

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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MEDTRONIC, INC.,  
Petitioner

v.

MOSKOWITZ FAMILY LLC,  
Patent Owner.

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Case IPR2026-00121  
Patent No. 11,864,755

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**PETITIONER'S DISCRETIONARY DENIAL OPPOSITION**

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**LIST OF EXHIBITS**

<b>Exhibit No.</b>	<b>Document</b>	<b>Previously Submitted</b>
Ex. 1001	U.S. Patent No. 11,864,755 to Moskowitz et al. (“the ’755 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. 11,864,755	X
Ex. 1005	RESERVED	
Ex. 1006	U.S. Patent Application Publication No. 2008/0249569 A1 to Waugh et al. (“Waugh”)	X
Ex. 1007	U.S. Patent No. 7,077,864 to Byrd et al. (“Byrd”)	X
Ex. 1008	U.S. Patent Application Publication No. 2003/0045877 A1 to Yeh (“Yeh”)	X
Ex. 1009	U.S. Patent Application Publication No. 2004/0059271 A1 to Berry (“Berry”)	X
Ex. 1010	U.S. Patent No. 7,056,343 to Schäfer et al. (“Schäfer”)	X
Ex. 1011	U.S. Patent No. 6,395,034 to Suddaby (“Suddaby”)	X
Ex. 1012- Ex. 1019	RESERVED	

Exhibit No.	Document	Previously Submitted
Ex. 1020	Phulchand Prithvi Raj, <i>Intervertebral Disc: Anatomy-Physiology-Pathophysiology-Treatment</i> , 8(1) PAIN PRACT. 18 (2008)	X
Ex. 1021- Ex. 1030	RESERVED	
Ex. 1031	Daniela Alexandru and William So, <i>Evaluation and Management of Vertebral Compression Fractures</i> , 16(4) PERM J. 46 (2012)	X
Ex. 1032	Michael Shulte et al., <i>Vertebral body replacement with a bioglass-polyurethane composite in spine metastases – clinical, radiological and biomechanical results</i> , 9(5) EUR. SPINE J. 437 (2000)	X
Ex. 1033	Issada Thongtrangan et al., <i>Vertebral body replacement with an expandable cage for reconstruction after spinal tumor resection</i> , 15(5) NEUROSURG FOCUS. 1 (2003)	X
Ex. 1034	Christian Knop et al., <i>Biomechanical compression tests with a new implant for thoracolumbar vertebral body replacement</i> , 10(1) EUR. SPINE J. 30 (2001)	X
Ex. 1035	U.S. Patent No. 4,657,550 to Daher (“Daher”)	X
Ex. 1036	U.S. Patent No. 6,752,832 to Neumann (“Neumann”)	X
Ex. 1037- Ex. 1039	RESERVED	
Ex. 1040	Amended Complaint, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Minn. filed May 23, 2025), Dkt. 27.	

Exhibit No.	Document	Previously Submitted
Ex. 1041	Answer to Amended Complaint, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Minn. filed June 27, 2025), Dkt. 29.	
Ex. 1042	Sotera Stipulation, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Minn. filed Jan. 6, 2026), Dkt. 41	
Ex. 1043	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. 1044	Plaintiff’s Responses to Defendants’ First Set of Interrogatories (Nos. 1-12), <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Minn. Jan. 5, 2026).	
Ex. 1045	Administrative Office of the United States Courts, U.S. District Court – Judicial Caseload Profile (June 30, 2025), <a href="https://www.uscourts.gov/sites/default/files/document/fcms_na_distprofile0630.2025.pdf">https://www.uscourts.gov/sites/default/files/document/fcms_na_distprofile0630.2025.pdf</a>	
Ex. 1046	Patent Owner’s Request for Discretionary Denial, Paper 6 (December 8, 2025), <i>Medtronic, Inc. v. Moskowitz Family LLC</i> , IPR2025-01598	
Ex. 1047	Defendants’ Motion to Stay, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Minn. filed Feb. 20, 2026), Dkt. 59	
Ex. 1048- Ex. 1049	RESERVED	
Ex. 1050	Ortrun Pohler, <i>Unalloyed titanium for implants in bone surgery</i> , 31 INJURY 7 (2000)	X

<b>Exhibit No.</b>	<b>Document</b>	<b>Previously Submitted</b>
Ex. 1051	Patent Owner's Infringement Claim Charts, Exhibit J1, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Mass.), served October 30, 2025.	X
Ex. 1052	Memorandum Opinion, <i>Moskowitz Family LLC v. Globus Medical, Inc.</i> , No. 2:20-cv-03271 (E.D.Pa.), Dkt. 143.	X
Ex. 1053	Anne Polikeit et al., <i>The importance of the endplate for interbody cages in the lumbar spine</i> , 12(6) EUR. SPINE J. 556 (2003)	X

## 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. 11,864,755 ("755 patent") is largely premised on the same arguments it made in support of its discretionary denial request in a companion IPR2025-01598 involving related U.S. Patent No. 9,005,293 ("293 patent"). The Director considered those arguments and referred the IPR for an adjudication on the merits. *See* IPR2025-01598, Paper 9 at 2. The reasons for instituting this IPR are even stronger.

**No Settled Expectations.** The '755 patent lacks settled expectations because it issued just over two years ago on January 9, 2024, and therefore, has "not been in force for a significant period of time . . . ." *Orca Security Ltd. v. Wiz, Inc.*, IPR2025-01083, Paper 10 at 2 (Director Oct. 17, 2025) (no settled expectations for 2024 patent). It also expired on August 23, 2025, prior to the filing of this IPR petition. The settled-expectations inquiry is fundamentally about long-term reliance, and there can be no credible claim of such reliance where the patent was in force for less than two years.

Given the recent issuance of the '755 patent, Moskowitz pivots to arguing settled expectations based on Medtronic's knowledge of older patents (*e.g.*, the '293 patent) and Moskowitz's "portfolio" since 2015. (DD Req., 4–9.) In so doing, Moskowitz ignores that Medtronic expressly rejected Moskowitz's demand to

license that portfolio in January 2016. (Ex. 1040, ¶48; Ex. 1041, ¶48). That rejection is dispositive because Moskowitz did not take any action against Medtronic until 2025, while suing Medtronic’s competitors (*e.g.*, Globus in 2019, ZimVie in 2022). (DD Req., 5–6.) Moskowitz remained silent for a decade while Medtronic “continued to develop and commercialize” the allegedly infringing technology in that intervening time period. (Ex. 1046, 9-10.) This *decade*-long silence following Medtronic’s express rejection negates Moskowitz’s claim of settled expectations because a patent owner cannot use its own delay to shield a patent from institution. *Apple Inc. v. Ferid Allani*, IPR2025-00856, Paper 11 (Director Sept. 5, 2025) (informative). Moreover, Moskowitz’s reliance on the ’293 patent is misplaced, to say the least, given that the Director referred the ’293 patent for merits review.

**Judicial Efficiency.** The district court’s ready-for-trial date (February 2028) is nine 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 (Acting Chief APJ Oct. 17, 2025) (holding that a district court trial date four months after the anticipated final written decision date “counsel[s] against a discretionary denial”).

**Office Error.** Moskowitz’s contention that all of Medtronic’s cited references were “*affirmatively considered* by—the examiner,” warranting denial under § 325(d), misstates the record. (DD Req. 18 (emphasis added).) There is no

evidence that Schäfer—the reference forming the primary basis for the Petition’s Grounds 1-3 (*see* Petition, 4)—was ever considered by the Examiner. Nor is there evidence that Berry (relied upon in Grounds 4-6) was considered. Neither reference is listed on the front cover of the ’755 patent, discussed during prosecution, or listed on an IDS. Instead, the two references were mere search terms in the Examiner’s search history encompassing hundreds of references. (Petition, 5–6 n. 1 (citing Ex. 1004, 298-99, 302, 353-54, 357, 420-21, 424).) The listing of these references as a search term does not “indicate[] that the Examiner viewed [them] at all.” *Siemens Mobility, Inc. et al. v. Metrom Rail, LLC*, IPR2024-00947, Paper 16 at 11-12 (Delegated Director Review Apr. 4, 2025) (concluding that “a reference appearing only in an Examiner’s search history is not deemed previously presented art under 35 U.S.C. § 325(d).”). Thus, as a threshold matter, Moskowitz cannot even show that *Advanced Bionics* prong 1 is satisfied.

Even if prong 1 of *Advanced Bionics* were met, and it is not, the Office materially erred in issuing the challenged claims under prong 2. For example, Schäfer alone anticipates each challenged independent claim and discloses all **three** limitations identified by the Examiner as missing from the prior art—a fact that Moskowitz does not dispute. (*See infra*, Section IV.B.) Discretionary denial under § 325(d) is inappropriate under these facts. *Carbyne, Inc. v. Tritech Software Systems*, IPR2025-00959, Paper 11 (Director Oct. 3, 2025) (rejecting Patent Owner’s

§ 325(d) argument because Petitioner’s prior art “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. 1044, 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 (Director Aug. 29, 2025) (citing *Tesla, Inc. v. Intellectual Ventures II, LLC*, IPR2025-00217, Paper 9 (Director June 13, 2025)) (referring petitions where the parallel litigation involved 12 patents spanning 6 families).

IPR should be instituted for the above reasons, as explained further below.

## **II. MOSKOWITZ CANNOT CLAIM “SETTLED EXPECTATIONS”**

Moskowitz’s “settled expectations” argument ignores that the challenged patent issued a mere two years ago on January 9, 2024, and expired on August 23, 2025. (Ex. 1001, Cover.) Medtronic’s early challenge to the ’755 patent “favor[s]

robust, predictable patent rights and weigh[s] against discretionary denial.” *Orca Security*, IPR2025-01083, Paper 10 at 2. This is especially so because Moskowitz has not explained “how an extraordinary amount of investment, time, and resources dedicated to research, development, . . . correlates to [its alleged] settled expectations.” (See generally DD Req., 4-10.) *Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00603, Paper 9 at 2 (Director July 24, 2025) (informative).

Moskowitz’s reliance on a “long-running patent family” and Medtronic’s notice of “ancestor patents” (e.g., the ’293 patent) does not support denial of *inter partes* review. (DD Req., 4-9.) To the contrary, such reliance supports review. For example, Moskowitz’s reliance on the ’293 patent (*see* DD Req., 8) supports institution given the ’293 patent was referred for merits review. If ancestor patents, such as the ’293 patent, are the barometer for settled expectations, then Moskowitz’s misconduct (including withholding key prior art during prosecution of the ’293 patent) and the clear Office error in issuing the ’293 patent, *see* IPR2025-01598, Paper 7, apply with equal force here and similarly warrant review of the ’755 patent.

Furthermore, settled expectations arising from publication of older parent patents do not necessarily carry over to a younger child patent. Rather, each challenged patent is reviewed for settled expectations based on its own issue date. *See Tanklogix, LLC v. Sitepro, Inc.*, IPR2025-00647, -00648, -00649, -00650, -00651, -00652, -00653, Paper 10 (July 31, 2025) (finding that U.S. Patent No.

10,488,871, which issued in 2019, did not have settled expectations even though its grandparent, U.S. Patent No. 9,342,078, issued in 2016 and had settled expectations). Moskowitz's cited authority does not warrant a different conclusion because, in those cases, a younger patent avoided review for efficiency reasons. (DD Req., 4, citing *Samsung Elecs. Co. v. iCashe, Inc.*, IPR2025-00641, Paper 12 at 3 (P.T.A.B. Aug. 14, 2025); *Amazon.com, Inc. v. Audio Pod IP, LLC*, IPR2025-00757, Paper 15 at 3 (Director Aug. 14, 2025).) Specifically, in *Amazon*, the Acting Director found that it "would be an inefficient use of Board resources" to review one out of six challenged patents when the other five challenged patents were subject to discretionary denials. *Amazon.com*, IPR2025-00757, Paper 15 at 3. The Acting Director cited similar efficiency reasons in denying review of two out of six challenged patents. *Samsung*, IPR2025-00641, Paper 12 at 3. Here, the '293 patent was referred to the Board and Medtronic's challenges to eight out of twelve asserted patents are pending before the Office and the Director.

Moskowitz's remaining arguments based on Medtronic's alleged notice of Moskowitz's "portfolio" and "subsequent enforcement activity" are essentially the same as those considered (and deemed unpersuasive) by the Director in IPR2025-01598. (*Compare* DD Req., 4-11 *with* IPR2025-01598, Paper 6, 4-11.) As explained by Medtronic in the -01598 IPR, Medtronic expressly stated in January 2016 that it "does not wish to pursue acquisition or license of" Moskowitz's portfolio. (Ex. 1040,

¶48; Ex. 1041, ¶48.) Under *Apple* (designated as informative by the Director), Medtronic’s rejection of a license put the onus on Moskowitz to either sue or hold its peace. *Apple Inc. v. Ferid Allani*, IPR2025-00856, Paper 11 at 3.<sup>1</sup> But Moskowitz chose not to sue Medtronic for almost 10 years after the January 2016 license refusal even though Medtronic continued commercialization of the allegedly infringing technology. (DD Req., 7.) Moskowitz’s strategic choice in suing Medtronic’s competitors (Globus in 2019 and ZimVie in 2022), while ignoring Medtronic, *see* DD Req. 5-6, only strengthened Medtronic’s expectation that Moskowitz would not sue Medtronic for infringement of patents in Moskowitz’s “portfolio.”<sup>2</sup>

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<sup>1</sup> Moskowitz’s attempt at distinguishing *Apple* collapses under the weight of his own inconsistency. Specifically, Moskowitz argues that *Apple* is distinguishable because at the time of Medtronic’s license refusal in 2016, “the ’755 patent had not yet issued, no infringement was alleged, and no accused products existed.” (DD Req., 7.) But if the ’755 patent’s later issue date is controlling, then Moskowitz cannot rely on older patents and earlier communications to argue for settled expectations.

<sup>2</sup> Moskowitz’s reliance on *DataDome S.A. v. Arkose Labs Holding, Inc.*, IPR2025-

Medtronic’s knowledge of Moskowitz’s patent portfolio since 2015 (DD Req., 5-8) is irrelevant and does not create settled expectations for Moskowitz. Like the petitioner in *Apple*, Medtronic advised Moskowitz that it did not require a license, and Moskowitz then waited nearly a decade to sue despite continued commercialization, supporting Medtronic’s expectations of non-enforcement. *Apple Inc. v. Ferid Allani*, IPR2025-00856, Paper 11 at 3.

Moskowitz’s arguments about meetings with Medtronic regarding purported “presentations” and “prototypes” before the ’755 patent issued, which are backed by only the bare allegations in Moskowitz’s complaint, are unpersuasive. (*Id.*, 5.) Moskowitz does not bother to explain how any of his alleged “presentations” and “prototypes” relate to the specific scope of the challenged claims. Vague commercial discussions from over a decade ago, unmoored from the specific patent rights at issue, cannot give rise to any “settled expectations” of patent validity

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00693, Paper 13 (Director Aug. 14, 2025) is unavailing. In *DataDome*, “patent owner asserted the patent two years after the parties’ discussion,” a fact the Director distinguished when declining to exercise discretion to deny institution in *Apple*. IPR2025-00856, Paper 11 at 3. Like in *Apple*, Moskowitz’s 10-year delay, however, counsels against discretionary denial.

relevant to the '755 patent.

### **III. THE FINTIV FACTORS STRONGLY FAVOR INSTITUTION**

The *Fintiv* factors strongly favor institution.

#### **A. Factor 1: Medtronic Will Request a Stay**

Medtronic has requested a stay. (Ex. 1047.) Moskowitz argues a stay is “unlikely” and “impractical.” (DD Req., 10.) But the Minnesota court has granted stays when a significant number of patents are subject to review by the Office. *See, e.g., Vascular Solutions LLC v. Medtronic, Inc.*, No. 0:19-cv-01760-PJS-TNL (D. Minn.), ECF No. 276 (July 7, 2020) (granting Medtronic’s motion to stay pending thirteen IPRs). Moskowitz’s cited cases are inapplicable because, in those cases, the courts denied a stay as IPRs were not yet instituted and involved fewer asserted patents. Here, Medtronic has filed IPRs challenging eight patents and anticipates challenging more patents; therefore, there is a high likelihood of a stay. Given the complexity of the dispute, instituting review is the most effective way to encourage a stay and conserve judicial resources.

#### **B. Factor 2: The Final Decision Will Issue Nearly a Year Before Trial**

This factor strongly favors institution. Medtronic’s Petition was accorded a filing date in November 2025 (*see* Paper 3), meaning that the Board’s final decision is due in May 2027. Meanwhile, the Minnesota Action is scheduled to be ready for trial nine 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 nine months before any verdict in the district court.

**C. Factor 3: The Minnesota Action Is in Its Infancy**

Institution is an efficient use of Board resources because the parallel litigation with Medtronic has barely begun. The Minnesota court has not yet held a *Markman* hearing or issued a claim construction order. Moskowitz recently amended its complaint to assert a twelfth patent on January 29, 2026. (Ex. 1043, ¶¶22, 34, 304-305.) Medtronic's deadline to serve invalidity contentions is not until April 28, 2026. By contrast, in *Apple*, the Office instituted review despite the fact that “the district court has issued a Markman order” and the parties had exchanged written discovery. *Apple Inc. v. Ferid Allani*, IPR2025-00856, Paper 11 at 2.

Moskowitz's recent addition of a 12th asserted patent against Medtronic further ensures that the case remains in its infancy. Contrary to Moskowitz's insinuation regarding Medtronic delaying the schedule (DD Req., 12–13), extensions to the schedule were necessitated by Moskowitz's eleventh-hour amendment to the complaint and jointly agreed to by the parties. (Ex. 2005; Ex. 2016.)

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

Medtronic's *Sotera* stipulation (Ex. 1042) “mitigates any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions.” *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-

01019, Paper 12 at 19 (P.T.A.B. Dec. 1, 2020) (precedential).

**E. Factor 5: Early FWD Supports Institution**

While the parties in the Minnesota Action are the same, the timing of the trial (Factor 2) renders this factor favorable to institution because the Board’s earlier FWD will simplify the issues for trial. *See NeuMoDx Molecular, Inc. v. HandyLab, Inc.*, IPR2020-01133, Paper 23 at 13-14 (P.T.A.B. Aug. 6, 2021).

**F. Factor 6: Strong Merits Support Institution**

The Petition presents six prior-art grounds challenging claims 1–6, 8–12, and 17–20 of the ’755 patent, including an anticipation ground based on Schäfer and multiple obviousness grounds based on combinations of Schäfer, Yeh, Berry, and Suddaby. (Petition 4–5.) The Petition supports those grounds with detailed analysis and an expert declaration. (Ex. 1002.) Moskowitz’s *attorney* arguments questioning the Petition’s merits are unpersuasive. (DD Req., 16-17.) The arguments turn on implausible claim constructions, which Moskowitz has not demonstrated are supported by the ’755 patent. For example, Moskowitz admits that surface 16 of Schäfer’s outer sleeves “rests against” the supporting ring but then contends, without support, that such “[r]esting contact is not *coupling*.” (DD Req., 16 (emphasis added).) Moskowitz similarly acknowledges that a gear inside Schäfer’s supporting ring rotates but contends, without support, that the *entire* ring must rotate in order for the prior art to disclose a “rotation of the turning mechanism.” (*Id.*, 16-17.)

Moskowitz similarly proffers an interpretation untethered to the claim language in an attempt at distinguishing the claims from the Yeh-Berry ground. (*Id.*, 17.)

#### **IV. MATERIAL ERROR BY THE OFFICE, PERPETUATED BY MOSKOWITZ’S CONDUCT, WARRANTS REVIEW**

A discretionary denial under § 325(d) is not warranted here because the first prong of *Advanced Bionics* is not satisfied for any of the Petition’s six grounds. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7–8 (P.T.A.B. Feb. 13, 2020) (precedential). Even if it were, consideration of *Becton Dickinson* factors (c), (e), and (f) confirms that there has been material error under the second prong of the *Advanced Bionics* framework. *Ecto World LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 5 (holding that Petitioner may articulate Office error “with reference to *Becton Dickinson* factors (c), (e), and (f)”) (citing *Becton, Dickinson and Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17-18 (P.T.A.B. Dec. 15, 2017) (precedential)).

##### **A. *Advanced Bionics* Prong 1 Is Not Satisfied**

The Petition’s lead reference, Schäfer, which forms the primary basis for most of the limitations in the Petition’s Grounds 1-3 (*see* Petition, 4, 23-56) was not listed on an IDS or discussed by the Examiner during prosecution. Berry, which is relied upon in Grounds 4-6 for a key limitation found missing by the Examiner (*see infra* Section IV.B.2) was also not listed on an IDS or discussed by the Examiner during

prosecution. These references are merely present in the Examiner's prior art search history encompassing hundreds of references (Petition, 5–6 n. 1 (citing Ex. 1004, 298-99, 302, 353-54, 357, 420-21, 424)), and “not deemed previously presented art under 35 U.S.C. § 325(d).” *Siemens*, Paper 16 at 11-12.

Under such facts, the Petition's reliance on non-cumulative prior art like Schäfer and Berry means that *Advanced Bionics* prong one is not satisfied. Moskowitz does not demonstrate otherwise. For example, the Board has previously held that “the first part of the *Advanced Bionics* framework is not satisfied” where the primary reference in the Petition's grounds “was not before the Office” while a secondary reference was. *See Fusion Pharms., Inc. v. Universität Heidelberg*, IPR2023-00551, Paper 8 at 8, 12–14 (P.T.A.B. Aug. 15, 2023). Likewise, in *Oticon*, the Board declined exercise of discretion under § 325(d) because there was “new, noncumulative prior art asserted in the Petition.” *Oticon Med. AB v. Cochlear Ltd.*, IPR2019-00975, Paper 15 at 19 (P.T.A.B. Oct. 16, 2019) (precedential). Here too, Schäfer and Berry are non-cumulative art because, *inter alia*, they disclose a tool for expanding a spinal implant that ***rotates along the longitudinal axis of the tool*** (like a screwdriver), which the Examiner found missing from the prior art before him. (Ex. 1004, 372; Petition, 13-14, 33-34, 66-71; *see infra* Section IV.B.2.)

Given that *Advanced Bionics* prong one is not satisfied, the Director need “not reach the second part of the *Advanced Bionics* framework” and should decline “to

exercise [] discretion to deny the Petition under § 325(d).” *Fusion Pharms.*, IPR2023-00551, Paper 8 at 14.

**B. There Was Material Error Under *Advanced Bionics* Prong 2**

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

*Becton Dickinson* factor (c) considers “the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection.” IPR2017-01586, Paper 8 at 17-18. Here, Schäfer (Ex. 1010), Yeh (Ex. 1008), and Berry (Ex. 1009) were not applied in a rejection, and they form the *primary* basis for the IPR challenge accounting for over 95% of the claim limitations in the challenged claims. (See Petition, 4, 23-95.<sup>3</sup>) The Petition thus satisfies the second prong of *Advanced Bionics* because “the asserted prior art was not a basis for rejection during examination . . . and includes specific teachings that ‘impact patentability of the challenged claims.’” See *Ecto World*, Paper 13 at 5.

Furthermore, the manner in which these references appear in the file history further warrants a finding of material error under *Becton Dickinson* factor (f), which “considers the extent to which additional evidence and facts warrant reconsideration

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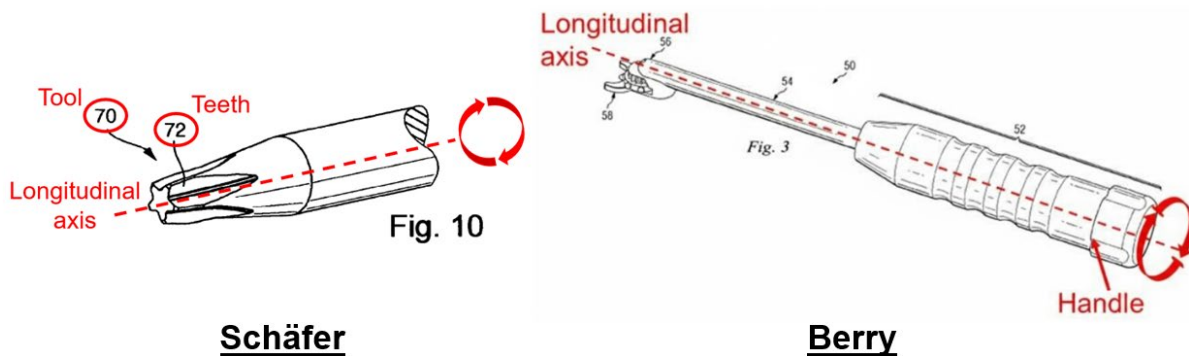
<sup>3</sup> Suddaby (Ex. 1011) was applied in a rejection by the Office but it is a secondary reference applied against only 2 out of 15 challenged claims. (Petition, 4.)

of the prior art.” *Ecto World*, Paper 13 at 6. The IDS citing the application that published as Yeh included more than 158 references, which is almost six times the size of a typical IDS. (Ex. 1004, 171-77.) *Ecto World*, Paper 13 at 6–7 n.3 (noting that a typical IDS contains fewer than 25 references). Despite the large volume of references cited, Moskowitz did not provide any “information or assistance regarding the relevance of references” to the Examiner. (Ex. 1004, 178-179); *Ecto World*, Paper 13 at 6-7. Berry and Schäfer were buried in the Examiner’s prior art search history encompassing hundreds of references and were not discussed during prosecution. (Petition, 5–6 n. 1 (citing Ex. 1004, 298-99, 302, 353-54, 357, 420-21, 424).) These facts demonstrate that “denial under § 325(d) is not warranted.” *Ecto World*, Paper 13 at 7.

## **2. *Becton Dickinson* Factor (e) (Examiner Error)**

The Petition identifies the Examiner’s allowance rationale and explains why the cited art discloses the very limitations the Examiner viewed as missing (Petition, 12–14)—a fact Moskowitz does not dispute (*see* DD Req.). For example, in allowing the claims, the Examiner determined that: “in Daher the tool does not turn along its longitudinal axis but is rotated about the axis of the device and for Biedermann the threaded body has an axis that is perpendicular to an axis that extends from the first to the second shell.” (Petition, 13; Ex. 1004, 372 (Reasons for Allowable Subject Matter in Office Action dated 8/16/23), 434 (Notice of Allowance

stating that “the reasons for allowance were included in the final office action mailed 8/16/23”).) The Petition points to prior art disclosures in Schäfer and Berry of a tool that rotates along its longitudinal axis (like a screwdriver), as shown below. (Petition, 14–16, 18-20, 33-34, 67-68.) The Petition further explains how the Petition’s primary references, Schäfer and Yeh, disclose a threaded body that has an axis that is aligned (and not perpendicular) to an axis extending from the first to the second shell. (*Id.*, 31-32, 64.)



(Ex. 1010, Fig. 10 (cited Petition, 34); Ex. 1009, Fig. 3 (cited Petition, 67).)

The Petition also cites the Examiner’s understanding that Biedermann’s gear does not rotate “about an axis that passes through the center of the gear.” (Petition, 13; Ex. 1004, 389 (Examiner Interview Summary), 380-84 (amending claim 31 based on Examiner’s suggestion), 434 (Reasons for Allowance).) Again, the Petition explains how both Schäfer and Yeh disclose a gear that rotates about an axis passing through its center. (Petition, 39-40, 43-44, 82, 85-86.)

This analysis is precisely the type of additional evidence and technical explanation that warrants reconsideration under *Becton Dickinson* factor (e). Given these facts, “it is an appropriate use of Office resources to review the potential error” in issuing the challenged claims of the ’755 patent. *FreightCar*, IPR2025-01046, Paper 20 at 3-4 (finding Office error because the prior art “appear[s] to disclose the allowable features of the claims”). Because the Examiner did not engage with Schäfer, Yeh, and Berry, which Medtronic relies upon for more than 95% of the claim limitations, Medtronic is not asking the Board to “reconsider and reweigh the same disclosures the Office already evaluated during prosecution.” (DD Req., 19.)

## **V. 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 *Tesla*, the Office referred petitions where the parallel litigation involved 11 patents, citing the large number of patents and “a diverse range of subject matter” as weighing against discretionary denial. *Tesla*, IPR2025-00217, Paper 9 at 2-3. 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. v. Intellectual Ventures I, LLC*, IPR2025-00785, Paper 11 at 3 (Director Aug. 29, 2025). 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 12th patent added by Moskowitz less than a month ago. (Ex. 1043, ¶¶22, 34, 304-305.) Contrary to Moskowitz’s assertion that the asserted patents “arise from a common lineage and share overlapping disclosures and technology” (DD Req., 8), 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. 1044, 9-12.) These are

precisely the type of “complex” litigations where the Office has found the Board’s expertise most valuable. Institution here allows the Board to apply its specialized technical expertise to specific validity issues, thereby streamlining massive district court actions and preventing the waste of judicial resources on invalid claims.

Moskowitz’s position regarding the Board not being better suited to review these patents is based on the false premise that “[r]eviewing a newer family member [*i.e.*, the ’755 patent] *in isolation* would not streamline the dispute.” (DD Req., 9 (emphasis added).) But the Director has already referred the older ’293 patent to the Board, and Medtronic’s other IPRs are pending the Director’s review. Instituting Medtronic’s IPRs, including this one, would promote efficiency and assist the district court in narrowing the scope of issues it needs to decide.

## **VI. 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 1-6, 8-12, and 17-20.

Respectfully submitted,

Dated: February 20, 2026

By: /Naveen Modi/  
Naveen Modi (Reg. No. 46,224)

Counsel for Petitioner

**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 February 20, 2026:

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