 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

Moskowitz 440 is a publication of U.S. Application No. 11/842,855 (“the ’855 application”), which is listed as a parent of the ’738 patent. (Ex. 1001, cover.³) Moskowitz 440 was cited in an IDS containing 142 references—almost six times the size of a typical IDS. (Ex. 1004, 100-105.) The Examiner, however, overlooked that Moskowitz 440 discloses each claim limitation that formed the basis for

³ The ’738 patent claims priority to the ’855 application through a chain of continuations and continuations-in-part. As explained in the Petition, Moskowitz 440 is prior art to the challenged claims of ’738 patent under at least 35 U.S.C. § 102(b) because it published more than one year before the earliest priority date (May 22, 2009) alleged by Moskowitz. (*See* Petition, 4 (citing Ex. 1061, 9).) While Moskowitz alludes vaguely to a priority challenge (DD Req., 17), that argument is a non-starter because Moskowitz 440 is prior art under pre-AIA § 102(b) and therefore, not subject to an antedating defense. Moreover, Moskowitz has presented no evidence supporting a filing date earlier than May 22, 2009.

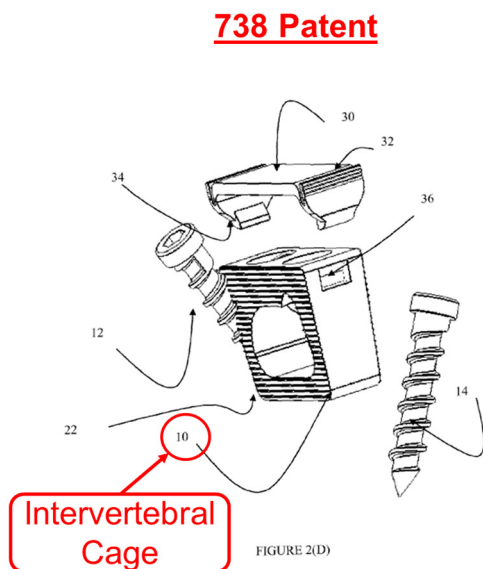
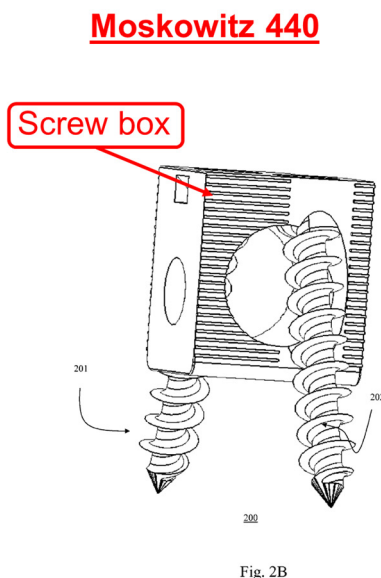
allowance—a fact Moskowitz does not dispute.

The Examiner stated the following as the reasons for allowance:

The following is an examiner's statement of reasons for allowance: the prior art fails to disclose or reasonably teach an intervertebral cage including an internal screw guide, wherein the internal bore portion has a an entry opening formed only in a top surface of the top wall as viewed from the top and has an exit opening formed at least partially in a bottom surface of the top wall and at least partially in a side surface of the top wall. Thus the examiner has allowed claims 32-64.

(*Id.*, 208.)

As explained in the Petition, Moskowitz 440 discloses a screw box (which is an “intervertebral cage”) just like the '738 patent. (Petition, 17-20.)



(Ex. 1001, Fig. 2D; Ex. 1005, Fig. 2B (both annotated).) The screw box has the claimed walls.

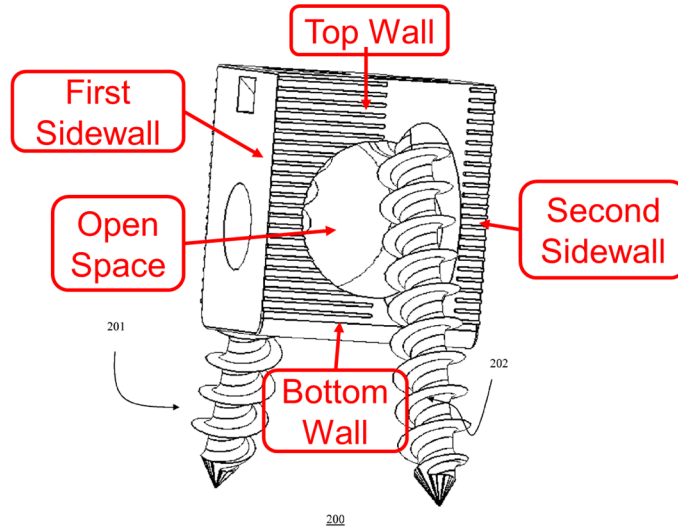


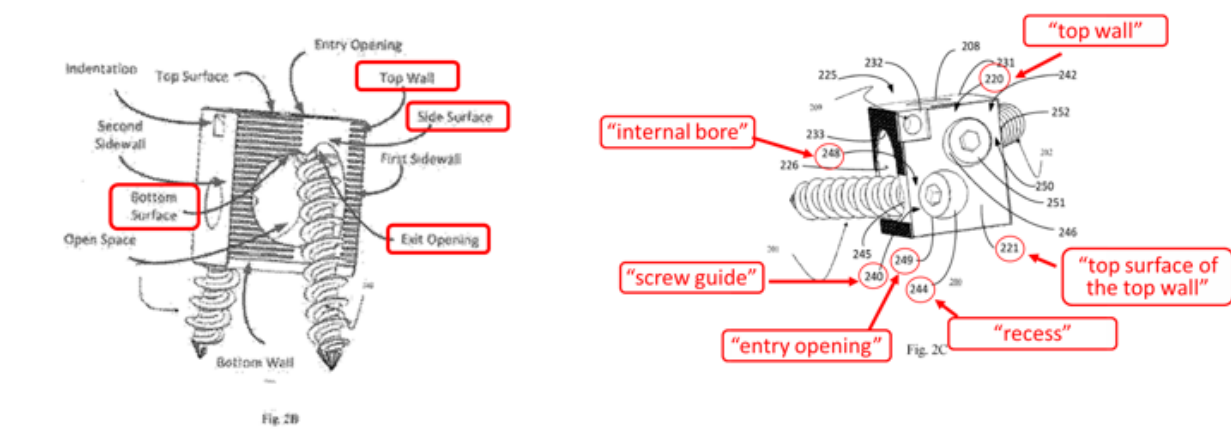
Fig. 2B

(Ex. 1005, Fig. 2B (annotated).) These facts are not disputed by Moskowitz; nor can Moskowitz do so given his representations to the Patent Office in a related application, which is a continuation of Moskowitz 440 and has the same specification. (See Petition, 8-9, 19-20.⁴)

Moskowitz 440 also discloses the claimed “internal screw guide” and “internal bore,” as confirmed, yet again, by Moskowitz’s own statements during prosecution of the ’849 patent. (Petition, 20-24.) The Examiner of the ’849 patent required Moskowitz to show support for these structures in the specification because, like the ’738 patent, the related application also lacked textual support for these features. (Ex. 1043, 172, 176-77 (noting that the claim limitations “are not supported or

⁴ The related application issued as the ’849 patent (Ex. 1048).

identified in the Specification”).) Moskowitz then attempted to amend the specification and provided annotated figures 2A-2C (reproduced in relevant part below) to show purported disclosure of these claimed structures in the as-filed application (which issued as the ’849 patent). (*See id.*, 180-82 (providing annotated figures during a telephonic interview), 231 (amending the specification), 245 (representing that “[n]o new matter is added” by the amendments).)



(*Id.*, 182 (excerpted and annotated), 240 (annotated).)

The annotated figures signified Moskowitz’s understanding of how the figures of the ’849 patent (and by extension, Moskowitz 440) disclose the claimed “internal bore,” “internal screw guide,” “entry opening,” and “exit opening.” (*Id.*, 180, 182.) Critically, Moskowitz represented to the Patent Office that the embodiment of figures 2A-2C in the ’849 patent shows that the “*the entry opening of the internal bore [is] formed only in the top surface of the top wall,*” and “*the exit opening [is] formed at least partially in the bottom surface of the top wall and at least partially*

in a side surface of the top wall,” as recited in then-pending claim 21. (*Id.*, 232 (claim 21) (emphases added), 244-245 (“the structures recited in the claims . . . appear in Figs. 2A-2C”); Petition, 29-34.) Those representations apply equally to Moskowitz 440, which has the same specification and figures as the ’849 patent.

Moskowitz’s representations during prosecution of the ’849 patent thus confirm that Moskowitz 440 discloses the limitations that the Examiner found missing from the prior art during prosecution of the ’738 patent. The Examiner, therefore, committed material error in allowing the ’738 patent claims. Instituting review is thus warranted for the Office to consider and correct its error in issuing the ’738 patent. *Carbyne*, Paper 11 at 2 (finding material error by the Office because Petitioner’s prior art was “cited on an IDS during prosecution” and “appears to disclose the purportedly missing claim limitations”); *FreightCar America*, Paper 20 at 3-4 (finding “material error by the Office” because the prior art “appear[s] to disclose the allowable features of the claims”).

Review is particularly warranted here because the Office error appears to have been perpetuated by Moskowitz’s questionable prosecution tactics, including filing multifarious continuations and continuations-in-part applications. Here, Moskowitz acknowledges that the ’738 patent is not entitled to the filing date of the ’855

application (which published as Moskowitz 440).⁵ Yet, Moskowitz included the '855 application in the direct priority chain of the '738 patent. Given the presence of the '855 application in the priority chain, it is unclear if the Examiner even considered Moskowitz 440 prior art. Moskowitz should not be allowed to avoid review when its prosecution practices may have played a significant role in the Examiner's error in allowing the '738 patent to issue.

III. 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

⁵ In the Pending Litigation, in response to an interrogatory seeking Moskowitz's contention regarding, *inter alia*, the earliest priority date for each asserted claim of the patents-in-suit, Moskowitz admitted that the challenged claims of the '738 Patent have a priority date of May 22, 2009. (Ex. 1061, 9.) The '855 application was filed on August 21, 2007. (Ex. 1001, cover.)

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. 1061, 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 suggests that the district court, not the Board, “is better positioned to manage” the parties’ dispute because the district court will address overlapping issues, which per Moskowitz, are “fragment[ed]” across “multiple IPRs.” (DD Req., 10.) Moskowitz’s argument ignores the unique “technical” expertise that the Board will bring to bear on the parties’ dispute. It also incorrectly assumes that multiple IPRs would lead to inconsistent outcomes and overlooks the Board’s management of related IPRs, which includes assigning related patents to the same panel.

IV. 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. 2013, 42:17-43:10.) Since then, the Director has instituted review in five IPRs and two IPRs remain pending pre-institution merits review. *See* IPR2025-01598, Paper 10 at 2; IPR2026-00121, Paper 11 at 2; IPR2026-00124, Paper 11 at 2; IPR2026-00162, Paper 13 at 2; IPR2026-00163, Paper 11 at 2; IPR2026-00216, Paper 12 at 1; IPR2026-00217, Paper 12 at 1. 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 February 2026 (*see* Paper 3), meaning that the Board's final decision is due in August 2027. Meanwhile, the Minnesota Action is scheduled to be ready for trial six 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 six 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 and remains in its infancy. The case is in early fact

discovery. That the parties have exchanged written discovery and initial contentions (see DD Req., 12-13) does not suggest that the litigation has progressed to an advanced stage for purposes of the *Fintiv* analysis. In fact, there has been no ruling on claim construction, nor has the district court issued any “**substantive** orders related to the [patents at issue].” See *Apple Inc., v. Fintiv, Inc.*, IPR2020-00019, Paper No. 11 at 10 (March 20, 2020) (“If, at the time of the institution decision, the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution”); *id.* (“district court claim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.”) (emphasis added). “[M]uch remains to be done, including expert discovery,” which means factor three weighs against denial. *Samsung Display Co., Ltd. v. Pictiva Displays International Ltd.*, IPR2024-01222, Paper No. 12 at 7 (March 6, 2025).

Moskowitz, not Medtronic, is responsible for the current state of the litigation. 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., 13), those extensions were necessitated by Moskowitz’s eleventh-hour addition of a new patent to the complaint and were jointly agreed to by the parties. (Ex. 2005; Ex. 2016.)

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

Medtronic has filed a *Sotera* stipulation (Ex. 1042) which “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 1-7, 9, 11-12, 22, 24-25, 28, and 32-33. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (P.T.A.B. Dec. 1, 2020) (precedential).⁶

Moskowitz is incorrect that “institution would not materially narrow the district court case” because “Petitioner has not challenged all asserted claims across the asserted portfolio.” (DD Req., 14.) 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. 2013, 24:8-21 (noting that resolving 60 claims not challenged by the IPRs “seems like an awful lot less than 150 to me”).)

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

⁶ Medtronic’s omission of a *Sotera* stipulation before Moskowitz filed its discretionary denial brief was inadvertent. As Moskowitz acknowledges, “Petitioner has filed *Sotera* stipulations for other patents.” (DD Req., 15).

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 unsubstantiated attorney arguments do not undercut the Petition’s compelling merits. In fact, those arguments are surprising given Moskowitz’s own statements regarding the ’849 patent, which as discussed above in Section II, apply to Moskowitz 440.

First, Moskowitz questions whether the Moskowitz 440 implant is symmetrical and discloses a “second slot” opposite to the “first slot.” (DD Req., 18.) But Moskowitz ignores that utilizing this very symmetry, Moskowitz tried to claim a “second slot” during prosecution in the ’849 patent. (*See* Petition, 39-40 (citing Ex. 1043 at 231).) There, Moskowitz asserted that figures 2A-2C include a “first indentation 228 in a first outer side surface 230” and a “second indentation 229 in a second outer surface 231” when only one indentation (*i.e.*, “slot”) is visible in the figures. (Ex. 1043, 231, 238-240.)

Second, Moskowitz contends that “the curvature of Waugh’s faceplate would create a gap when applied to Moskowitz ’440” and that Waugh’s locking tabs may not fit the alleged slots in Moskowitz 400. (DD Req., 18-19.) Moskowitz incorrectly assumes that obviousness requires bodily incorporation of Waugh’s faceplate (including tabs) in Moskowitz 440’s implant. *Allied Erecting & Dismantling Co. v.*

Genesis Attachments, LLC, 825 F.3d 1373, 1381 (Fed. Cir. 2016) (“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference”) (internal citation omitted). Here, a POSA would have understood how to adjust the mechanical shape of Waugh’s faceplate and tabs to fit Moskowitz 440’s implant, and would have been able to do so with a reasonable expectation of success. (*See* Ex. 1002, ¶62.)

Third, Moskowitz contends that the Petition should be penalized for including a backup ground and that such a ground “highlights the uncertainty in Petitioner’s mappings.” (DD Req., 19.) Moskowitz ignores that the additional Michelson ’019 ground only underscores the obviousness of Moskowitz’s claims; *i.e.*, not one but two prior art references disclose the relevant limitations.

V. SETTLED EXPECTATIONS FAVOR INSTITUTION

Moskowitz’s settled expectations based on the 2018 issue date of the ’738 patent (*see* DD Req., 4-6) 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 ’738 patent, which shares a common ancestor, Application No. 11/842,855, as the ’367 patent. (Ex. 1074, cover.) Moskowitz himself ties the ’738 patent to the 2015 notice. (Ex. 1040, ¶137 (“[t]he ’738 patent is a continuation of patents and applications disclosed in Dr. Moskowitz’s 2015 notice letters.”).) 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 ’738 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 for the ’738 patent.

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 '738 patent. Moskowitz's failure to sue in a timely manner negates any claim that it has settled expectations of patent validity.⁷

VI. MEDTRONIC HAS NOT TAKEN INCONSISTENT POSITIONS

Moskowitz contends that boiler-plate preservation of rights language in the Petition warrants denial of the Petition. (DD Req., 6-9.) That language merely reserves rights to raise claim construction and other arguments in other venues where such arguments can be raised and/or are necessary to resolve a dispute between the parties. Moskowitz identifies no case in which such preservation language by itself has warranted denial. Under the Director's jurisprudence, what matters is whether Medtronic has taken an inconsistent position. But Medtronic has taken no

⁷ Moskowitz's attempt at distancing itself from the 2015 notice letter (*see* DD Req., 5) for purposes of settled expectations fails. As noted above, Moskowitz expressly tied the '738 patent to the 2015 notice letters for litigation purposes. (Ex. 1040, ¶137.)

inconsistent position, nor does it intend to do so. (Ex. 2013 at 20:6-8 (“Of course, we are not planning to present anything inconsistent. We don’t have inconsistent positions.”).) Indeed, Moskowitz has not identified a single inconsistent position, nor can it. Moskowitz’s argument is thus a non-starter.

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 1-7, 9, 11-12, 22, 24-25, 28, and 32-33.

Respectfully submitted,

Dated: May 26, 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 May 26, 2026:

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