

**From:** [Trials](#)  
**To:** [Eric Zelepugas](#); [Bansal, Chetan R.](#); [Moskowitz \(Post-Grant\)](#); [Robert Conley](#); [PH-Medtronic-Moskowitz-IPR](#)  
**Cc:** [Trials](#)  
**Subject:** RE: IPR2026-00162  
**Date:** Thursday, April 9, 2026 7:53:32 AM  
**Attachments:** [image003.png](#)  
[image004.png](#)

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Counsel,

Petitioner is authorized to file a 5-page preliminary reply in IPR2026-00162, due no later than April 14, 2026, limited to addressing Patent Owner's position that the challenged patent is entitled to an earlier date of invention and to addressing Patent Owner's position in the Preliminary Response regarding *Revvo* and *Tesla*. Patent Owner is authorized to file a 5-page preliminary sur-reply in IPR2026-00162 due no later than April 17, 2026, limited to addressing the same issues.

The parties should file their briefs as papers in P-TACTS.

Regards,

Andrew Kellogg,  
Deputy Chief Clerk, Trials  
Patent Trial and Appeal Board  
USPTO  
[andrew.kellogg@uspto.gov](mailto:andrew.kellogg@uspto.gov)  
(571) 272-5366



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**From:** Bansal, Chetan R. <[chetanbansal@paulhastings.com](mailto:chetanbansal@paulhastings.com)>  
**Sent:** Wednesday, April 8, 2026 3:40 PM  
**To:** Eric Zelepugas <[zelepugas@avantechlaw.com](mailto:zelepugas@avantechlaw.com)>; Director\_Discretionary\_Decision <[Director\\_Discretionary\\_Decision@uspto.gov](mailto:Director_Discretionary_Decision@uspto.gov)>; Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** Moskowitz (Post-Grant) <[moskowitz\\_post-grant@avantechlaw.com](mailto:moskowitz_post-grant@avantechlaw.com)>; Robert Conley <[conley@avantechlaw.com](mailto:conley@avantechlaw.com)>; PH-Medtronic-Moskowitz-IPR <[PH-Medtronic-Moskowitz-IPR@paulhastings.com](mailto:PH-Medtronic-Moskowitz-IPR@paulhastings.com)>  
**Subject:** RE: IPR2026-00162

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Honorable Director Squires and the Honorable Board,

Patent Owner did not provide its response below to Petitioner when Petitioner asked Patent Owner to insert its position in Petitioner's April 7 email. Patent Owner only indicated that it opposes Petitioner's request but then followed up with a detailed response to Petitioner's email. As a result, Petitioner is unfortunately forced to respond to Patent Owner's inaccurate allegations in a piecemeal manner.

While Petitioner disagrees with virtually everything Patent Owner alleges below, Petitioner would like to note that Patent Owner's representation that Petitioner "had a full and fair opportunity to address [the antedating] issue and, in fact, did so in its opposition" is facially wrong. Petitioner filed its Opposition (Paper 7) on March 9, three hours before the POPR. Prior to the POPR, Patent Owner presented only a bare allegation (with no supporting evidence) that Palmatier "may" be disqualified as prior art in its Request for discretionary denial. See Paper 6 at 2, 14–15. It is only in the POPR that Patent Owner presented evidence (over thirty new exhibits, including a declaration by one of the inventors) and over fifty pages of arguments on the swear behind issue. There can be no credible dispute that Petitioner has not had an opportunity to respond to those arguments and evidence, which were in Patent Owner's sole

possession. Moreover, the Board has previously authorized replies to POPRs when a Patent Owner raises contested factual issues (such as antedating prior art) in a POPR. See, e.g., IPR2025-00058, Paper 11 at 2, 20-25 (May 21, 2025).

Sincerely,

Chetan Bansal  
Counsel for Petitioner

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**PAUL**  
**HASTINGS**

**Chetan Bansal | Of Counsel, Litigation Department**

Paul Hastings LLP | 2050 M Street NW, Washington, DC 20036 | Direct: +1.202.551.1948 |  
Main: +1.202.551.1700 | Fax: +1.202.551.0448 | [chetanbansal@paulhastings.com](mailto:chetanbansal@paulhastings.com) |  
[www.paulhastings.com](http://www.paulhastings.com)

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**From:** Eric Zelepugas <[zelepugas@avantechlaw.com](mailto:zelepugas@avantechlaw.com)>

**Sent:** Tuesday, April 7, 2026 5:39 PM

**To:** Bansal, Chetan R. <[chetanbansal@paulhastings.com](mailto:chetanbansal@paulhastings.com)>; [Director\\_Discretionary\\_Decision@uspto.gov](mailto:Director_Discretionary_Decision@uspto.gov); Trials <[trials@uspto.gov](mailto:trials@uspto.gov)>

**Cc:** Moskowitz (Post-Grant) <[moskowitz\\_post-grant@avantechlaw.com](mailto:moskowitz_post-grant@avantechlaw.com)>; Robert Conley <[conley@avantechlaw.com](mailto:conley@avantechlaw.com)>; PH-Medtronic-Moskowitz-IPR <[PH-Medtronic-Moskowitz-IPR@paulhastings.com](mailto:PH-Medtronic-Moskowitz-IPR@paulhastings.com)>

**Subject:** [EXT] Re: IPR2026-00162

Director,

Patent Owner respectfully opposes Petitioner's request for leave to file a reply to Patent Owner's Preliminary Response ("POPR"). The request is both untimely and procedurally improper.

First, Patent Owner clearly raised its challenge to whether Palmatier qualifies as prior art in its discretionary denial brief. See Paper 6 at 2, 14–15. Petitioner had a full and fair opportunity to address that issue and, in fact, did so in its opposition. See Paper 7 at 3, 11. However, Petitioner elected not to substantively support its position with evidence, despite having approximately one month to prepare its response. Having made that strategic choice, Petitioner cannot now seek a second opportunity to cure that deficiency after reviewing Patent Owner's POPR and supporting evidence. Patent Owner followed USPTO guidance by raising the issue in its discretionary denial brief and developing it further in the POPR; Petitioner cannot credibly claim surprise.

Second, the timing of Petitioner's request underscores its impropriety. Patent Owner filed its POPR nearly one month ago, affording Petitioner ample time to gather evidence and seek appropriate relief. Instead, Petitioner waited until after the Director issued the discretionary denial determination and referred the Petition for merits consideration before requesting leave to file a reply—more than two months after Patent Owner first raised the issue and approximately one month after the POPR was filed. Petitioner now seeks an additional ten days to respond. This sequence reflects a calculated attempt to maximize time to formulate a response after previewing Patent Owner's full evidentiary showing, rather than any legitimate need arising from newly discovered issues.

Third, Petitioner cannot claim surprise regarding Patent Owner's discussion of Revvo, Tesla, and Generac and its district court positions. It is Petitioner's burden to identify how the challenged claims should be construed in the Petition itself. Petitioner had over nine months after service to develop its claim constructions but instead stated that the Board should "not construe any claims." Paper 1 at 21. Director decisions that reinforce existing petition requirements do not justify reopening the record or permitting a belated reply. Petitioner's request for additional briefing based on these decisions is simply an attempt to remedy deficiencies in its Petition, not a legitimate basis for additional briefing.

The AIA framework does not contemplate serial, post hoc replies of this nature. Granting Petitioner's request would be prejudicial and inconsistent with the efficient administration of these proceedings.

For these reasons, Patent Owner respectfully requests that Petitioner's request be denied.

Best regards,

**Eric A. Zelepugas**

 **AVANTECH LAW**

**312-487-2185**

[zelepugas@avantechlaw.com](mailto:zelepugas@avantechlaw.com)

[LinkedIn](#) | [Firm Bio](#)

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**From:** Bansal, Chetan R. <[chetanbansal@paulhastings.com](mailto:chetanbansal@paulhastings.com)>

**Sent:** Tuesday, April 7, 2026 4:19 PM

**To:** [Director\\_Discretionary\\_Decision@uspto.gov](mailto:Director_Discretionary_Decision@uspto.gov) <[Director\\_Discretionary\\_Decision@uspto.gov](mailto:Director_Discretionary_Decision@uspto.gov)>; Trials <[trials@uspto.gov](mailto:trials@uspto.gov)>

**Cc:** Moskowitz (Post-Grant) <[moskowitz\\_post-grant@avantechlaw.com](mailto:moskowitz_post-grant@avantechlaw.com)>; Robert Conley <[conley@avantechlaw.com](mailto:conley@avantechlaw.com)>; PH-Medtronic-Moskowitz-IPR <[PH-Medtronic-Moskowitz-IPR@paulhastings.com](mailto:PH-Medtronic-Moskowitz-IPR@paulhastings.com)>; Eric Zelepugas <[zelepugas@avantechlaw.com](mailto:zelepugas@avantechlaw.com)>

**Subject:** IPR2026-00162

Honorable Director Squires and the Honorable Board,

The above-identified IPR was recently referred for review of the merits and non-discretionary considerations. (Paper 10.) Petitioner Medtronic seeks leave to file a 7-page reply to Patent Owner's Preliminary Response ("POPR"; Paper 9) responding to Patent Owner's various arguments, including those seeking to antedate the Pamatier prior art applied in the Petition. Good cause exists for such a reply.

At the time Medtronic filed its Petition, it was unaware of Patent Owner's contention that the '367 patent challenged claims were entitled to an earlier date than October 25, 2012, or the evidence or argument that Patent Owner submitted with the POPR in support of this contention. In its initial Response to Medtronic's interrogatory, which Patent Owner served on Medtronic *after* the Petition was filed, Patent Owner did not provide any contention that the challenged claims of the '367 patent were conceived before Pamatier's December 19, 2011 filing date. (See Ex. 1044, 12 (identifying October 25, 2012 as the priority date and stating that its investigation into conception and reduction to practice was "ongoing").) Now, with its POPR, Patent Owner submitted over thirty exhibits and fifty pages of argument contending that the named inventors conceived of the claims on May 18, 2011, and then diligently reduced to practice the challenged patent. (See POPR, 5-67.) Accordingly, good cause exists to afford Medtronic an opportunity to respond to these previously unknown contentions.

The POPR also advances unsupported allegations regarding Medtronic's positions in the district court litigation and the implications of the Director's guidance in *Revvo*, *Tesla*, and *Generac* that have nothing to do with the merits of Medtronic's Petition. (See, e.g., POPR at 69-79.) Medtronic has not received an opportunity to respond to these allegations and good cause exists for leave to file a Reply to such allegations.

Medtronic agrees to limit the Reply to seven pages and would request authorization to file the Reply within ten days after the Director or the Board grants such leave. The Reply will not include any new exhibits.

Medtronic conferred with Patent Owner regarding this request. Patent Owner indicated that it opposes Medtronic's request for leave to file a Reply.

Medtronic does not believe a conference call is necessary, but to the extent the Director or the Board would like to discuss this request, Medtronic will make itself available at the Board's convenience.

Sincerely,

Chetan Bansal

Counsel for Petitioner Medtronic

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**PAUL**  
**HASTINGS**

**Chetan Bansal | Of Counsel, Litigation Department**

Paul Hastings LLP | 2050 M Street NW, Washington, DC 20036 | Direct: +1.202.551.1948 |  
Main: +1.202.551.1700 | Fax: +1.202.551.0448 | [chetanbansal@paulhastings.com](mailto:chetanbansal@paulhastings.com) |  
[www.paulhastings.com](http://www.paulhastings.com)

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