

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,
Petitioner

v.

MOSKOWITZ FAMILY LLC,
Patent Owner

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

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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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	First Amended Complaint, <i>Moskowitz Family LLC v. Medtronic, Inc. et. al.</i> , No. 0:25-CV-00769-PJS-DLM, ECF No. 27 (Dist. Of Minn. May 23, 2025)
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	Complaint, <i>Moskowitz Family LLC v. Zimvie Inc.</i> , No. 1:22-cv-01632-UNA, ECF No. 1 (D. Del. December 23, 2022)
2010	Information Disclosure Statement citing early publication of '755 great-great-great-grandparent U.S. 7,704,279 (U.S. App. Pub. No. 2006/0241621) in Medtronic/Warsaw U.S. Patent Application No. 12/326,682 (December 3, 2008)
2011	Information Disclosure Statement citing '755 great-grandparent U.S. 9,924,940 in Medtronic/Warsaw U.S. Patent Application No. 17/246,968 (May 3, 2021)
2012	Information Disclosure Statement citing '755 grandparent U.S. 10,251,643 in Medtronic/Warsaw U.S. Patent Application No. 17/307,706 (November 3, 2021)
2013	<i>Intentionally left blank</i>
2014	<i>Intentionally left blank</i>
2015	<i>Intentionally left blank</i>
2016	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)
2017	Complaint, <i>Moskowitz Family LLC v. Globus Medical, Inc.</i> , No. 6:19-cv-00672, ECF No. 1 (W.D. Tex. November 20, 2019)
2018	<i>Intentionally left blank</i>
2019	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)

2020	Letter from Michael Fink, Counsel for Nathan Moskowitz to Newton Metcalf Jr., Director of Advanced Technologies Program for Medtronic, Inc., dated June 30, 2015
2021	Letter from Michael Fink, Counsel for Nathan Moskowitz to Brad Lerman, Senior Vice President and General Counsel for Medtronic, Inc., dated June 30, 2015
2022	Attachments to Notice Letters including Moskowitz Patent Portfolio and U.S. Patent No. 9,005,293
2023	<i>Intentionally left blank</i>
2024	Uniloc USA, Inc. v. Motorola Mobility LLC, Case No. 2:16-CV-00992-JRG, ECF No. 125 (E.D. Tex. Apr. 5, 2017)) (Gilstrap, J.)

I. INTRODUCTION

The Director should deny institution. This Petition challenges a continuation patent that issued into a long-established and actively enforced patent family, where the district court is already adjudicating multiple related family members and will do so regardless of what happens here. Board review of a single family member would not meaningfully simplify that dispute; it would only duplicate adjudication already underway in another forum.

Petitioner's knowledge of the Moskowitz inventions predates the '755 patent. For more than a decade before issuance, Petitioner had direct, detailed notice of the inventions and the applications that later matured into the '755 patent. From 2005 through 2015, Patent Owner repeatedly presented those inventions to Petitioner's engineers, business leadership, and counsel—including the very disclosures to which the '755 patent claims priority. In 2015, Petitioner received formal, portfolio-wide notice identifying the '755 patent's grandparents and the broader family, acknowledged receipt, and stated it was "working [its] way through" the portfolio.

That history frames the settled-expectations inquiry. The Director's guidance recognizes that settled expectations arise not only from the age of a particular patent, but from long-standing notice of a mature patent family and the institutional posture in which related patents are enforced. Here, the record reflects continuous notice, active monitoring, and family-wide enforcement—paired with a selective request for

Board review of a single family member while the district court adjudicates the family as a whole.

Institution would be inefficient. The district court is adjudicating twelve asserted patents drawn from the same family, including multiple relatives of the '755 patent, and will resolve overlapping technology, claim-construction issues, and validity disputes across that family regardless of institution. An IPR directed to a single continuation patent cannot streamline that adjudication.

Nor do the Petition's merits justify that duplication. The Petition relies on prior art that was considered by the Office, opens with arguments outside the scope of inter partes review, and does not present a compelling case for Board intervention. Where the district court will adjudicate the family regardless and the Petition offers no path to simplification, discretionary denial under is warranted.

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

Section 314(a) gives the Director broad discretion to determine whether an inter partes review should proceed. The USPTO "is permitted, but never compelled, to institute" an IPR, even when a petition satisfies the statutory thresholds. *Nautilus Hyosung Inc. v. Diebold, Inc.*, IPR2017-00426, Paper 17 at 11 (PTAB June 22, 2017). That discretion is properly exercised to deny institution where parallel district-court litigation will adjudicate the same underlying disputes, such that Board review would be duplicative rather than efficient. *NHK Spring Co. v. Intri-Plex*

Techs., Inc., IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019).

To guide that inquiry, the Office has identified a set of practical considerations—commonly referred to as the *Fintiv* factors—that assess whether an IPR would advance efficiency and fairness in the presence of parallel litigation. Those considerations include the likelihood of a stay, the progress and investment in the district-court action, the degree of overlap between the proceedings, the identity of the parties, 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).

The Director’s guidance also makes clear that discretionary denial is not confined to the *Fintiv* factors alone. Independent considerations—such as the parties’ settled expectations arising from long-standing notice of a mature patent family and the institutional posture of related proceedings—may warrant denial even where some *Fintiv* considerations might otherwise favor review. Director’s March 26, 2025 Memorandum, *Interim Processes for PTAB Workload Management*, at 2-3; *Dabico Airport Sol. 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). Recent decisions confirm that where related family members are being adjudicated in district court and Board review would add little value, discretionary denial is appropriate. *Samsung Elecs.*

Co. v. iCashe, Inc., IPR2025-00641, Paper 12 at 3 (Aug. 14, 2025); *Amazon.com, Inc. v. Audio Pod IP, LLC*, IPR2025-00757, Paper 15 at 3 (Aug. 14, 2025).

A. The Parties’ Settled Expectations Strongly Favor Discretionary Denial.

The Director’s recent decisions place significant weight on the parties’ settled expectations. Those expectations weigh against institution where a challenged patent is part of a mature, well-known patent family and Board review would not serve as a meaningful substitute for district-court adjudication of related family members. In that circumstance, Director decisions make clear that discretionary denial is appropriate because Board review of a single family member adds little value and risks inefficient, piecemeal adjudication. *E.g.*, *iCashe* at 3; *Audio Pod* at 3.

That is the posture here. The ’755 patent issued as part of a long-running patent family that Petitioner understood well before issuance, tracked through prosecution and enforcement, and is now being adjudicated in district court across multiple related patents—including several long-standing ancestor patents not subject to any post-grant proceeding. Petitioner had continuous, detailed notice of the Moskowitz inventions and the applications that matured into the ’755 patent, observed enforcement of the family against competitors, and now seeks Board review of a single family member while the district court adjudicates the rest.

1. Petitioner Had Long-Standing, Detailed Notice of the Moskowitz Patent Family.

Petitioner's notice of the Moskowitz inventions long predates the '755 patent. Between 2005 and 2015, Dr. Moskowitz repeatedly disclosed his spinal-fusion designs to Petitioner's engineers, business leadership, and in-house counsel. Ex. 2004 ¶¶ 40-41, 43-44. They included technical presentations, prototype demonstrations, claim sets, and written materials describing the very inventions and applications that later matured into the '755 patent and its related family members. *Id.* Petitioner actively engaged with those disclosures, requested additional materials, and sought internal review with its research and development leadership.

That understanding was reinforced in 2015, when Patent Owner's counsel provided Petitioner's General Counsel and technical leadership with formal, portfolio-wide notice identifying more than thirty issued patents and pending applications, including ancestors of the '755 patent. Ex. 2020; 2021; 2022 at 1-2, 4; 2004 ¶ 45. Petitioner acknowledged receipt, stated that it was "working [its] way through" the portfolio, and undertook internal review. Ex. 2004 ¶¶ 46-47. Director precedent makes clear that such actual notice weighs strongly in favor of discretionary denial. *See Toyota Motor Corp. v. AutoConnect Holdings LLC*, IPR2025-00890, Paper 9 at 3 (Acting Director Stewart Sept. 19, 2025).

Patent Owner's subsequent enforcement activity made future assertion foreseeable. After providing formal notice, Patent Owner publicly enforced the

Moskowitz portfolio against other market participants, including Globus Medical and ZimVie. Exs. 2009; 2017. Those actions resulted in contested district-court litigation and multiple IPR petitions—each denied—confirming that the portfolio was neither dormant nor theoretical. A sophisticated industry participant with long-standing notice of both the patent family and its active enforcement cannot plausibly claim surprise when a related continuation patent is later asserted. *See Google LLC v. SoundClear Techs. LLC*, IPR2025-00344, Paper 15 at 2 (Aug. 4, 2025).

2. The Record Forecloses Any Claim of Surprise or Reasonable Reliance on Non-Enforcement.

Settled expectations are assessed from the record, not from hindsight. The relevant question is whether the record supports reasonable reliance concerning enforcement or challenge of the patent. *iRhythm*, at 3. Here, the record forecloses any claim that Medtronic reasonably relied on non-enforcement of the Moskowitz patent family.

For years, Medtronic repeatedly encountered the '755 patent family in the ordinary course of its business and prosecution activity. Medtronic and its subsidiaries cited the '755 family members dozens of times in IDS filings across their own portfolios. *E.g.*, Ex. 2004 ¶¶ 71, 74–75, 90, 94, 97–98, 102, 117, 121–123, 137, 139, 141–142, 146, 160, 164, 169, 183, 187–188, 203, 207–208, 212, 226, 230–231, 249, 253–254, 271–276, 290, 294–296.

That record is incompatible with any claim of surprise or reliance. When Patent Owner provided portfolio notice in 2015, the '755 patent had not yet issued, no infringement was alleged, and no accused products existed. But enforcement of the family was foreseeable, and Medtronic continued to track and cite the portfolio while developing products in a space shaped by a known and actively prosecuted patent family. Exs. 2010 at 3; 2011 at 19; 2012 at 4. In that posture, any expectation that individual family members would not be enforced was a business risk—not a reliance interest protected by discretionary review.

Director precedent makes clear that a petitioner's internal assessment of patent rights—particularly before infringement is even possible—does not itself establish settled expectations. *DataDome S.A. v. Arkose Labs Holdings, Inc.*, IPR2025-00693, Paper 13 at 3 (Director Aug. 14, 2025). Here, the record reflects continuous notice, ongoing monitoring, and an understanding that enforcement of related family members would proceed through coordinated adjudication. In those circumstances, discretionary denial is warranted because Board review would add little value and risk fragmenting resolution of a family-wide dispute.

3. District Court Adjudication of Long-Standing Ancestor Patents Undermines Any Need for Board Review.

This Petition targets a single continuation within a long-standing patent family that the district court is already adjudicating in a coordinated manner, family-wide manner. The question is not whether the overall litigation is complex or involves

multiple patents, but whether Board review of one family member would meaningfully simplify what the district court must decide. It would not.

The '755 patent is part of a mature family that traces back more than two decades and shares a common disclosure and technical core. Patent Owner has asserted multiple related family members in the district court, including U.S. Patent Nos. 9,005,293; 9,907,674; 10,064,738; 10,016,284; 10,238,505; 10,426,633; 10,603,183; 11,096,797; 11,376,136; 12,011,367; and 12,491,088—each tracing their lineage to U.S. Patent No. 7,704,279. Several of these ancestor patents have been in force for six to ten years, giving rise to substantial settled expectations when combined with Petitioner's long-standing notice of the family. Critically, the validity of those patents will be litigated to judgment regardless of what happens here.

This posture is fundamentally different from decisions such as *American Airlines*, *Tesla*, *Shenzen Tuozhu*, *Harbor Freight*, and *Apex Beam*. Those cases involved portfolios spanning multiple families, diverse disclosures, and patents that had corresponding IPRs filed. Here, by contrast, all asserted patents arise from a common lineage and share overlapping disclosures and technology, and district-court adjudication will proceed across the family regardless of institution. Even if additional petitions are filed, Board review would not displace the district court's work on claim construction, infringement, or non-IPR-eligible validity issues, nor would it resolve family-wide disputes rooted in a common disclosure. Thus, the

USPTO cannot be “better suited” to resolve the controversy; it would review issues in parallel, not in lieu of, the district court. *See American Airlines, Inc. v. Intellectual Ventures I, LLC*, IPR2025-00785, Paper 11 (Director Aug. 29, 2025); *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 (Director June 13, 2025); *Shenzen Tuozhu Tech. Co., Ltd. v. Stratasy, Inc.*, IPR2025-00438, Paper 10 (Director July 17, 2025); *Harbor Freight Tools USA Inc. et al. v. Champion Power Equip., Inc.*, IPR2025-00805, Paper 20 (Director Sept. 19, 2025); *Apple Inc. v. Apex Beam Techs. LLC*, IPR2025-00896, Paper 10 (Director Sept. 3, 2025).

Reviewing a newer family member in isolation would therefore not streamline the dispute; it would fracture it. The district court will still evaluate overlapping technology, prior art, and invalidity theories across the older family members with well-developed settled expectations. Recent Director decisions deny institution in precisely these circumstances, recognizing that Board review “adds little value” where related patents will be adjudicated in district court in any event. *iCashe*, at 3.

The Director has exercised discretion to deny institution on settled-expectations grounds even where other considerations might otherwise favor review. *OnePlus Tech. Co. v. Pantech Corp.*, IPR2025-00637, Paper 17 at 2 (Aug. 14, 2025); *Kahoot! AS v. Interstellar Inc.*, IPR2025-00696, Paper 12 at 2 (July 31, 2025). The same considerations apply here. Where a mature patent family is being adjudicated

to judgment in district court, § 314(a) does not require the Board to intervene—and efficiency counsels against it.

B. Factor 1 Favors Denial Because No Stay Was Sought and Is Unlikely.

Factor 1 weighs against institution because Petitioner has not sought a stay of the district court action—and a stay is unlikely even if one were requested. The case has been pending for nearly eleven months, yet Petitioner has taken no steps to pause the proceedings in favor of Board review. Where a petitioner elects to proceed with parallel litigation rather than seek to pause it in favor of Board review, that choice weighs against institution.

A stay would also be impractical. The district-court action involves twelve asserted patents drawn from the same family, including U.S. Patent No. 12,491,088, which issued in December 2025. This Petition challenges only a subset of claims and does not place all asserted patents before the Board. Even if this IPR were instituted, the district court would still need to proceed with claim construction, infringement, and invalidity issues for the remaining patents—including recently added family members. Under these circumstances, an IPR would not meaningfully simplify the case, and a stay would only delay resolution of the bulk of the dispute.

Courts routinely deny stays where parallel IPRs have not yet been instituted or would not materially narrow the litigation, particularly where significant portions of the case would proceed regardless. *E.g., Hutchinson Tech. Inc. v. Nitto Denko*

Corp., No. 17-CV-1992, 2018 WL 5984873, at *14–15 (D. Minn. Sept. 19, 2018); *Stratasys, Inc. v. Microboards Tech., LLC*, No. 13-3228, 2015 WL 1608344, at *2 (D. Minn. Apr. 10, 2015); Ex. 2024 at 3. Courts in the District of Minnesota, in particular, have declined stays where asserted patents exceed those placed into IPR or where substantial portions of the litigation would proceed in parallel. *See Dane Techs., Inc. v. Gatekeeper Sys., Inc.*, No. 12-2730 ADM/AJB, 2013 WL 4483355, at *2-3 (D. Minn. Aug. 20, 2013).

The Board has likewise recognized that when “no stay is likely to be entered,” Factor 1 “leans towards denial of institution.” *Mylan Labs. Ltd. v. Janssen Pharm. NV*, IPR2020-00440, Paper 17 at 13–14 (PTAB Sept. 16, 2020). Because Petitioner has not sought a stay—and because a stay would not advance efficiency even if requested—Factor 1 favors discretionary denial.

C. Factors 2 and 3 Favor Denial Because the District Court Action Is Advancing and Investment Is Inevitable.

Factors 2 and 3 weigh against institution because the district court action is already advancing in ways that will continue regardless of any IPR—and because substantial, irreversible investment will occur well before any institution decision. Under the Director’s guidance, where parallel litigation has progressed beyond the early stages and will not be meaningfully streamlined by Board review, discretionary denial is warranted to avoid duplicative effort and inconsistent results.

The district court action has been pending since February 2025 and is proceeding on a schedule that extends beyond any potential final written decision. Exs. 2001; 2019. By the time the Director decides whether to institute in May 2026, the district court will already be engaged in adjudicating infringement and validity issues across the asserted patent family, with infringement and invalidity contentions exchanged and discovery underway. Claim construction proceedings are scheduled to begin shortly thereafter and will proceed regardless of any IPR.

Any suggestion that the district court's progress is limited ignores the procedural reality—and Petitioner's own conduct. Medtronic sought and obtained a 60-day extension to respond to the complaint, followed by additional extensions tied to its demand that Patent Owner amend the complaint, delaying the case by nearly three months at the outset. Exs. 2002-2003. More recently, after a continuation patent in the same family issued in December 2025, Medtronic conditioned its consent to adding that patent on a further three-month extension of its invalidity and non-infringement contentions and related claim-construction deadlines. Exs. 2005; 2016. These extensions pushed back milestones that would otherwise already be underway. A petitioner cannot manufacture delay and then rely on that delay to argue against discretionary denial.

By the time the Director decides whether to institute, the parties and the district court will have invested substantial resources in adjudicating the same claims

and overlapping validity issues across a broader set of related family patents that will proceed regardless of institution. Institution at that stage would trail the district court's work, not lead it, and would duplicate—rather than streamline—adjudication. Factors 2 and 3 therefore favor discretionary denial.

D. Factor 4 Favors Denial Because Institution Would Not Eliminate Overlap or Meaningfully Simplify the District Court Proceedings.

Factor 4 weighs against institution because the invalidity issues raised in this Petition will be litigated in the district court regardless of what happens here, and Board review would not meaningfully simplify the parallel proceedings. Where an IPR would address only a narrow subset of issues while leaving substantial disputes to be resolved in court, discretionary denial is warranted.

The same prior art references, the same structural limitations, and the same claim construction disputes raised here will be litigated in the district court across the asserted patent family. Although Petitioner has filed a stipulation in the district court, it has not submitted any stipulation in this proceeding. The Office's Interim Director Discretionary Process instructs petitioners to file such stipulations "as soon as practicable." Ex. 2006 at 3. That omission leaves both scope and timing uncertain.

In any event, a timely filed *Sotera* stipulation would not eliminate the overlap. The Director has emphasized that such stipulations are "not dispositive" where other invalidity theories remain available in district court. Ex. 2007 at 2–3. That is the case here. Petitioner remains free to pursue system art, public-use evidence, on-sale bar

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 such theories remain available, the Office has explained that a *Sotera* stipulation is “not... particularly meaningful because the efficiency gained by an AIA proceeding will be limited.” Ex. 2008 at 3.

The problem is compounded by the family-wide nature of the district court action. Nothing prevents Petitioner from asserting the same art against other asserted family members in the district court, even if this IPR were instituted. So the Board’s review would not serve as a “true alternative” to the district court litigation. The Office has denied institution on that basis even where a stipulation was offered. *SAP Am., Inc. v. Cyandia, Inc.*, IPR2024-01495, Paper 13 at 8–9 (Apr. 7, 2025); *Motorola Sols. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3–4 (PTAB Mar. 28, 2025).

Because the same invalidity issues will be litigated regardless of institution, Board review would duplicate effort and risk inconsistency. Factor 4 favors denial.

E. Factor 5 Favors Denial Because the Same Parties are Litigating the Same Disputes in District Court.

Factor 5 weighs against institution because Petitioner is the defendant in the parallel district-court action, and the same parties are already litigating the same patent family and overlapping invalidity issues there. *Fintiv*, Paper 11 at 13–14; *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020). Where, as here, a single district-court proceeding between the same parties

will resolve their disputes regardless of institution, an IPR does not promote efficiency or conserve resources.

F. Factor 6 Favors Denial Because the Petition Does Not Present Compelling Merits.

Factor 6 also favors discretionary denial. The Director does not require a full merits analysis at this stage; the question is whether the Petition presents merits so compelling that they outweigh the strong discretionary considerations discussed above. *Fintiv*, Paper 15 at 15. And even a petition with some facial strength may be denied when other § 314(a) considerations predominate. *Samsung Elecs. Co., Ltd. v. SiOnyx, LLC.*, IPR2025-00065, Paper 16 at 19–20 (PTAB June 6, 2025). This Petition does not.

At the outset, the Petition relies on arguments outside the proper scope of inter partes review. It opens by suggesting that the '755 patent issued due to a “questionable prosecution strategy,” including alleged “burying” of prior art through continuation practice and IDS submissions. Pet. 1–2. Arguments sounding in inequitable conduct are not cognizable in an IPR, which is limited to challenges under §§ 102 and 103 based on patents or printed publications. 35 U.S.C. § 311(b). More importantly, the premise is incorrect. Petitioner acknowledges that Patent Owner submitted an IDS listing Yeh, that the Examiner independently located Berry and Schäfer, and that Suddaby was the subject of an obviousness rejection during

prosecution. Pet. at 5-6; Ex. 1004, 132, 172, 298-99, 302, 353-54, 357, 420-21, 424. These are the very references Petitioner says were “buried” or overlooked.

The Petition’s substantive grounds likewise suffer from threshold defects that undermine any claim of compelling merits. With respect to the Schäfer-based grounds, Petitioner fails to show that Schäfer discloses an “expansion mechanism coupled to the first opposite surface and the second opposite surface,” as required by independent claims 1 and 12. Petitioner identifies the “opposite surfaces” as surface 16 on the outer sleeves, and the “expansion mechanism” as inner sleeves 34 and 36 together with supporting ring 18. Pet. 25–30. But the Petition never plausibly explains how surface 16 is coupled to that expansion mechanism. The threading Petitioner relies on couples the *inner surfaces* of the outer sleeves to the inner sleeves—not surface 16. And Schäfer’s figures confirm that, during expansion, surface 16 moves relative to the asserted expansion mechanism. Nor does the fact that surface 16 “rests against” the supporting ring in a compressed state establish coupling. Resting contact is not coupling.

The Schäfer grounds independently fail for a second reason. Petitioner contends that Schäfer discloses a “turning mechanism” comprising bevel teeth 26 on the inner sleeves together with supporting ring 18, and that rotating a tool causes rotation of that turning mechanism. Pet. 30–33. But under Petitioner’s own definition, the turning mechanism includes the supporting ring, and the Petition does

not allege—nor does Schäfer disclose—that the supporting ring rotates in response to tool rotation. If the supporting ring does not rotate, Petitioner’s identified turning mechanism does not rotate. That internal inconsistency is a fundamental failure of the asserted mapping, not a marginal technical dispute.

The Yeh–Berry grounds fail for different, but equally fundamental, reasons. Independent claims 1 and 12 require that rotating a tool while engaged with the tool-engagement surface *along the direction of insertion* causes rotation of a turning mechanism. In Yeh and Berry, however, the tool-engagement surfaces are embedded in the turning mechanisms themselves. As those mechanisms rotate, the engagement surfaces rotate with them, moving away from the longitudinal axis of the tool. As a result, the tool cannot remain engaged along the direction of insertion while rotating about its own axis. Even in the proposed Yeh–Berry combination, Berry’s tool repeatedly disengages as the turning structure rotates. That physical incompatibility with the claim language is not cured by combination or addressed by the Petition.

These deficiencies are compounded by the structure of the Petition. Grounds 2 and 3 depend on the Schäfer theories asserted in Ground 1, and Grounds 5 and 6 depend on the Yeh–Berry theories asserted in Ground 4. Where the independent grounds fail to meet core claim requirements, the dependent grounds necessarily fall with them. The Petition offers no alternative anticipation theories or independent combinations that would cure those failures.

The Petition does not present compelling merits. In these circumstances, Factor 6 does not outweigh the discretionary considerations favoring denial.

III. THE DIRECTOR SHOULD EXERCISE DISCRETION UNDER § 325(d) TO DENY INSTITUTION

Discretionary denial is independently warranted under § 325(d). The Petition relies exclusively on prior art references that were before—and affirmatively considered by—the examiner during prosecution of the '755 patent. Under *Advanced Bionics*, where the same or substantially the same art was previously presented to the Office, institution is improper absent a showing of material error in the prior evaluation. *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020).

Petitioner admits that the Schäfer, Yeh, Berry, and Suddaby references were before the examiner. Pet. at 4-6. That satisfies the first *Advanced Bionics* prong. Under the second prong, Petitioner must demonstrate a material error apparent from the prosecution record. That burden is demanding. It is not met by offering a different obviousness narrative or by reweighing familiar disclosures. *Advanced Bionics*, at 8–9; *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17–18.

Petitioner cannot plausibly carry that burden on this record. The prosecution history does not reflect that the examiner overlooked these references, misunderstood their disclosures, applied an incorrect legal standard, or made

internally contradictory factual findings. To the contrary, the record reflects active engagement with the asserted art—including that the Examiner located Berry and Schäfer and that Suddaby was the subject of an obviousness rejection during prosecution. Pet. 5–6; Ex. 1004, 132, 172, 298–99, 302, 353–54, 357, 420–21, 424. Nor does the Petition identify any compelling merits, new claim constructions, or factual predicate that would materially alter the relevance of this previously considered art.

Viewed against the prosecution record, § 325(d) applies with full force. Granting review would require the Board to reconsider and reweigh the same disclosures the Office already evaluated during prosecution—precisely what § 325(d) is designed to prevent. Discretionary denial is therefore warranted.

IV. CONCLUSION

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

Date: January 20, 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 2001-2012, 2016-2017, 2019-2022, 2024) were served electronically via e-mail on January 20, 2026, in their entireties on the following counsel of record for Petitioner:

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