

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

MEDTRONIC, INC.,
Petitioner,

v.

MOSKOWITZ FAMILY LLC,
Patent Owner.

IPR2026-00162
Patent 12,011,367 B2

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual
Property and Director of the United States Patent and Trademark Office.*

DECISION
Granting Institution of *Inter Partes* Review

Medtronic, Inc. (“Petitioner”) filed a petition requesting *inter partes* review of claims 8, 9, 13, and 17–21 of U.S. Patent 12,011,367 B2 (“the ’367 patent,” Ex. 1001) as either anticipated or rendered obvious by Palmatier.¹ Paper 1 (“Petition” or “Pet.”). Moskowitz Family LLC (“Patent Owner”) filed a preliminary response, raising, among other arguments, that the claimed subject matter was conceived and diligently reduced to practice prior to Palmatier’s filing date. Paper 9 (“Prelim. Resp.”), 1, 5–67.²

Petitioner filed a reply asserting that Patent Owner did not meet the evidentiary burden to antedate Palmatier because Patent Owner relies on the testimony of only one named inventor, whom Petitioner should be provided the opportunity to cross-examine. Paper 11 (“Pet. Reply”), 1. Petitioner also disputes that the evidence shows conception of certain claimed features. *See id.* at 2–4 (“The ‘modified wedge’ design does not, however, disclose the claimed ridges on the vertebral body engagement surfaces.”). Patent Owner filed a sur-reply asserting that the documentary evidence and inventor testimony is sufficient to antedate Palmatier. Paper 12 (“PO Sur-Reply”), 1–4.

After considering the arguments presented and the record, and in view of all relevant considerations, institution was appropriate in this proceeding. *See* Paper 13 (“Notice”), 2. This determination was based on the totality of the evidence and arguments presented, only a select portion of which I discuss in this opinion identified as forthcoming in the Notice. *See id.*

¹ US 9,445,919 B2, issued Sept. 20, 2016 (Ex. 1057).

² At this preliminary stage, Petitioner establishes a reasonable likelihood that Palmatier anticipates or renders obvious the challenged claims (Pet. 22–66), and Patent Owner does not challenge Petitioner’s showings as to Palmatier.

Specifically, I determine that institution is warranted because Petitioner has made a sufficient showing of unpatentability based on Palmatier.

Patent Owner does present some evidence of conception, diligence, and constructive reduction to practice, but Petitioner persuasively disparages that evidence on the preliminary record. For example, Patent Owner relies on April and May 2011 emails exchanged between two or more of the named inventors (Exs. 2027–2031, 2056, 2057, 2059) and a declaration from one of the named inventors, Dr. Nathan Moskowitz (Ex. 2024), to show conception of the claimed subject matter. Prelim. Resp. 8–61. Patent Owner also relies on Dr. Moskowitz’s declaration and emails (Exs. 2045, 2049, 2050) to show reasonably continuous diligence leading up to the filing of a provisional patent application. *Id.* at 63–66. Petitioner asserts that the documentary evidence does not show conception of the claimed “ridges,” in part, because a key email attachment regarding an embodiment for ridges has not been provided. Pet. Reply 1–4. Petitioner also asserts that Patent Owner’s relies on the declaration testimony from only one named inventor, which is vague and should be the subject of cross-examination. *Id.* Given these disputes, during trial, the parties are free to develop the record as to the asserted prior conception and diligent reduction to practice of the claimed subject matter, relative to Palmatier’s filing date.

In consideration of the foregoing, it is:

ORDERED that the Petition is granted and an *inter partes* review is instituted.

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