

From: [Trials](#)
To: [Argenti, Matthew](#); [Trials](#)
Cc: [Rosato, Michael](#); [Medley, Patrick](#); cjacobsen@gibsondunn.com; jschung@gibsondunn.com; [Krevitt, Josh](#)
Subject: RE: Align v. Dental Monitoring, IPR2023-01369
Date: Friday, January 5, 2024 9:44:31 AM

Counsel,

From the Board -

1. Petitioner is free to provide Patent Owner with a *Sotera* stipulation and file it with the Board as a separate exhibit. If Petitioner serves and files a *Sotera* stipulation, the Board does not need further briefing on the issue. See Katherine K. Vidal, *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (June 21, 2022); available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_ai_a_parallel_district_court_litigation_memo_20220621_.pdf (“[T]he PTAB will not discretionarily deny institution of an IPR or PGR in view of parallel district court litigation where a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition.”).
2. If Petitioner is unwilling to provide a *Sotera* stipulation, but instead wants to provide a stipulation similar to a *Sand Revolution* stipulation, Petitioner is authorized to file a three - page preliminary reply on or before January 12th, 2024, narrowly tailored to address the *Fintiv* factors for discretionary denial. In response, Patent Owner is authorized to file a three-page preliminary sur-reply on or before January 19th, 2024, addressing the same.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Argenti, Matthew <margenti@wsgr.com>
Sent: Wednesday, January 3, 2024 7:07 PM
To: Trials <Trials@USPTO.GOV>
Cc: Rosato, Michael <mrosato@wsgr.com>; Medley, Patrick <pmedley@wsgr.com>; cjacobsen@gibsondunn.com; jschung@gibsondunn.com; Krevitt, Josh <JKrevitt@gibsondunn.com>
Subject: Align v. Dental Monitoring, IPR2023-01369

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Board,

Consistent with the Director's memorandum on interim procedure for discretionary denials in AIA post-grant proceedings with parallel district court litigation, Petitioner Align Technology requests authorization to file a stipulation in IPR2023-01369 agreeing to limit our invalidity arguments in the district court case in the event the Board grants institution in this IPR. Align also requests authorization from the Board to file a three-page reply to Patent Owner's preliminary response, limited to addressing the *Fintiv* factors for discretionary denial.

Patent Owner opposes Align's request.

Should the Board find it helpful to hold a conference call to discuss this issue, Align will provide availability upon request.

Regards,

Matthew A. Argenti

Counsel for Petitioner Align Technology, Inc.
Wilson Sonsini Goodrich & Rosati
650 Page Mill Rd., Palo Alto, CA 94304
Direct: (650) 354-4154
Fax: (650) 493-6811

This email and any attachments thereto may contain private, confidential, and privileged material for the sole use of the intended recipient. Any review, copying, or distribution of this email (or any attachments thereto) by others is strictly prohibited. If you are not the intended recipient, please contact the sender immediately and permanently delete the original and any copies of this email and any attachments thereto.