

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,
Petitioner

v.

MOSKOWITZ FAMILY LLC,
Patent Owner

Case No. IPR2026-00285
Patent No. 10,603,183

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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Patent Trial and Appeal Board
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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>Reserved.</i>
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)
2014	Cover Pleading of Medtronic’s Invalidity Contentions, <i>Moskowitz Family LLC v. Medtronic, Inc. et al.</i> , No.0:25-cv-00769 (Dist. Of Minn April 26, 2026)
2015	Exhibit G1 to Medtronic’s Invalidity Contentions, <i>Moskowitz Family LLC v. Medtronic, Inc. et al.</i> , No.0:25-cv-00769 (Dist. Of Minn April 26, 2026)
2016	Cover Pleading of Medtronic’s Non-infringement Contentions, <i>Moskowitz Family LLC v. Medtronic, Inc. et al.</i> , No.0:25-cv-00769 (Dist. Of Minn April 26, 2026)
2017	Exhibit G1 to Moskowitz’s Infringement Contentions, <i>Moskowitz Family LLC v. Medtronic, Inc. et al.</i> , No.0:25-cv-00769 (Dist. Of Minn, January 30, 2026)

2018	Exhibit D1 to Medtronic’s Invalidity Contentions, <i>Moskowitz Family LLC v. Medtronic, Inc. et al.</i> , No.0:25-cv-00769 (Dist. Of Minn April 26, 2026)
2019	Exhibit E2 to Medtronic’s Invalidity Contentions, <i>Moskowitz Family LLC v. Medtronic, Inc. et al.</i> , No.0:25-cv-00769 (Dist. Of Minn April 26, 2026)
2020	Exhibit B1 to Medtronic’s Invalidity Contentions, <i>Moskowitz Family LLC v. Medtronic, Inc. et al.</i> , No.0:25-cv-00769 (Dist. Of Minn April 26, 2026)
2021	Exhibit I1 to Medtronic’s Invalidity Contentions, <i>Moskowitz Family LLC v. Medtronic, Inc. et al.</i> , No.0:25-cv-00769 (Dist. Of Minn April 26, 2026)
2022	Exhibit L3 to Medtronic’s Invalidity Contentions, <i>Moskowitz Family LLC v. Medtronic, Inc. et al.</i> , No.0:25-cv-00769 (Dist. Of Minn April 26, 2026)
2023	Exhibit C3 to Medtronic’s Invalidity Contentions, <i>Moskowitz Family LLC v. Medtronic, Inc. et al.</i> , No.0:25-cv-00769 (Dist. Of Minn April 26, 2026)
2024	Exhibit F3 to Medtronic’s Invalidity Contentions, <i>Moskowitz Family LLC v. Medtronic, Inc. et al.</i> , No.0:25-cv-00769 (Dist. Of Minn April 26, 2026)
2025	Exhibit E1 to Medtronic’s Invalidity Contentions, <i>Moskowitz Family LLC v. Medtronic, Inc. et al.</i> , No.0:25-cv-00769 (Dist. Of Minn April 26, 2026)

I. INTRODUCTION

The Director should deny institution because this Petition would not provide an efficient alternative to the Minnesota litigation. The '183 patent has been in force for over six years. The same parties are already litigating it in Minnesota. And the Petition depends on a multi-step theory involving disputed priority, 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 '183 patent carries strong settled expectations. It issued in 2020 and has been in force for more than 6 years—a 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 at 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 '183 claims. Those claims are assessed based on their own issue date.

Second, Petitioner's district-court contentions confirm that institution would not promote efficiency. Petitioner reads the claims broadly for invalidity, but narrowly for non-infringement. It asks the Board to accept structural inferences from prior-art figures while telling the district court that Patent Owner has not shown comparable structures in the accused product. The Petition never explains why the

same claim language should be applied differently across forums. Those unresolved claim-scope disputes belong in one case, not two.

Third, the Minnesota litigation will remain active regardless of institution. The case has been pending for over a year. Petitioner sought a stay that was denied. 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 will not simplify the case.

Finally, the Petition does not present compelling merits. 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 a clean compelling case. It is a layered challenge in a duplicative forum.

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 '183 patent issued over 6 years ago, yet Petitioner waited to seek review until after Patent Owner filed suit, only filing this Petition on the very last day it could. The Minnesota litigation has heavy investments, involves the same parties and asserted references, and will continue regardless of institution. And the Petition does not present a clear challenge that compels reopening settled patent rights in a duplicative forum. Discretionary denial is warranted.

A. The '183 Patent's Settled Expectations Strongly Favor Discretionary Denial.

The '183 patent has been in force for more than six years. 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.”); *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 '183 patent was filed in 2018, and the patent issued in 2020. Whatever the parties discussed in 2015, those discussions do not eliminate the settled expectations developed thereafter by the later-issued '183 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 '183 patent early in its life. It waited over six years and until the statutory deadline to challenge the '183 patent. 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 ’183 patent is a mature patent, long in force, that Petitioner chose not to challenge until the last possible day. The settled expectations are substantial. They favor discretionary denial.

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

Petitioner asks the Board to institute under one view of the claims while preserving a different view for district court. That is exactly what the rules and recent Director decisions prohibit. An IPR petition must identify “[h]ow the challenged claim is to be construed.” 37 C.F.R. § 42.104(b)(3). That requirement is not optional, and it is not satisfied by saying no construction is needed while reserving inconsistent claim-scope positions for later.

The Petition does just that. Petitioner tells the Board that, except for certain alleged means-plus-function terms, “the Board need not construe any claim terms.” Pet. 10–11. It then says the challenged 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 11 n.3. Petitioner thus asks the Board to institute without disclosing the claim scope it intends to press in Minnesota.

That is not a harmless reservation. The Board and district court apply the same *Phillips* standard. The Office adopted that standard to reduce forum-dependent claim scope—not to let petitioners use broad claim scope for invalidity at the Board while preserving narrower or different positions for district court. Recent Director decisions enforce that rule. In *Revvo*, the Director held that when a petitioner advances different claim-construction positions across forums, the petition must 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 the petitioner treated a limitation as definite enough for IPR while arguing indefiniteness in district court 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 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 knew this mattered. At the stay hearing, Petitioner acknowledged that claim construction would affect its district-court 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 cause the Director

to view Petitioner's PTAB and district-court positions as inconsistent and deny institution. *Id.* at 20. In other words, Petitioner understood the Director's rule. It tried to avoid triggering it.

The contentions Petitioner later served confirm the problem. In its invalidity cover pleading, Petitioner stated that claim construction had not occurred, that its invalidity contentions "may depend on the Court's claim construction," and that it "reserve[d] the right to present alternative constructions." Ex. 2014 at 3. Its non-infringement cover pleading likewise states that the responsive charts "are not intended to include or otherwise reflect Defendants' claim construction contentions," and that nothing in those charts should be construed as accepting Patent Owner's apparent claim constructions. Ex. 2016 at 3. Those are not commitments to consistent claim scope. They preserve different positions for later.

The inconsistency is not hypothetical. In district-court invalidity contentions asserting the same references Petitioner relies on here, Petitioner states that limitations [1F], [11F], and [19F] are "awkwardly worded" and that it is "logically impossible" for surface features to be positioned "on the side surface between the top wall and the exit opening" if the exit opening is formed where the claims say it is formed. Ex. 2015 at 32 n.5. That is, at minimum, an indefiniteness-style claim-scope position: Petitioner tells the district court the limitation cannot be coherently applied as written. But the Petition does not disclose or explain that position.

Instead, it supplies an interpretation “solely for the purpose of this IPR” so the Board can apply the limitation and institute review. Pet. 38–39 n.9. Petitioner cannot treat the same limitation as impossible in district court and workable before the Board without explaining the difference.

That is exactly the kind of forum-dependent claim practice *Revvo*, *Tesla*, and *Generac* reject. If Petitioner believed the limitation was impossible to apply as written, the Petition had to say so. If Petitioner wanted the Board to adopt an IPR-only saving construction, the Petition had to explain why that construction should govern here. It did not.

The Director should not reward that approach. Institution would allow Petitioner to obtain Board review while keeping its district-court claim-scope positions in reserve. That would undermine the petition-disclosure rule, invite inconsistent treatment of the same claim language, and make this IPR less—not more—efficient. This favors discretionary denial.

C. Petitioner Applies Broad Claim Scope for Invalidity and Narrow Claim Scope for Non-Infringement.

Petitioner’s district court contentions confirm that the claim-scope problem is real. This is not a case where Petitioner has committed to one construction and applied it consistently across forums. Petitioner instead asks the Board to institute on flexible claim scope while preserving a more demanding application of the same limitations in Minnesota.

That is what *Revvo* forbids. The Director explained that a petitioner may not rely on a broad interpretation to support invalidity in an IPR while invoking a narrower interpretation in district court to avoid infringement, unless the petition gives a meaningful explanation for the difference. *Revvo* at 4 (citing 83 Fed. Reg. 51,340, 51,350) (Oct. 11, 2018). Petitioner gives no explanation here.

The internal-structure limitations show the problem. The Petition treats “internal screw guide,” “internal bore portion,” and “entry opening” as path-based structural concepts. Under Petitioner’s IPR theory, a prior-art implant need not disclose a separately identified screw guide, bore, or entry opening. It is enough that a screw travels through the implant along a path from which those structures can be reconstructed. Pet. 17–18, 25–29.

Petitioner applies a different understanding in Minnesota. For Sovereign, Petitioner does not accept that the screw path through the implant establishes the claimed internal screw guide, internal bore, or entry opening. It denies they are met. *Compare* Ex. 2017 at 3-5, 27-29, 51-53; *with* Ex. 2016 at 2 (“Defendants do not concede that Moskowitz’s Infringement Contentions are adequate or sufficient under the Court’s Pretrial Scheduling Order), 3 (“Defendants deny all allegations in Moskowitz’s Infringement Contentions unless expressly admitted in the accompanying Responsive Claim Charts.”). That is a claim-scope difference.

Petitioner must explain why the same words cannot mean “the screw path is enough” for invalidity and “the screw path is not enough” for non-infringement.

The Petition gives no explanation. It never tells the Board whether the claimed “internal screw guide” and “internal bore” require identifiable structures, or whether they can be supplied by the path a screw takes through the implant. Petitioner uses the broader, path-based reading to attack validity, while preserving a narrower, structure-based reading to avoid infringement. That is the forum-dependent claim scope *Revvo* forbids.

The same problem appears in Petitioner’s treatment of the “formed only in a top surface” limitation. In the Petition, Petitioner asks the Board to locate that opening through later prosecution statements and figure-based inference. Pet. 25–29. In Minnesota, Petitioner refuses to apply the same inference-based approach to Sovereign. *Compare* Ex. 2017 at 3-4, 27-28, 51; *with* Ex. 2016 at 2-3. The Petition presents different meanings for the same claim language across the two proceedings.

Institution is supposed to promote efficiency, not create a second forum for unresolved claim-scope disputes. If the Board institutes under Petitioner’s flexible invalidity mapping while the district court proceeds under Petitioner’s more demanding non-infringement position, the proceedings will not simplify each other. They will diverge.

The Director should not institute on that record. Petitioner had to disclose and explain any materially different claim-scope positions in the Petition. It did not. This favors discretionary denial.

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

Petitioner argues in related proceedings that the Minnesota litigation is too complex for district-court resolution and therefore favors institution. That argument gets *Tesla* backward. *Tesla* does not hold that more patents automatically means more reason for Board review. The question is whether institution would make the parallel litigation more efficient. It would not. *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 (June 13, 2025).

This case involves a related patent family, not 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 disputes—priority, written description, claim scope, and invalidity—are cross-cutting.

That is the wrong kind of complexity for multiple parallel PTAB proceedings. Institution would fragment overlapping issues across multiple IPRs, potentially before different panels, while the district court continues to address the same patent family, products, claim-construction disputes, and non-IPR invalidity theories. The

district court can manage those issues together. Multiple IPRs cannot. They would add proceedings, not simplify the case.

E. *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.

Thus, 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 remain. A stay would delay resolution without eliminating the work the district court must do.

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.

F. *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 Petitioner has served invalidity and noninfringement contentions. By the expected September 5, 2026 institution decision, the parties also will have

exchanged claim-construction terms and requested a claim construction hearing. Ex. 2009 at 2. 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 delayed 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 be allowed to create delay and then use that delay to argue the district case is not far enough along. Factors 2 and 3 favor denial.

G. *Fintiv* Factor 4 Favors Denial Because Institution Would Not Eliminate Overlap or Meaningfully Simplify the Minnesota Case.

Factor 4 favors denial because institution would not materially narrow the Minnesota case. This IPR would address only one piece of a broader dispute

involving the same parties, the same patent family, the same accused products, the same claim-scope disputes, and overlapping invalidity theories. Institution would not replace the district court's work. It would add to it.

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.

Petitioner's *Sotera* stipulation does not fix that problem. Although Petitioner filed a *Sotera* stipulation in district court, it has not filed one in this proceeding. And the district court stipulation is conditional: it applies only if an IPR is instituted and not later dismissed or terminated. The Office's Interim Director Discretionary Process instructs petitioners to file such stipulations "as soon as practicable." Ex. 2006 at 3. Petitioner did not do so here.

In any event, even a full *Sotera* stipulation would not eliminate the duplication. 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 from Board review is necessarily limited. Ex. 2008 at 3.

Petitioner’s own invalidity contentions confirm that overlap will remain. Petitioner expressly “reserve[d] the right to rely on any prior art or other invalidity defenses identified in any *Inter Partes* Review, Post-Grant review, or other proceedings before the United States Patent and Trademark Office involving the Asserted Patents or related patents.” Ex. 2014 at 4. It preserves PTO-related prior art and invalidity theories for use in Minnesota, including against related patents that this IPR will not resolve.

Petitioner’s claim charts show the same thing in practice. Petitioner has asserted references raised in the ’293 IPR—which was instituted on March 3—against other asserted patents, including Waugh and Messerli against the ’674 patent, and Waugh against the ’738 and ’505 patents. Exs. 2018-2020. Petitioner likewise asserted references raised in the ’797 IPR—which was instituted on April 22—against other asserted patents, including McLuen against the ’088 and ’136 patents, and Michelson against the ’284, ’633, ’136, ’674, and ’505 patents. Exs. 2020-2025. Thus, even where IPRs proceed, the same art and related invalidity disputes continue in Minnesota through other patents and claims.

The overlap is not limited to prior art references. The same structural limitations, claim-scope disputes, and priority issues recur across the asserted patent family. Because related patents and claims will remain in district court regardless of institution, Petitioner can continue litigating overlapping art, overlapping claim-scope positions, and overlapping priority theories there even if estoppel later applies.

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). Factor 4 favors denial.

H. *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. *Fintiv*, at 13–14; *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020). Factor 5 favors denial.

I. *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 needed to overcome settled expectations and parallel-litigation concerns. The question is not whether the Petition is facially plausible. It

is whether the merits justify institution despite duplication, inefficiency, and the maturity of the challenged patent. *Fintiv*, Paper 15 at 15. Even plausible petitions 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 lack 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 read; and that Waugh and Michelson ’019 should be combined with Moskowitz ’440 to supply limitations Petitioner cannot find in one reference. That is not a clean theory. It is a layered challenge built on disputed priority, written-description premises, later prosecution characterizations, and obviousness combinations.

The Petition also depends on issues that are not themselves IPR grounds. Petitioner’s priority theory rests on alleged written-description deficiencies in the ’183 patent and other family disclosures. Pet. at 7-8, 17, 21, 23-24. But IPR is limited to challenges based on patents and printed publications. Petitioner’s reliance on written-description allegations confirms 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 overlap with issues Petitioner has preserved for district court.

The Petition's merits theory also depends on the same unstable claim scope discussed above. Petitioner asks the Board to read internal structures, openings, and spatial relationships into prior-art figures through inference and later prosecution characterizations, while preserving different applications of the same limitations in Minnesota. That is another reason institution would not simplify the district court case: the Board would be asked to decide validity under claim-scope positions Petitioner has not committed to adopting in the infringement litigation.

These problems matter at the discretionary-denial stage. Petitioner is not asking the Board to correct a simple oversight based on a single overlooked reference. It is asking the Board to take up contested priority and claim-scope issues that overlap with Minnesota and then resolve combinations Petitioner will continue to litigate in district court. That showing is not strong enough to overcome the settled expectations, district-court investment, unresolved claim-scope disputes, and limited simplification present here. Factor 6 favors denial.

III. CONCLUSION

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

Date: May 5, 2026

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** and associated exhibits (Exhibits 2001-2011, 2013-2025) were served electronically via e-mail on May 5, 2026, in their entireties on the following counsel of record for Petitioner:

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