UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,
Petitioner

v.

MOSKOWITZ FAMILY LLC,
Patent Owner

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

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
2001	Pretrial Scheduling Order, *Moskowitz Family LLC v. Medtronic, Inc. et. al.,* 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, *Moskowitz Family LLC v. Medtronic, Inc. et. al.,* 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, *Moskowitz Family LLC v. Medtronic, Inc. et. al.,* No. 0:25-CV-00769-PJS-DLM, ECF No. 24 (Dist. Of Minn. May 22, 2025)
2004	First Amended Complaint, *Moskowitz Family LLC v. Medtronic, Inc. et. al.,* 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, *Moskowitz Family LLC v. Medtronic, Inc. et. al*., 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 recission 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, *Moskowitz Family LLC v. Zimvie Inc.,* No. 1:22-cv-01632-UNA, ECF No. 1 (D. Del. December 23, 2022)
2010	Information Disclosure Statement citing earlier publication (U.S. Pat. App. Pub. No. 2020/0138591) of '797 Patent (parent of the '367 patent) in Medtronic U.S. Patent Application No. 17/246,968 (May 3, 2021)
2011	Information Disclosure Statement citing '293 patent (great-great-great-great-grandparent of the '367 patent) in Medtronic U.S. Patent Application No. 17/246,968 (May 3, 2021)
2012	Notice of References Cited in Notice of Allowance citing earlier publication (U.S. Pat. App. Pub. No. 2008/0033440) of '903 patent (great-great-great-great-great-grandparent of the '367 patent) in Medtronic U.S. Patent Application No. 13/440,241 (September 3, 2015)
2013	Patent Trial And Appeal Board Standard Operating Procedure 1 (Revision 16) Assignment Of Judges To Panels
2014	*Intentionally Left Blank*
2015	*Intentionally Left Blank*
2016	Amended Pretrial Scheduling Order, *Moskowitz Family LLC v. Medtronic, Inc. et. al*., No. 0:25-CV-00769-PJS-DLM, ECF No. 44 (Dist. Of Minn. January 20, 2026)
2017	Complaint, *Moskowitz Family LLC v. Globus Medical, Inc.,* No. 6:19-cv-00672, ECF No. 1 (W.D. Tex. November 20, 20192)

2018	Second Amended Complaint, *Moskowitz Family LLC v. Medtronic, Inc. et. al*., No. 0:25-CV-00769-PJS-DLM, ECF No. 48 (Dist. Of Minn. January 29, 2026)
2019	Complaint, *Moskowitz Family LLC v. Medtronic, Inc. et al.,* 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	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

This Petition should be denied because it would fragment—rather than streamline—the adjudication of a long-standing patent family that the district court is already positioned to resolve in full. Petitioner asks the Board to review a single continuation patent drawn from a mature, well-known family, even though the district court is adjudicating eleven other related family members and will do so regardless of what happens here. Board review of one continuation cannot meaningfully simplify that dispute; it would only duplicate work already underway in another forum and risk inconsistent outcomes.

That inefficiency is the predictable result of Petitioner's decision to pursue Board review in a staggered, piecemeal fashion. Rather than seeking coordinated review, Petitioner has filed serial petitions over several months, challenging only some family members at a time while leaving the district court to adjudicate all twelve asserted Moskowitz patents as a whole—ensuring parallel proceedings with no realistic path to simplification despite Petitioner's long-standing, detailed notice of the inventions and their prosecution. That filing strategy also conflicts with the Board's own efficiency objectives, requiring multiple panels to independently become familiar with the same technology, priority history, and family-wide issues and imposing unnecessary administrative burdens without corresponding benefit.

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 public, family-wide enforcement—followed by fragmented requests for Board review of individual family members while the district court adjudicates the family in its entirety. Director precedent therefore makes clear that discretionary denial is appropriate.

Nor do the Petition's merits justify that duplication. The Petition relies exclusively on a single reference whose status as prior art is materially disputed and whose application requires expert-driven reconstruction of disclosures already examined during prosecution of related patents. That is not the type of clean, self-contained merits case that warrants Board intervention, particularly where the Office has already considered the same reference.

Where, as here, the district court will adjudicate the patent family regardless, and Board review of a single continuation—pursued through a staggered filing strategy—offers no realistic path to simplification, discretionary denial 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 meets 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 resolve the same validity issues, making Board review 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 or hinder efficient dispute resolution in the presence of parallel litigation, including 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 limited to the *Fintiv* factors. Separate and independent considerations—including the parties' settled expectations and "other considerations bearing on the Director's discretion"—may independently warrant denial. Director's March 26, 2025 Memorandum, *Interim Processes for PTAB Workload Management*, at 2-3. Recent decisions confirm that long-standing notice and the posture in which Board review is sought—particularly where review is pursued only after related patents are already being adjudicated in district court—may independently warrant discretionary denial,

even where some Fintiv considerations might otherwise favor review. *Dabico Airport Solutions Inc. v. AXA Power APS*, IPR2025-00408, Paper 21 at 3 (Acting Director Stewart June 18, 2025); *iRhythm Techs., Inc. v. CardioNet, LLC*, IPR2025-00363, Paper 10 at 3 (Acting Director Stewart June 6, 2025).

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 most heavily against institution where a challenged patent issues as part of a mature, well-known patent family and the petitioner—despite long-standing notice—seeks Board review only after district-court adjudication of related family members is already underway. In that posture, Director precedent recognizes that Board review of an individual continuation adds little value and risks inefficient, piecemeal adjudication. *E.g.*, *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).

That is exactly the posture here. The '367 patent issued as part of a long-running patent family that Petitioner knew well years 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 '367 patent,

observed enforcement of the family against competitors, and nevertheless sought Board review only after litigation was underway.

1. Petitioner Had Long-Standing, Detailed Familiarity with the Moskowitz Patent Family.

Petitioner's familiarity with the Moskowitz inventions long predates the issuance of the '367 patent. For nearly two decades, Petitioner had detailed, direct notice of the technology underlying the asserted patent family and of the applications that later matured into the '367 patent. That record of notice is extensive, undisputed, and central to the settled-expectations analysis.

From 2005 through 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 '367 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 '367 patent. Ex. 2020-2022; 2004 ¶ 45. Petitioner acknowledged receipt, stated that it was "working [its] way through" the

portfolio, and undertook internal review. Ex. 2004 ¶¶ 46-47. From that point forward, Petitioner indisputably understood both the scope of the Moskowitz patent family and its potential relevance to Petitioner's products and business.

Petitioner's subsequent conduct confirms that understanding. Petitioner and its affiliates repeatedly cited members of the Moskowitz patent family in Information Disclosure Statements across their own patent portfolios, reflecting sustained monitoring of the family's prosecution and scope. At the same time, Patent Owner publicly enforced the Moskowitz patents against other industry participants, resulting in contested district-court litigation and post-grant proceedings. Exs. 2009; 2017. This was not a dormant or obscure portfolio; it was a mature, actively enforced patent family well known to Petitioner.

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.

For years, Medtronic repeatedly encountered the '367 patent and its family in the ordinary course of its business and prosecution activity. Petitioner and its subsidiaries cited the '367 patent and related family members dozens of times in IDS filings across their own portfolios. 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; Ex. 2010 at 12 (citing publication of parent ’797 patent); Ex. 2011 at 10 (citing great-great-great-great-grandparent ’293 patent); Ex. 2012 at 13 (citing publication of great-great-great-great-great-grandparent ’903 patent). This was not incidental exposure. It was sustained monitoring.

That record is incompatible with any claim of surprise or reliance. When Patent Owner provided portfolio notice in 2015, the ’367 patent had not yet issued, no infringement was alleged, and no accused products existed. But enforcement of the family was foreseeable, and Petitioner continued to track and cite the portfolio while developing products in a space shaped by a known and actively prosecuted patent family. 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.

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. The question is not whether the overall litigation is complex, but whether Board review of this patent would meaningfully simplify what the district court must decide. It would not.

The ’367 patent traces its lineage through a common disclosure to U.S. Patent No. 7,704,279 and shares its technical core with numerous asserted family members, 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; 11,864,755; and 12,491,088. Several of these ancestor patents have been in force for many years, giving rise to substantial settled expectations—especially 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 cases involving unrelated portfolios or where all asserted patents were subject to corresponding IPRs. Here, 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 Board action. 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. In these circumstances, the Board cannot be “better suited” to resolve the controversy. Reviewing a newer family member in isolation would not streamline the dispute; it would fracture it. 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.

B. *Fintiv* 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 a year, yet Petitioner has taken no steps to pause the proceedings in favor of Board review.

A stay would also be impractical. The district-court action involves twelve asserted patents. Ex. 2018, ¶ 22. This Petition challenges only eight claims of a single patent; many asserted patents—including close family members—are not 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 direct 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. 2023 at 3; *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. *Fintiv* Factors 2 and 3 Favor Denial Because the District Court Action Is Advancing and Investment Is Irreversible.

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. Ex. 2019. By the time the Director decides whether to institute in June 2026, the district court will already be on a path to adjudicate infringement and validity issues across the asserted patent family, with infringement and invalidity contentions exchanged and discovery underway. Claim-construction is scheduled to begin shortly thereafter under the parties' stipulated schedule and will proceed regardless of any IPR. Ex. 2001.

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 raised in this Petition—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. *Fintiv* 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 substantially overlap with those that will be litigated in the district court—and institution would not meaningfully simplify the parallel proceedings. Where the Board's review would address only a subset of issues while leaving substantial invalidity 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 asserted family members in the district court action. Nothing prevents Petitioner from asserting the same art against the other family members in the district court. In that posture, 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 *Sotera* stipulation was offered. *See 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. *Fintiv* 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*, 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. *Fintiv* Factor 6 Favors Denial Because the Petition Does Not Present Compelling Merits.

Factor 6 also favors discretionary denial because the Petition does not present compelling merits. The Director does not require a full merits analysis at this stage; rather, the inquiry is whether the Petition's merits are sufficiently compelling to outweigh the strong discretionary considerations favoring denial. *Fintiv*, Paper 15 at 15. Even a petition with facial plausibility may be denied where efficiency and duplication concerns predominate. *Samsung Elecs. Co., Ltd. v. SiOnyx, LLC*, IPR2025-00065, Paper 16 at 19–20 (PTAB June 6, 2025).

Petitioner's merits rise and fall with Palmatier qualifying as prior art. As Patent Owner will elaborate more fully in its forthcoming POPR, Patent Owner disputes Palmatier's qualification as prior art. Palmatier qualifies as prior art under § 102(e), based on its December 19, 2011 effective date, and Petitioner acknowledges that the '367 Patent claims priority to at least October 25, 2012 (Pet. at 4). Palmatier may therefore be disqualified by a showing of conception and diligent reduction to practice from at least December 18, 2011—raising a threshold factual dispute that must be resolved before the Board could reach the grounds.

That dispute is not confined to the '367 patent. *See e.g., Medtronic, Inc. v. Moskowitz Family LLC,* IPR2026-00216, Paper 1 at 3-4; *Medtronic, Inc. v. Moskowitz Family LLC*, IPR2026-00217, Paper 1 at 3-4. Because Palmatier's § 102(e) status turns on the same underlying inventive activity that spans several

asserted Moskowitz patents, any swearing-behind analysis would require overlapping fact development concerning conception and diligence that bears on multiple asserted patents already being litigated in district court. Institution here would therefore not simplify the merits inquiry; it would inject a complex, family-wide priority dispute into parallel proceedings that could risk inconsistent results.

Petitioner's filing posture further underscores the absence of compelling merits. Petitioner has advanced the same Palmatier-based prior-art theory across multiple petitions challenging closely related Moskowitz patents, filed in a staggered sequence over several months. The Board's Standard Operating Procedure recognizes that, where practicable, related AIA proceedings involving the same patent owner and related subject matter should be assigned to the fewest total judges to promote efficiency and consistency. Ex. 2013 at 12. Here, institution would require multiple panels to independently grapple with the same disputed prior-art status, priority record, and technical background—an additional inefficiency that weighs against discretionary review in the absence of compelling merits.

The Petition also relies heavily on expert testimony. The Petition cites the Culbert declaration more than fifty times; the declaration spans seventy pages, including extensive claim charts. Such reliance underscores that Palmatier does not clearly disclose the asserted limitations and that the validity inquiry will turn on competing expert analysis, which the Office has determined is best assessed through

live expert testimony in district court. Ex. 2008 at Q.22 (explaining that "extensive reliance on expert testimony . . . may suggest that the questions are better resolved in an Article III court," and that "the failure to provide focused expert testimony may weigh against institution"); Ex 2006 (retiring PTAB's April 25, 2025 FAQs (Ex. 2008) as part of the formalization of the new interim Director discretionary process but confirming that "the extent of the petition's reliance on expert testimony" remains a relevant consideration).

This is not a case where strong merits overcome the substantial discretionary considerations favoring denial. Because the Petition depends on a disputed prior-art theory, implicates overlapping family-wide factual issues, and would require duplicative expert-driven analysis, Fintiv Factor 6 favors discretionary 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 a single prior art reference—Palmatier (Ex. 1057)—whose teachings were repeatedly presented to, considered by, and applied by the Patent Office during prosecution of the Moskowitz patent family. Allowing institution would require the Board to revisit the same reference and substantially the same disclosures already evaluated by the Office, without any showing of material error. Section 325(d) exists to prevent precisely that result.

Palmatier was not merely cited in passing. It was substantively addressed during prosecution of the ’367 patent’s great grandparent, U.S. Patent No. 10,016,284. Ex. 1056 at 146-148. During that examination, Palmatier was expressly discussed between Patent Owner’s representative and the examiner and addressed in Patent Owner’s response. *Id.* at 182-184, 195. Palmatier was later submitted to, and considered by, the examiner during prosecution of the ’367 patent itself. Ex. 1004, 133, 190. Petitioner does not dispute this record. Pet. at 4.

That history readily satisfies the first prong of *Advanced Bionics*. *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7–8 (PTAB Feb. 13, 2020). Because the asserted art was previously before the Office, Petitioner bears the burden under the second prong to demonstrate a material error apparent from the prosecution record. That burden is demanding. It is not met by re-arguing the same reference, advancing a different narrative, or disagreeing with the examiner’s judgment. *Id.* at 8–9; *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017).

Petitioner cannot make that showing. Although Petitioner emphasizes that Palmatier formed the basis of an anticipation rejection in the great grandparent of the ’367 patent—which Petitioner characterizes as having “nearly identical independent claims,” Pet. at 15—Petitioner’s material error theory does not rest on similarities between those claims and the claims of the ’367 patent. It rests on

differences. That framing is fatal under *Advanced Bionics*, which asks whether the Office committed a material error in assessing the patentability of the challenged claims—not whether different claims in related applications were treated differently.

In particular, Petitioner's primary criticism focuses on a "slot" limitation that appears in the claims of the '284 patent but does not appear in the claims of the '367 patent. Pet. at 15 (arguing that "the Examiner failed to appreciate that the claimed slot appeared in the embodiment of Palmatier discussed with respect to Figures 22–26"). Whether Palmatier discloses the slot claimed in the '284 patent has no bearing on whether the Office materially erred in evaluating the patentability of claims that do not recite that limitation. Recasting the prosecution record around an element absent from the challenged claims does not establish material error.

Petitioner repeats the same flaw when pointing to prosecution of the '367 patent's grandparent, U.S. Patent No. 10,426,633—again focusing on a claimed "slot" not present in the '367 claims and criticizing the Office for relying on Vaccaro rather than Palmatier. Pet. at 16. Even accepting Petitioner's characterization for argument's sake, Petitioner does not assert a Vaccaro–Palmatier combination here, rendering the alleged error irrelevant to the patentability of the challenged claims.

The prosecution record does not reflect that the examiner mischaracterized Palmatier, applied an incorrect legal standard, made contradictory factual findings, or overlooked any disclosure relevant to the claims at issue. The examiner did not

rely on Palmatier because it had already been considered, applied, and found inapplicable in light of the claims being examined. Petitioner's disagreement with that outcome—and its attempt to reframe the same reference under a different narrative—does not amount to material error as a matter of law.

Granting institution here would also require the Board to expend additional resources re-evaluating a reference already analyzed during prosecution of this patent family, notwithstanding the Board's guidance favoring efficient, coordinated treatment of related proceedings where practicable. Section 325(d) is designed to prevent that redundancy. Discretionary denial is therefore warranted.

IV. CONCLUSION

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

Date: February 9, 2026

Respectfully submitted,

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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 2001-2013, 2016-2023) were served electronically via e-mail on February 9, 2026, in their entireties on the following counsel of record for Petitioner:

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