

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,
Petitioner

v.

MOSKOWITZ FAMILY LLC,
Patent Owner.

Case IPR2026-00162
Patent No. 12,011,367

PETITIONER'S DISCRETIONARY DENIAL OPPOSITION

Table of Contents

I. INTRODUCTION1

II. MOSKOWITZ CANNOT CLAIM “SETTLED EXPECTATIONS”5

III. THE FINTIV FACTORS STRONGLY FAVOR INSTITUTION8

 A. Factor 1: Stay.....9

 B. Factor 2: The Final Decision Will Issue Nearly a Year Before
 Trial9

 C. Factor 3: The Minnesota Action Is in Its Infancy9

 D. Factor 4: The *Sotera* Stipulation Supports Institution 10

 E. Factor 5: Early FWD Supports Institution 11

 F. Factor 6: Strong Merits Support Institution 11

IV. MATERIAL ERROR BY THE OFFICE, PERPETUATED BY
MOSKOWITZ’S CONDUCT, WARRANTS REVIEW..... 12

 A. *Becton Dickinson* Factors (c) and (f) (Prior Consideration of
 Asserted Art and Additional Facts Warranting Review) 13

 B. *Becton Dickinson* Factor (e) (Examiner Error) 13

V. THE COMPLEXITY OF THE DISPUTE FAVORS INSTITUTION 18

VI. CONCLUSION.....20

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Activision Blizzard, Inc. v. Milestone Ent. LLC</i> , IPR2025-00708, Paper 11 (Director Aug. 14, 2025).....	2, 14, 17
<i>Amazon.com, Inc. v. Audio Pod IP, LLC</i> , IPR2025-00757, Paper 15 (Director Aug. 14, 2025).....	6, 7
<i>American Airlines, Inc. v. Intellectual Ventures I LLC</i> , IPR2025-00785, Paper 11 (Director Aug. 29, 2025).....	5, 18
<i>Amgen Inc. v. Bristol-Myers Squibb Co.</i> , IPR2025-00603, Paper 9 (Director July 24, 2025).....	5
<i>Apple Inc. v. Apex Beam Technologies LLC</i> , IPR2025-00896, Paper 10 (Director Sept. 3, 2025)	19
<i>Apple Inc. v. Ferid Allani</i> , IPR2025-00856, Paper 11 (Director Sept. 5, 2025)	<i>passim</i>
<i>Becton, Dickinson and Co. v. B. Braun Melsungen AG</i> , IPR2017-01586, Paper 8 (P.T.A.B. Dec. 15, 2017)	12, 13, 14
<i>Ecto World LLC v. RAI Strategic Holdings Inc.</i> , IPR2024-01280, Paper 13 (Director May 19, 2025)	1, 12, 13
<i>Google LLC v. Cellular South, Inc.</i> , IPR2025-00875, Paper 10 (Director Oct. 17, 2025).....	4
<i>Harbor Freight Tools USA Inc. et al. v. Champion Power Equipment, Inc.</i> , IPR2025-00805, Paper 20 (Director Sept. 19, 2025)	19
<i>iRhythm Technologies, Inc. v. Welch Allyn</i> , IPR2025-00363, Paper 10 (Director June 6, 2025)	12
<i>Nespresso USA, Inc. v. K-Fee System GmbH</i> , IPR2022-01574, Paper 12 (P.T.A.B. Apr. 14, 2023)	13

<i>NeuMoDx Molecular, Inc. v. HandyLab, Inc.</i> , IPR2020-01133, Paper 23 (P.T.A.B. Aug. 6, 2021).....	11
<i>Orca Security Ltd. v. Wiz, Inc.</i> , IPR2025-01083, Paper 10 (Director Oct. 17, 2025).....	3, 5
<i>Samsung Elecs. Co. v. iCashe, Inc.</i> , IPR2025-00641, Paper 12 (P.T.A.B. Aug. 14, 2025).....	6, 7
<i>Shenzhen TuoZhu Technology Co., Ltd. v. Stratasys, Inc.</i> , IPR2025-00438, Paper 10 (Director July 17, 2025).....	18, 19
<i>Sotera Wireless, Inc. v. Masimo Corp.</i> , IPR2020-01019, Paper 12 (P.T.A.B. Dec. 1, 2020)	10
<i>Tanklogix, LLC v. Sitepro, Inc.</i> , IPR2025-00647, -00648, -00649, -00650, -00651, -00652, -00653, Paper 10 (P.T.A.B. July 31, 2025).....	6
<i>Tesla, Inc. v. Intellectual Ventures II LLC</i> , IPR2025-00217, Paper 9 (Director June 13, 2025)	5, 18
<i>Western Digital Technologies, Inc. v. Godo Kaisha IP Bridge 1</i> , IPR2025-00701, Paper 9 (Director Aug. 14, 2025).....	5, 18
Statutes	
35 U.S.C. § 325(d)	3, 12, 13

LIST OF EXHIBITS

Exhibit No.	Document	Previously Submitted
Ex. 1001	U.S. Patent No. 12,011,367 to Moskowitz et al. (“the ’367 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. 12,011,367	X
Ex. 1005	RESERVED	
Ex. 1006	U.S. Patent Application Publication No. 2008/0249569 A1 to Waugh et al. (“Waugh”)	X
Ex. 1007- Ex. 1019	RESERVED	
Ex. 1020	Phulchand Prithvi Raj, <i>Intervertebral Disc: Anatomy-Physiology-Pathophysiology-Treatment</i> , 8(1) PAIN PRACT. 18 (2008)	X
Ex. 1021	Fabio Galbusera et al., <i>Ageing and degenerative changes of the intervertebral disc and their impact on spinal flexibility</i> , 23(3) EUR. SPINE J. 324 (2014)	X
Ex. 1022	Dil Patel et al., <i>Interbody options in lumbar fusion</i> , 5(1) J. SPINE SURG. S19 (2019)	X
Ex. 1023	RESERVED	
Ex. 1024	U.S. Patent No. 9,585,766 to Robinson (“Robinson”)	X
Ex. 1025- Ex. 1039	RESERVED	

Exhibit No.	Document	Previously Submitted
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.	
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. 50.	
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), https://www.uscourts.gov/sites/default/files/document/fcms_na_distprofile0630.2025.pdf	
Ex. 1046	Patent Owner’s Request for Discretionary Denial, Paper 6 (February 9, 2026), <i>Medtronic, Inc. v. Moskowitz Family LLC</i> , IPR2025-01598	
Ex. 1047	U.S. Patent No. 6,342,074 to Simpson (“Simpson”)	X
Ex. 1048- Ex. 1052	RESERVED	

Exhibit No.	Document	Previously Submitted
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
Ex. 1054- Ex. 1055	RESERVED	
Ex. 1056	File History for U.S. Patent No. 10,016,284	X
Ex. 1057	U.S. Patent No. 9,445,919 to Palmatier et al. (“Palmatier”)	X
Ex. 1058	RESERVED	
Ex. 1059	Patent Owner’s Infringement Claim Charts, Exhibit K1, <i>Moskowitz Family, LLC v. Medtronic, Inc.</i> , No. 0:25-cv-00769 (D. Mass.), served October 30, 2025.	X
Ex. 1060	Senthil Eswaran et al., <i>The micro-mechanics of cortical shell removal in the human vertebral body</i> , 31 COMPUT. METHODS APPL. MECH. ENGRG. 3025 (2007)	X
Ex. 1061	Vivek Palepu et al., <i>Biomechanics of Disc Degeneration</i> , ADV. ORTHOP (2012)	X
Ex. 1062	Kai-Uwe Lewandrowski, <i>Surgical Technique of Endoscopic Transforaminal Decompression and Fusion with a Threaded Expandable Interbody Fusion Cage and A Report of 24 Cases</i> , 7(2) J. SPINE 1 (2018)	X
Ex. 1063	Erik Emstad et al., <i>The VariLift(®) Interbody Fusion System: expandable, standalone interbody fusion</i> , 8 MED. DEVICES (AUKL.) 219 (2015)	X

Exhibit No.	Document	Previously Submitted
Ex. 1064	Gstoettner Michaela et al., <i>Footprint mismatch in lumbar total disc arthroplasty</i> , 17(11) EUR. SPINE J. 1470 (2008)	X
Ex. 1065	Thomas Steffen et al., <i>Cages: designs and concepts</i> , 9 EUR. SPINE J. S89 (2000)	X
Ex. 1066	Thomas Lowe et al., <i>A Biomechanical Study of Regional Endplate Strength and Cage Morphology as It Relates to Structural Interbody Support</i> , 29(21) SPINE 2389 (2004)	X
Ex. 1067	U.S. Patent No. 6,102,950 to Vaccaro (“Vaccaro”)	X
Ex. 1068	File History for U.S. Patent No. 10,426,633	X
Ex. 1069	RESERVED	
Ex. 1070	U.S. Patent No. 10,016,284 to Moskowitz et al. (“the ‘284 patent”)	

I. INTRODUCTION

Patent Owner Moskowitz Family LLC's ("Moskowitz") request for discretionary denial (Paper 6 ("DD Req.)) of this IPR involving U.S. Patent No. 12,011,367 ("the '367 patent") is largely premised on the same arguments it made in support of its discretionary denial request in a companion IPR involving related U.S. Patent No. 9,005,293 ("the '293 patent"). The Director considered those arguments and referred the IPR to the Board for an adjudication on the merits. *See* IPR2025-01598, Paper 9 at 2. The reasons for instituting this IPR are even stronger. The '367 patent is less than two years old, and the district court will not hold trial for at least 8 months after the anticipated final written decision date. Moreover, like in IPR2025-01598, the Office's own findings in related applications confirm that the Office erred in issuing the challenged claims.

Office Error. The Petition demonstrates that each challenged claim is unpatentable over Palmatier (Ex. 1057). (Petition, 3.) The Examiner, however, overlooked Palmatier, which was buried in a 325-reference Information Disclosure Statement ("IDS")—thirteen times the size of a typical IDS. (Ex. 1004, 133 (reference no. 186), 190 (reference no. 186).) *Ecto World LLC v. RAI Strategic Holdings Inc.*, IPR2024-01280, Paper 13 at 5 (Director May 19, 2025) (precedential). Other than the Examiner's initials on the IDS citing Palmatier, the file history of the '367 patent includes no evidence that the Examiner considered Palmatier. The

lack of consideration of Palmatier’s teachings, which are anticipatory, demonstrates that the Office erred in performing a complete and thorough review of the prior art. This oversight/error is confirmed by the Office’s own findings in a great-grand-parent application of the ’367 patent, which was examined by a *different* Examiner (Pedro Philogene), who rejected materially similar claims over Palmatier.

As explained below in Section IV.B (addressing Office error), Examiner Philogene initially rejected then-pending claims of related U.S. Patent No. 10,016,284 (“the ’284 patent”) over Palmatier, but allowed the ’284 patent claims after being persuaded that Palmatier does not disclose a “slot” in the claimed “second housing.” (Ex. 1056, 144-149, 195; DD Req., 17.) But Moskowitz admits that the ’367 patent claims do not recite a “slot.” (DD Req., 18.) Under similar circumstances, the Office has deemed Board review of the petition an “efficient use of Board resources.” *See Activision Blizzard, Inc. v. Milestone Ent. LLC*, IPR2025-00708, Paper 11, at 2-3 (Acting Chief APJ Aug. 14, 2025) (referring Petition after finding “evidence that the challenged claims omit limitations . . . of the parent patent that appear to have been the patent examiner’s reason for allowing the parent patent’s claims”).)

The same result is warranted here because the ’367 patent claims are materially broader than the ’284 patent claims and, therefore, should have been rejected based on Palmatier, as the Petition further demonstrates. (*See infra* Section

IV.B (comparing challenged claim 17 of the '367 patent and claim 1 of the '284 patent).) Indeed, Moskowitz does not identify a single limitation that is missing from Palmatier and, instead, declares that it will “dispute[]” Palmatier’s status as prior art in its POPR. (DD Req., 14.) Moskowitz’s above insinuation regarding Palmatier—whose § 102(e) date predates the alleged priority date by almost one year and whose prior art status Moskowitz did not challenge previously—further confirms that a discretionary denial under § 325(d) is inappropriate. Instead, institution is warranted to evaluate Moskowitz’s forthcoming fact intensive swear behind challenge on a full trial record.

No Settled Expectations. The '367 patent lacks settled expectations because it issued less than two years ago on June 18, 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). The settled-expectations inquiry is fundamentally about long-term reliance, and there can be no credible claim of such reliance where the patent has been in force for less than two years.

Given the recent issuance of the '367 patent, Moskowitz tries to argue settled expectations based on Medtronic’s knowledge of older patents (*e.g.*, the '293 patent) and Moskowitz’s “portfolio” since 2015. (DD Req., 4-7.) 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 in the interim (*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 given that the Director referred the ’293 patent for merits review.

Judicial Efficiency. The district court’s ready-for-trial date (February 2028) is eight 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”).

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 at 3 (Director Aug. 29, 2025) (citing *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 at 2-3 (Director June 13, 2025) (informative)) (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 less than two years ago on June 18, 2024. (Ex. 1001, Cover.) Medtronic’s early challenge to the ’367 patent thus “favor[s] robust, predictable patent rights and weigh[s] against discretionary denial.” *Orca Security Ltd.*, 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., 4-9.) *Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00603, Paper 9 at 2 (Director July 24, 2025) (informative).

Moskowitz’s reliance on a “long-standing 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) is misplaced 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 '367 patent.

Furthermore, settled expectations arising from publication of older parent patents do not 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, the Board declined review of a younger patent for efficiency reasons, not due to settled expectations. (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, no similar efficiency reasons exist because the ’293 patent was referred to the Board, and Medtronic’s challenges to nine 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 conduct” are essentially the same as those considered (and deemed unpersuasive) by the Director in IPR2025-01598. (*Compare* DD Req., 4-10 *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. 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."

Medtronic's knowledge of Moskowitz's patent portfolio since 2015 (DD Req., 5-7) is not dispositive 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 "prototype demonstrations" before the '367 patent issued, which are backed by only the conclusory allegations in Moskowitz's complaint, are unpersuasive. (DD Req., 5.) Moskowitz does not bother to explain how any of his alleged "presentations" and "prototype demonstrations" 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 relevant to the '367 patent.

III. THE FINTIV FACTORS STRONGLY FAVOR INSTITUTION

The *Fintiv* factors strongly favor institution.

A. Factor 1: Stay

Medtronic recently sought a stay of the parallel litigation. During an oral hearing on March 6, the magistrate judge denied Medtronic's stay request without prejudice but expressly noted the Court will revisit the issue if Medtronic renews the motion following a decision on institution of one or more patents at issue in this case.¹ Thus, depending on the Director's institution decisions in this and other cases, a stay is a likely possibility.

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 December 2025 (*see* Paper 3), meaning that the Board's final decision is due in June 2027. Meanwhile, the Minnesota Action is scheduled to be ready for trial eight 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 eight 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

¹ A formal transcript of the hearing is unavailable. Medtronic is willing to submit the transcript once it is available, if the Director deems it will be helpful.

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. Although Moskowitz engages in a blaming exercise relative to the new district court schedule (DD Req., 11), extensions to the schedule were necessitated by Moskowitz’s eleventh-hour addition of a new patent 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). Moskowitz’s speculation about system prior art that might be asserted in the future and its citation to comments in the now “superseded” interim FAQs cannot override this central

consideration from the precedential *Sotera* decision.

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 a single ground challenging 8, 9, 13, and 17-21 of the '367 patent. The Petition supports that ground with a detailed analysis and an expert declaration. (Ex. 1002.) Patent Owner agrees that Palmatier qualifies as prior art under § 102(e), based on Palmatier's December 19, 2011 filing date, and that the '367 patent claims priority to at least October 25, 2012. Patent Owner has not submitted *any* evidence of conception and diligent reduction to practice to overcome Palmatier as prior art. Instead, Patent Owner merely asserts that it "will elaborate more fully" in a forthcoming response. (DD Req., 14.) Such speculation about an alleged future evidentiary showing does not support discretionary denial.

Moskowitz contends that Petitioner's analysis "relies heavily on expert testimony." (DD Req., 15-16.) But Moskowitz fails to identify a single limitation for which Medtronic only relied on expert testimony. Instead, Moskowitz simply highlights the number of citations and length of Culbert's declaration. (*Id.*, 15.) This

reasoning conflates thoroughness with deficiency and cannot serve as a basis for discretionary denial because “Patent Owner does not identify *any portions* of the expert testimony that suggest Petitioner is using its expert to fill gaps in the prior art.” *iRhythm Technologies, Inc. v. Welch Allyn*, IPR2025-00363, Paper No. 10 at 2-3 (June 6, 2025) (emphasis added.) Medtronic’s expert testimony serves as an aid to the Board, especially on issues like motivation to modify and reasonable expectation of success. (See, e.g., Ex. 1002, ¶¶52-56.) Medtronic’s expert testimony thus complies with Office precedent. See *iRhythm Technologies, Inc.*, IPR2025-00363, Paper No. 10 at 2-3.

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

The Examiner allowed the claims of the ’367 patent despite the presence of anticipatory prior art (Palmatier) in the file history. This is the type of error that warrants institution on the merits notwithstanding § 325(d). *Ecto World*, 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 as to Section III.C.5, first paragraph)). As explained below, Palmatier (Ex. 1057) was not applied in a rejection, was buried in a 325-reference IDS, and discloses *every* limitation of the challenged claims.

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

The Examiner never relied on *Palmatier* to reject the claims. Nor does the prosecution history of the '367 patent include any commentary regarding *Palmatier* suggesting that the Examiner carefully evaluated it. These facts support material error under *Becton Dickinson* factor (c) 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. *Becton Dickinson* factor (f) also supports a finding of material error because the IDS citing *Palmatier* included 325 references, which is thirteen times the size of a typical IDS. (Ex. 1004, 127-139.) *Ecto World*, Paper 13 at 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. *Ecto World*, Paper 13 at 6-7. These facts demonstrate that “denial under § 325(d) is not warranted.” *Ecto World*, Paper 13 at 7; *see also Nespresso USA, Inc. v. K-Fee System GmbH*, IPR2022-01574, Paper 12 at 50-52 (Apr. 14, 2023) (declining to exercise discretion where asserted art was cited in voluminous IDS and not relied upon by Examiner during prosecution).

B. *Becton Dickinson* Factor (e) (Examiner Error)

The '367 patent Examiner's failure to evaluate *Palmatier*'s teachings supports a finding of Examiner error under *Becton Dickinson* factor (e) because the Petition

demonstrates how Palmatier discloses each claim limitation—a fact Moskowitz does not dispute. This error is confirmed by the Office’s own findings during prosecution of the great-grand parent ’284 patent.

During prosecution of the ’284 patent, the Office initially rejected claims that are materially similar to the challenged claims of the ’367 patent over Palmatier and later allowed them due to the recitation of a “slot limitation.” (Ex. 1056, 144-149, 195.) But the “slot” limitation is absent from the challenged ’367 patent claims. (DD Req., 18 (admitting that the “slot” limitation “does not appear in the claims of the ’367 patent”).) This omission warrants institution. *See Activision Blizzard* at 2-3 (Acting Chief APJ Aug. 14, 2025) (referring Petitions after finding “evidence that the challenged claims omit limitations added during prosecution of the parent patent that appear to have been the patent examiner’s reason for allowing the parent patent’s claims”).²)

² Office error is a repeating theme across Moskowitz’s patent family. Even in the ’284 patent, Examiner Philogene outright missed that the claimed “slot” is disclosed by Palmatier in a different embodiment, which anticipates the claims. This error is the subject of Medtronic’s challenge to the ’284 patent in IPR2026-00216 and to U.S. Patent No. 10,426,633 in IPR2026-00217.

The omission of the “slot” limitation is significant because, as shown by the below side-by-side comparison of claim 17 of the ’367 patent and claim 1 of the ’284 patent, virtually all limitations of claim 17 are present in claim 1 of the ’284 patent. Aside from non-substantive changes in terminology (*e.g.*, “housing” vs. “body”) and a minor add-on limitation that is undisputedly in Palmatier, the ’367 patent claims are merely broader versions of the ’284 patent claims that Examiner Philogene *correctly* rejected over Palmatier. The Office’s findings in the ’284 patent thus apply equally to the ’367 patent claims (which do not recite a “slot”) and confirm that Palmatier discloses all limitations of the challenged claims of the ’367 patent.

'367 Patent--Claim 17	'284 Patent--Claim 1
<p>An expandable intervertebral device comprising:</p> <p>a first body extending from a first end to a second end, wherein the first body has first and second end portions positioned at the first and second ends, respectively, and has first and second side portions extending between the first and second end portions; wherein the first body has a first vertebral body engagement surface having a first plurality of ridges formed therein and has a first interior surface positioned on an opposite side of the first body than the first vertebral body engagement surface;</p> <p>a second body extending from a third end to a fourth end, wherein the second body has third and fourth end portions positioned at the third and fourth ends, respectively, and has third and fourth side portions extending between the third and fourth end portions; wherein the second body has a second vertebral body engagement surface having a second plurality of ridges formed therein and has a second interior surface positioned on an opposite side of the second body than the second vertebral body engagement surface; wherein the first body is aligned with the second body such that the first end of the first body is axially aligned with the third end of the second body and the second end of the first body is axially aligned with the fourth end of the second body, wherein the first end portion of the first body and the third end portion of the second body are hingedly interconnected such that the first body can pivot with respect to the second body so as to move the second end portion of the first body away from the fourth end portion of the second body; and</p> <p>a wedge extending from a fifth end to a sixth end and having an angled wedge surface extending along at least a portion of a distance between the fifth end and the sixth end, wherein the wedge is positioned between the first body and the second body with the angled wedge surface facing the first interior surface of the first body, wherein the first interior surface of the first body has an angled housing surface shaped to engage the angled wedge surface of the wedge, wherein the wedge is configured to slide within a space defined by the first body and second body in a direction toward the second and fourth ends of the first body and second body from a first wedge position that allows the first body and second body to pivot to a position that is substantially closed to a second wedge position whereby the angled wedge surface presses against the first interior surface of the first body to hingedly open the first body with respect to the second body whereby the wedge remains axially confined within the space defined by the first body and second body in the first and second wedge positions.</p>	<p>An expandable interbody device comprising:</p> <p>a first housing extending from a first end to a second end, wherein the first housing has first and second end portions positioned at the first and second ends, respectively, and has first and second side portions extending between the first and second end portions; wherein the first housing has a first vertebral body engagement surface and has a first interior surface positioned on an opposite side of the first housing than the first vertebral body engagement surface;</p> <p>a second housing extending from a third end to a fourth end, wherein the second housing has third and fourth end portions positioned at the third and fourth ends, respectively, and has third and fourth side portions extending between the third and fourth end portions; wherein the second housing has a second vertebral body engagement surface and has a second interior surface positioned on an opposite side of the second housing than the second vertebral body engagement surface, wherein the first housing is aligned with the second housing such that the first end of the first housing is axially aligned with the third end of the second housing and the second end of the first housing is axially aligned with the fourth end of the second housing, wherein the first end portion of the first housing is hingedly connected to the third end portion of the second housing such that the first housing can pivot with respect to the second housing so as to move the second end portion of the first housing away from the fourth end portion of the second housing; wherein the second housing defines a slot in the fourth end portion between the third and fourth side portions that is sized to receive the second end portion of the first housing such that the second end of the first housing and the fourth end of the second housing are axially aligned;</p> <p>a wedge extending from a fifth end to a sixth end and having an angled wedge surface extending along at least a portion of a distance between the fifth end and the sixth end, wherein the wedge is positioned between the first housing and the second housing with the angled wedge surface facing the first interior surface of the first housing, wherein the first interior surface of the first housing has an angled housing surface shaped to engage the angled wedge surface of the wedge, wherein a distance from the fifth end to the sixth end of the wedge is less than a distance from the first end to the second end of the first housing and is less than a distance from the third end to the fourth end of the second housing, wherein the wedge is configured to slide within a space defined by the first and second housings in a direction toward the second and fourth ends of the first and second housings from a first wedge position that allows the first and second housings to pivot to a housing position that is substantially closed to a second wedge position whereby the angled wedge surface presses against the first interior surface of the first housing to hingedly open the first housing with respect to the second housing whereby the wedge remains axially confined within the space defined by the first and second housings in the first and second wedge positions; and</p> <p>a rotation screw operably connected to the wedge and to the second housing, wherein rotation of the rotation screw moves the wedge in an axially translating direction with respect to the first housing and the second housing within the space defined by the first and second housings from the first wedge position to the second wedge position.</p>

(Ex. 1001, 17:33-18:26 (left) (annotated); Ex. 1070, 14:43-15:47 (right))

(annotated);³)

The Office's prior findings during the '284 patent prosecution thus confirm that the '367 patent Examiner's failure in evaluating and applying *Palmatier* against the claims warrants reconsideration of the '367 patent grant. *See Western Digital Technologies, Inc. v. Godo Kaisha IP Bridge 1*, IPR2025-00701, Paper 9 (Director Aug. 14, 2025) (finding "material error by the Office" based on the Office's findings in related applications). Indeed, this is not a situation where Medtronic is merely "disagreeing with the examiner's judgment." (*Contra* DD Req., 17.) Instead, as in *Activision Blizzard*, Medtronic is requesting the Office revisit its patent grant in view of Moskowitz's broadening of the claims in the child '367 patent and the Examiner's

³ Although claim 17 of the '367 patent also recites "a [first/second] plurality of ridges" on the "[first/second] vertebral body engagement surface," this limitation is undeniably present in *Palmatier*. During prosecution of the '284 patent, the Office found that *Palmatier*'s "first housing has a first vertebral body engagement surface (552)" and "the second housing has a second vertebral body engagement surface (578)." (Ex. 1056, 146.) *Palmatier* explicitly states that endplate surfaces 552 and 578 "include[] a plurality of raised elements [554/580] configured to enhance fixation and/or gripping with vertebral tissue." (Ex. 1057, 15:26-29, 15:57-60.)

failure to adequately evaluate the broadened claims in view of Palmatier. Institution is further warranted because the Examiner's failure appears to have been perpetuated by Moskowitz's burying of Palmatier in a voluminous IDS without providing any explanation to the Examiner regarding the reference's relevance.

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 the *Tesla* decision recently designated as informative, the Office referred petitions where the parallel litigation involved 11 patents, citing “[t]he large number and vast scope of the patents asserted in the district court litigation” as weighing against discretionary denial. *Tesla, Inc.*, IPR2025-00217, Paper 9 at 2-3. Notably, in *Tesla*, the complexity of the case overrode concerns the trial date preceding the FWD, a significant *Fintiv* factor which is not even present here. The Office similarly referred petitions where the parallel litigation involved 12 patents asserted against multiple parties across multiple jurisdictions, finding the Board was “better suited” to review such a large portfolio. *American Airlines, Inc.*, IPR2025-00785, Paper 11 at 3. The Office also referred petitions in other cases with similarly complex disputes. *Shenzhen Tuozhu Technology Co., Ltd. v. Stratasys, Inc.*, IPR2025-00438, Paper 10 (Director July 17, 2025) (denying request for discretionary denial where the parallel litigation involved 9 patents and specifically

noting that “the large number and vast scope of the patents . . . weighs against discretionary denial.”); *Harbor Freight Tools USA Inc. et al. v. Champion Power Equipment, Inc.*, IPR2025-00805, Paper 20 (Director Sept. 19, 2025) (referring petitions where the parallel litigation involved 13 patents asserted against multiple parties across multiple jurisdictions, finding that resolving the dispute at the Office “would be more efficient”); *Apple Inc. v. Apex Beam Technologies LLC*, IPR2025-00896, Paper 10 (Director Sept. 3, 2025) (referring petitions where the parallel litigation involved 17 patents, again confirming the Board’s role in managing high-volume patent validity challenges). Institution is similarly warranted here.

Here, the parallel litigation involves 12 patents, with the twelfth patent formally added by Moskowitz a month ago. (Ex. 1043, ¶¶22, 34, 304-305.) Notwithstanding 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 unsupported premise that “[r]eviewing a newer family member [*i.e.*, the ’367 patent] *in isolation* would not streamline the dispute.” (DD Req., 8 (emphasis added).) But the Director has already referred the older ’293 patent to the Board, and Medtronic’s other nine 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 8, 9, 13, and 17-21.

Respectfully submitted,

Dated: March 9, 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 March 9, 2026:

Eric A. Zelepugas (zelepugas@avantechlaw.com)
Robert A. Conley (conley@avantechlaw.com)

moskowitz_post-grant@avantechlaw.com

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