UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,
Petitioner

v.

MOSKOWITZ FAMILY LLC,
Patent Owner

Case No. IPR2025-01598
Patent No. 9,005,293

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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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	Scheduling Order, *Moskowitz Family, LLC v. NuVasive, LLC et. al.,* No. 1:25-CV-00711-WCB, ECF No. 17 (D. Del. October 20, 2025) (Bryson, W.)
2005	Email from Chetan R. Bansal, Counsel for Medtronic to Eric Zelepugas, Counsel for Moskowitz Family LLC, dated December 2, 2025
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 Messerli to Examiner Philogene in co-pending sibling U.S. Patent Application No. 13/084,543 (April 18, 2012)
2011	Information Disclosure Statement citing Byrd to Examiner Philogene in co-pending sibling U.S. Patent Application No. 13/084,543 (May 4, 2012)
2012	Information Disclosure Statement citing Messerli and Byrd to Examiner Philogene again in co-pending child U.S. Patent Application No. 13/741,361 (April 18, 2012)
2013	Office Action citing Waugh by Examiner Philogene in related U.S. Patent Application No. 13/401,829 (July 16, 2013)
2014	Office Action citing Waugh by Examiner Philogene in related U.S. Patent Application No. 13/418,323 (December 30, 2013)
2015	Office Action citing Waugh by Examiner Philogene in related U.S. Patent Application No. 13/418,335 (September 9, 2013)
2016	Office Action citing earlier publication of ’293 patent in U.S. Patent Application No. 14/494,381 (September 17, 2015)
2017	Complaint, *Moskowitz Family LLC v. Globus Medical, Inc.,* No. 6:19-cv-00672, ECF No. 1 (W.D. Tex. November 20, 20192)
2018	Complaint, *Moskowitz Family, LLC v. NuVasive, LLC et. al.,* No. 1:25-CV-00711-WCB, ECF No. 1 (D. Del. June 6, 2025)
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	Letter from Michael Fink, Counsel for Nathan Moskowitz to Peter Ullrich, Chief Executive Officer for Titan Spine, dated July 27, 2015
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.)
2025	Information Disclosure Statement citing U.S. Patent No. 9,005,293 in Patent App. No. 16/282,661 (July 19, 2019)
2026	Information Disclosure Statement citing U.S. Patent No. 9,005,293 in Patent App. No. 17/590,529 (Feb. 1, 2022)
2027	Information Disclosure Statement citing U.S. Patent No. 9,005,293 in Patent App. No. 29/783,700 (May 14, 2021)

I. INTRODUCTION

The Director should deny institution because this Petition comes a decade too late, seeks review of only one claim, and offers no path to simplifying the two district court actions that are already well underway.

For over ten years, Petitioner knew of Patent Owner's inventions and the patent family covering them. This knowledge existed long before the '293 patent issued. From 2005 through 2015, Patent Owner repeatedly presented his spinal-fusion innovations to Petitioner's engineers, business leadership, and counsel—including the very applications and figures that later issued as the '293 patent in 2015. Shortly after issuance, Petitioner received formal notice identifying the '293 patent, attaching the patent itself, and listing the related patents and applications in the portfolio. Petitioner acknowledged that it was "working [its] way through" the portfolio yet chose not to challenge any patent in the family for the next ten years. Under the Director's guidance, such long-standing notice creates strong settled expectations that weigh heavily against institution. And Patent Owner's consistent enforcement of this portfolio against several of Petitioner's closest competitors leaves no basis for Petitioner to claim an expectation of non-enforcement.

Institution would also be inefficient. Petitioner challenges a single claim while Patent Owner asserts multiple other claims of the same patent—claims that will require the district court to litigate the same patent, accused products, invalidity

theories, and claim-construction disputes, regardless of what happens here. And two federal courts are already moving forward: a Minnesota action involving eleven asserted patents, and a Delaware action set for trial two months before this proceeding would generate a final written decision.

The Petition's merits do not overcome these problems. It raises insinuations about prosecution conduct and written-description defects—grounds that are not permitted in an inter partes review. And those insinuations are baseless; the same examiner reviewed the same references in multiple related Patent Owner applications years before the '293 patent issued. The art was never hidden. The Petition's narrative is unsupported.

The goals of § 314 are not served by granting the Petition. It does not simplify the parallel actions, it does not resolve any dispute that the courts must otherwise decide, and it arrives after a decade of inaction despite long-standing, detailed notice. 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 decide 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 principle has warranted denials where parallel litigation will address the

same issues. *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019).

Over time, the Office has identified a set of practical considerations—commonly referred to as the *Fintiv* factors—to help determine whether an IPR would advance or hinder efficient dispute resolution:

1. Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. The proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. Investment in the parallel proceeding by the court and the parties;
4. Overlap between issues raised in the Petition and the parallel proceeding;
5. Whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. Other circumstances that impact the Board's exercise of 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 identifies additional considerations—separate from the *Fintiv* factors—that apply here: the parties' settled expectations—including "the length of time the claims have been in force"—and "any other considerations bearing on the Director's discretion." Director's March 26, 2025 Memorandum, *Interim Processes for PTAB Workload Management*, at 2-3. Decisions applying settled expectations show that long-standing notice and late-filed petitions weigh

strongly against institution even when some *Fintiv* factors favor institution. *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); *Toyota Motor Corp. v. AutoConnect Holdings LLC*, IPR2025-00890, Paper 9 at 3 (Acting Director Stewart Sept. 19, 2025).

Applied here, these considerations all point in the same direction. Petitioner had deep knowledge of Patent Owner's inventions long before the '293 patent issued, waited ten years to seek review after issuance, and now challenges only one claim while two district-court actions—one of which will reach trial before any final written decision—are already addressing the same technical issues. Under § 314(a), this is not a case where an IPR would promote efficiency or fairness. It is a case where discretionary denial is warranted.

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

The Director's recent decisions place significant weight on the parties' settled expectations. A decade-old patent, longstanding notice, and petitioner delay create circumstances in which settled expectations weigh strongly against institution. *Dabico*, at 3; *iRhythm*, at 3; *Toyota*, at 3. Although there is no bright-line rule, the Office has held that "the longer the patent has been in force, the more settled expectations should be." *Dabico*, at 2-3; *Samsung Electronics Co., Ltd. Et al v.*

W&Wsens Devices Inc., IPR2025-00995, 00996, Paper 17 at 2 (October 17, 2025). Patents that have been in force for more than ten years create ***strong*** settled expectations. *Samsung Electronics Co., Ltd. v. Sinotechnix LLC*, IPR2025-00331, Paper 13 at 2 (PTAB July 2, 2025); *Kingston Tech. Co., Inc. v. Vervain, LLC*, IPR2025-00614, Paper 12 at 2 (Acting Director Stewart July 16, 2025). These expectations arise not only because of the passage of time but also because "issued patents are almost always publicly available to provide notice to the public, other inventors, competitors, and commercial interests." *Dabico*, at 3.

Here, the '293 patent issued over a decade ago. Standing alone, this period weighs heavily in favor of discretionary denial. The settled-expectations analysis could end there. But Patent Owner's settled expectations are even stronger here because Petitioner had deep, continuous notice of Patent Owner's inventions beginning years before the '293 patent issued, followed by formal notice of the '293 patent in 2015, followed by Petitioner inaction for ten years.

1. Petitioner's notice began years before the '293 patent issued.

Petitioner had detailed, sustained notice of the Moskowitz inventions long before the '293 patent issued. From 2005 through 2015, Dr. Moskowitz met repeatedly with Petitioner's engineers, business leadership, and in-house counsel to share his spinal-fusion designs. Ex. 1040 ¶¶ 40-41, 43-44. In those meetings, he provided technical presentations, prototype demonstrations, claim sets, and written

materials describing interbody devices, fixation systems, and other innovations that later formed the foundation of the Moskowitz patent family. *Id.* These disclosures included pending applications that ultimately issued as, or continued into, the ’293 patent, and shared the same specification and figures now before the Director.

Petitioner did not receive this information passively. It repeatedly asked for additional materials, follow-up meetings, and more detailed disclosures. *Id.* ¶¶ 43-44. In 2011, Petitioner’s Director of Advanced Technologies requested a PowerPoint presentation, claim sets, and written descriptions so he could “review [Dr. Moskowitz’s] published IP” internally. *Id.* ¶ 43. Two years later, Petitioner met with Patent Owner again, asked for further patent information, reviewed prototype demonstrations, and sought clarification on the scope of the innovations Dr. Moskowitz had disclosed. *Id.* ¶¶ 43-44. These were not cursory exchanges. Petitioner’s representatives took notes, requested supplemental documents, and communicated that they needed more detail to conduct internal review and discuss the portfolio with Petitioner’s R&D leadership. Each step reflected an intentional effort to understand and evaluate the inventions that later formed the ’293 patent.

That decade of direct engagement further supports discretionary denial. It shows that Petitioner not only had notice of the patent materials, but understood the nature and direction of the Moskowitz inventions well before the ’293 patent issued and remained aware of the portfolio thereafter.

2. Formal 2015 notice reinforced those expectations.

In 2015, Patent Owner's counsel provided Petitioner's General Counsel and technical leadership with a portfolio-wide notice letter. Ex. 2020-2021; Ex. 1040 ¶ 45. The submission identified more than thirty issued patents and pending applications—including the '293 patent itself—and enclosed a copy. Ex. 2022. Petitioner's in-house counsel confirmed receipt, stated that Petitioner was "working [its] way through" the portfolio, and attempted to coordinate internal review with R&D leadership. Ex. 1040 ¶¶ 46-47.

Petitioner acknowledges receipt of this notice but wrongly argues it had no reason to expect enforcement because Patent Owner did not contact Petitioner again until suit. First, actual notice reinforces settled expectations, it does not give rise to an obligation for Patent Owner to provide running updates or renewed warnings. *Toyota Motor Corp. v. AutoConnect Holdings LLC*, IPR2025-00890, Paper 9 at 3 (Acting Director Stewart Sept. 19, 2025) ("actual notice… further supports discretionary denial"). Second, Petitioner later acquired Titan Spine—another entity that Patent Owner formally notified in 2015. Ex. 2023. When a petitioner acquires a company with its own notice history, that history is imputed to the acquirer. *Cf. Power Integrations, Inc. v. Semiconductor Components Indus., LLC,* 926 F.3d 1306, 1315-1316 (Fed. Cir. 2019). Petitioner thus entered the acquisition already aware—or on notice—of both entities' correspondence with Patent Owner.

3. Patent Owner's consistent enforcement activity made future assertion foreseeable.

Petitioner's suggestion that it had no reason to expect suit—because Patent Owner did not contact it again after 2015—cannot be reconciled with the record. After Petitioner and Titan Spine declined to engage, Patent Owner retained new counsel in 2016 and pursued prosecution of its portfolio. Within days of its last patent issuing, Patent Owner filed suit against Globus Medical in November 2019, asserting eight patents. Ex. 2017. When that case was transferred to the Eastern District of Pennsylvania in July 2020, Globus responded with eight IPR petitions. The PTAB denied institution of all eight in 2021. The district court then allowed the case to proceed to a December 2023 trial. The case remains on appeal.

In December 2022, while the Globus litigation was pending, Patent Owner sued ZimVie—another of Petitioner's competitors. Ex. 2009. That case was dismissed in 2023, only because Patent Owner's counsel had a conflict. Patent Owner retained new counsel and continued its enforcement efforts, filing the present action against Petitioner in February 2025. Ex. 2019. Patent Owner—a small entity with limited resources—pursued enforcement in a steady and predictable manner, while Petitioner, despite detailed notice and ample resources, chose not to act.

This enforcement record—public, persistent, and directed at significant market participants—made clear that Patent Owner viewed its patent rights as valuable and enforceable. Petitioner, a sophisticated industry leader with decades of

experience navigating patent risk, and with detailed notice since at least 2015, cannot credibly claim a reasonable expectation that Patent Owner would not assert its patents. Such arguments have been rejected in prior Director decisions. *Google LLC v. SoundClear Techs. LLC*, IPR2025-00344, Paper 15 at 2 (Aug. 4, 2025).

4. Medtronic's decade of inaction strengthens, rather than undermines, settled expectations.

In addition to Patent Owner's direct notices, Petitioner repeatedly encountered the '293 patent and its related family in its own prosecution work. The earlier publication of the '293 patent was cited against one of Petitioner's applications. Ex. 2016 at 13. Petitioner and its subsidiaries—each a defendant in the Minnesota Action—also listed the '293 patent in numerous IDS filings. *E.g.*, Ex. 2025 at 11 (July 19, 2019); Ex. 2027 at 11 (May 14, 2021); Ex. 2026 at 20 (Feb. 1, 2022). And across its broader portfolio, Petitioner and the same subsidiaries cited Patent Owner's patents and applications more than one hundred times. Ex. 1040 ¶¶ 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.

Petitioner also continued to develop and commercialize several product families that infringe the '293 patent, including Divergence, Sovereign, Endoskeleton TAS, and Endoskeleton TCS. *See* Ex. 1040 ¶¶ 53-57. Several of these systems, or their precursors, were on the market or in development when Petitioner received the 2015 notice letter. *Id.* ¶¶ 72, 77-78. Petitioner did not pause

or reconsider those efforts after receiving notice; it expanded these product lines and continues to market them today. *Id.* That continued expansion made enforcement of the ’293 patent more, not less, foreseeable—an outcome that Patent Owner ultimately pursued.

These repeated citations and continued product development confirm Petitioner’s ongoing awareness of Patent Owner’s portfolio and foreclose any claim that it viewed the patents as unimportant or dormant. A party that tracks, cites, and continues to advance product lines alleged to infringe cannot plausibly claim surprise when the portfolio is enforced. Yet despite this long-standing notice—spanning pre-issuance discussions, formal notice letters, public enforcement actions against competitors, and extensive citation of the portfolio—Petitioner waited ten years to file this Petition. Under the Director’s guidance, “failure to seek early review of the patents favors denial.” *iRhythm*, at 3.

Petitioner’s decade of inaction does not weaken settled expectations; it reinforces them. Patent Owner had every reason to rely on Petitioner’s silence as it invested in prosecution, advanced multiple district-court litigations, and maintained its portfolio based on the expectation that any validity challenges would be raised by Petitioner in a timely manner.

The Director has denied institution based on settled expectations even where other *Fintiv* factors favor institution or when the district court had stayed the case.

OnePlus Tech. Co., Ltd. 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 with greater force here given the age of the patent, Petitioner's long-standing notice, years of pre-issuance engagement, consistent enforcement against competitors, extensive citation of the portfolio, and Petitioner's decade-long delay before seeking review. Under § 314(a) and the Director's settled-expectations framework, discretionary denial is warranted.

B. Factor 1 Favors Denial Because a Stay in the Minnesota Action Is Neither Requested nor Realistic.

No stay has been requested by Petitioner in the Minnesota Action, which has been pending for more than nine months. That weighs against institution. Moreover, a stay is not a realistic possibility, even if Petitioner were to seek one now.

The Minnesota Action involves eleven asserted patents. This Petition challenges only one claim of one patent, and Petitioner's other four petitions still leave six asserted patents entirely unchallenged. A stay under these circumstances would not advance efficiency because the court must continue adjudicating infringement, invalidity, and claim construction for the remaining patents and other asserted claims of the '293 patent regardless of the outcome here. Courts routinely deny stays where parallel IPRs are not yet instituted or would not meaningfully narrow the case. *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); *TwinStrand Biosciences, Inc. v. Guardant Health, Inc.*, No. 21-1126, 2023 WL 2563179, at *2 (D. Del. Mar. 17, 2023); Ex. 2024 at 3.

The District of Minnesota, in particular, has declined stays where IPRs are not yet instituted, the asserted patents exceed those placed into IPR, or where significant portions of the litigation would proceed in parallel. *Id.*; *Dane Techs., Inc. v. Gatekeeper Sys., Inc.*, No. 12-2730 ADM/AJB, 2013 WL 4483355, at *2-3 (D. Minn. Aug. 20, 2013). The same reasoning applies here: this Petition cannot simplify the case, and a stay would only delay trial on the bulk of the issues before the court.

The PTAB has recognized that when "no stay is likely to be entered," this factor "leans towards denial of institution." *Mylan Labs. Ltd. v. Janssen Pharm. NV*, IPR2020-00440, Paper 17 at 13–14 (PTAB Sept. 16, 2020). Because a stay has not been requested and would not be granted if it were, Factor 1 favors denial.

C. Factor 2 Favors Denial Because Two District Actions Are Advancing, and One Will Reach Trial Before the IPR Deadline.

Two district courts are moving toward trial on the '293 patent, and one of those trials will occur before any final written decision would issue here. Under the Director's guidance, that timing weighs strongly in favor of discretionary denial because an IPR would duplicate work already underway and risk inconsistent results.

The Minnesota Action, filed in February 2025 against Petitioner, has a trial-ready date of February 8, 2028. *See* Ex. 2001 at 16; Ex. 2019. If the Director were

to institute this IPR, a final written decision would be due in April 2027. On that timeline alone, this factor may be neutral. But the Delaware Action, filed June 6, 2025, is scheduled for trial on February 8, 2027, before Judge Bryson of the Federal Circuit, sitting by designation. *See* Ex. 2004 at 8; Ex. 2018. That trial will begin two months before a final written decision would issue here—a sequencing the USPTO has treated as weighing heavily against institution. *E.g.*, *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 13 (PTAB May 13, 2020) (finding that when a parallel trial is scheduled about two months before the IPR deadline, Factor 2 "substantially" favors denial).

The fact that the Delaware Action involves one of Petitioner's competitors, NuVasive, does not change the analysis. The two district cases involve the same asserted claim, the same patent, and overlapping invalidity theories. A trial addressing those issues in February 2027 will materially shape the parties' positions in the Minnesota Action. Proceeding with an IPR in parallel would create unnecessary duplication and invite divergent outcomes on the same patent.

Because one district-court trial will precede a final written decision and both actions will address overlapping validity issues, Factor 2 favors discretionary denial.

D. Factor 3 Favors Discretionary Denial Because Both District Court Cases Will be Substantially Invested by the Institution Deadline.

By the time an institution decision is due in April 2026, both district-court actions involving the '293 patent will be far along. That level of progress weighs

heavily in favor of discretionary denial. The Office has recognized that significant investment includes the exchange of contentions, active discovery, and the onset of claim-construction proceedings. *BOE Tech. Grp. Co. v. Element Capital Commercial Co.*, IPR2023-00808, Paper 9 at 23–24 (PTAB Nov. 15, 2023).

The Minnesota Action will already reflect meaningful litigation activity. Patent Owner served infringement contentions on October 30, 2025, and Petitioner's non-infringement and invalidity contentions are due January 28, 2026. *See* Ex. 2001 at 3–4. Fact discovery will be ongoing at that point, and claim-construction disclosures will begin shortly after the institution deadline. *Id.* at 5–7. Indeed, the action would have progressed even further but for Petitioner's own delay in responding to the complaint; Petitioner requested multiple extensions, pushing the schedule back by nearly three months. *See* Ex. 2002–2003. Had Petitioner not delayed its response, claim-construction briefing—now set to begin following the parties' June 11, 2026, joint statement—would have begun in March, before any institution decision. That delay does not negate the substantial investment in the case; it simply shifts its timing.

The Delaware Action will be even further advanced by April 2026. Patent Owner's infringement contentions are due December 12, 2025, and NuVasive's invalidity contentions are due January 12, 2026. *See* Ex. 2004 at 1–2. Fact discovery closes on May 1, 2026—meaning that by the time the Director decides whether to

institute this IPR, the parties will have completed most of the discovery process in a case involving the very same patent and claim. Claim construction will also be nearing completion: the parties must exchange terms by January 28, 2026, complete briefing by March 27, 2026, meet and confer by April 2, 2026, and file a joint report by April 7, 2026. *Id.* at 6–7. These are precisely the kinds of efforts *BOE* identified as evidence of substantial investment.

Although Petitioner is not a party to the Delaware Action, the significance of this progress does not depend on party identity. Both Patent Owner and the Delaware court will have dedicated substantial resources to resolving the same claim and the validity issues Petitioner asks the Director to revisit. Proceeding with an IPR alongside two maturing district-court actions would duplicate effort across tribunals and undermine the efficiency that § 314(a) is designed to promote.

For these reasons, the level of investment already made—and the additional work that will occur before any institution decision—strongly favors denial.

E. Factor 4 Favors Denial Because the Invalidity Issues in the District Courts Substantially Overlap with Those Raised Here.

The invalidity issues raised in this Petition substantially overlap with the issues that will be litigated in the Minnesota and Delaware Actions. That overlap weighs against institution because it undermines the efficiency and coherence that § 314(a) is meant to protect.

The overlap is evident from the face of the Petition. The same prior art references, the same structural limitations, and the same claim-construction disputes that would be addressed here will be addressed in both district courts. Petitioner has already acknowledged this, as its counsel contacted Patent Owner to discuss filing a *Sotera* stipulation. *See* Ex. 2005. Petitioner then filed a stipulation in the Minnesota Action but, as of this filing, 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." *See* Ex. 2006 at 3. The absence of a stipulation here leaves both the scope and timing uncertain.

But even a timely stipulation would not resolve the overlap. The Director has emphasized that a *Sotera* stipulation is "not dispositive" when other invalidity theories remain in district court. *See* Ex. 2007 at 2–3. That is the situation here. Petitioner can still rely on system art, public use, on-sale bar evidence, and combinations involving non-printed publications—none of which fall within IPR estoppel. *See Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1365–66 (Fed. Cir. 2025) (estoppel does not preclude using the same references as evidence supporting non-IPR-statutory invalidity grounds). The USPTO has noted that when system art or other non-printed-publication invalidity theories remain available in district court, a *Sotera* stipulation is "not . . . particularly meaningful because the efficiency gained by an AIA proceeding will be limited." *See* Ex. 2008 at 3.

The same concern applies to Petitioner's use of the prior art across the eleven asserted patents. Even if Petitioner stipulated not to use the Petition's printed publications against the '293 patent, nothing prevents it from using the same art against the other asserted patents in the Minnesota Action. The Office has denied institution even with a *Sotera* stipulation when the stipulation does not convert an IPR into a "true alternative" to the district-court proceeding. *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 Petition raises issues that will be litigated in both district-court actions, and because even a perfect stipulation would not eliminate the overlapping theories available to Petitioner, an IPR would duplicate work and create the risk of conflicting outcomes. Factor 4 therefore favors discretionary denial.

F. Factor 5 Favors Denial Because This IPR Involves the Same Parties and Disputes as the Minnesota Action.

The Petitioner here is the defendant in the Minnesota Action. That identity of parties weighs in favor of discretionary denial because the same parties will be litigating the same patent, the same claim, and the same invalidity issues in district court. *See Fintiv*, Paper 11 at 13–14; *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020). When the same parties are already engaged in a parallel proceeding that will address the same disputes, an IPR is unlikely to enhance efficiency or conserve resources.

Although the Delaware Action involves a different defendant, it also places the '293 patent's validity before a district court and will proceed in parallel with this case. That second proceeding reinforces the concern that institution would multiply, rather than reduce, the number of tribunals addressing overlapping issues. For this reason as well, Factor 5 favors discretionary denial.

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

Factor 6 also favors denial. The Director does not require a full merits analysis at this stage; rather, the parties may identify strengths or weaknesses that assist in evaluating whether the merits meaningfully shift the balance. *Fintiv*, Paper 15 at 15. 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). Here, several threshold defects make the Petition far from compelling.

The first problem is that the Petition rests on arguments that are not permitted in an inter partes review. Under § 311(b), an IPR may challenge a claim only under §§ 102 or 103 and only on the basis of patents or printed publications. Yet the Petition opens by suggesting that the Office allowed the '293 patent to issue because of Patent Owner's "questionable actions" during prosecution and because Patent Owner supposedly "buried" prior art. *See* Petition at 1–2. These assertions echo inequitable-conduct themes that fall outside the scope of an IPR. More importantly,

the factual premise is incorrect. Petitioner acknowledges that Patent Owner submitted an IDS listing the very references Petitioner says the Office lacked. *See* Ex. 1004 at 398, 400, 403. And the record confirms that the examiner already knew about this art: the same references had been cited to, or cited by, the very same examiner in related Moskowitz applications in 2012 and 2014. *See* Exs. 2010–2015. Against that backdrop, the Petition's suggestion that a non-compliant IDS deprived the Office of critical art is unsupported. The references were not concealed, and the examiner had reviewed and cited them long before the '293 patent issued.

The Petition also devotes more than seven pages to written-description criticisms of the '293 patent, asserting that the patent "fails to describe" the claimed features. *See* Petition at 15–22. Section 112, however, is not a permissible ground for IPR. *Dexcowin Global, Inc. v. Aribex, Inc.*, IPR2016-00436, Paper 12 (PTAB July 7, 2016). And the regulations require a petitioner to provide "the specific statutory grounds under 35 U.S.C. 102 or 103" for each challenged claim. 37 C.F.R. § 42.104. Placing an extended § 112-style critique in the "Background" section does not cure the alleged defect; it signals that the Petition's unpatentability theory depends on arguments that cannot be considered in this forum. A petition that is improper on its face cannot present compelling merits.

These deficiencies matter because they confirm that an IPR would not simplify the district-court cases. The Petition's reliance on unpermitted grounds to

challenge a single asserted claim ensures that the Medtronic Action will still require a full trial on validity, including issues that the Petition does not and cannot address. Under the Director's guidance, such unresolved overlap weighs against institution, not in favor of it. For these reasons, and consistent with *Fintiv* and subsequent Director decisions, Factor 6 favors discretionary denial.

III. CONCLUSION

The Director should deny institution. The '293 patent has been in force for more than a decade, and Petitioner had repeated, detailed notice of Patent Owner's inventions—both before issuance and shortly after—yet waited ten years to seek review. Those long-standing expectations weigh heavily against institution under the Director's guidance and its following decisions. And this IPR will not simplify the parallel district-court proceedings. The Petition challenges only one claim of one patent in an eleven-patent case, and two federal courts are already investing substantial resources in resolving the same issues. Proceeding here would duplicate that work and create the risk of inconsistent outcomes. The Petition also does not present compelling merits. It relies on arguments outside the scope of an IPR and rests on an incorrect premise about the prior art considered during prosecution—ensuring that the district courts will still need to resolve validity. For these reasons, and consistent with § 314(a), Patent Owner respectfully requests discretionary denial of the Petition.

Date: December 8, 2025

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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 2001-2027) were served electronically via e-mail on December 8, 2025, in their entireties on the following counsel of record for Petitioner:

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