UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CLEARCORRECT OPERATING, LLC,
Petitioner

v.

ALIGN TECHNOLOGY, INC.,
Patent Owner

Case No. IPR2025-00815
U.S. Patent No. 10,524,879

PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

TABLE OF CONTENTS

I. INTRODUCTION 1

II. EVIDENCE OF NON-CUMULATIVE PRIOR ART AND EXAMINER ERROR SUPPORTS REFERRAL UNDER ADVANCED BIONICS 3

A. The Petition Includes Prior Art Combinations That Were Not Previously Presented to the Office 5

1. Becker Is Not Cumulative 6

2. Sachdeva Is Not Cumulative 12

3. Prior Consideration of Chishti-876 and Chishti-511 Does Not Support Discretionary Denial 17

B. The Office Erred in a Manner Material to the Patentability of the Challenged Claims 20

C. Evidence of Material Error Favors Referral 22

III. DISCRETIONARY DENIAL UNDER *FINTIV* IS UNWARRANTED 23

A. The *Fintiv* Factors Are Inapplicable Because the ’879 Patent Was Withdrawn from Co-pending Litigation 23

B. Even if Considered, the *Fintiv* Factors Do Not Support Discretionary Denial 26

IV. ADDITIONAL FACTORS SET FORTH IN THE WORKLOAD MEMORANDUM DO NOT SUPPORT DISCRETIONARY DENIAL 27

A. Settled Expectations 27

1. Petitioner’s early challenge supports referral 27

2. The Office’s prior expenditure of resources in other proceedings does not warrant denial 30

B. Strength of Petitioner’s Unpatentability Grounds 31

1. The Petition's Ground Includes Becker and Sachdeva, Which Teaches the Claim Limitation Found Missing from the Prior Art 32

2. The Petition Appropriately Addresses Relevant Findings From the '444 IPR 32

3. The Petition Is Not a Follow-On Petition and Does Not Trigger "Roadmapping" Concerns 36

C. No Forum Has Adjudicated Any Claim of the Challenged Patent 37

V. PATENT OWNER WAIVED ITS RIGHT TO RAISE OTHER BASES FOR DISCRETIONARY DENIAL 38

VI. CONCLUSION 39

I. INTRODUCTION

Discretionary denial under 35 U.S.C. § 325(d) is inappropriate because this Petition presents new prior art, grounds, and arguments not yet presented to the Office. Patent Owner is simply wrong to assert that the Petition "asks the Board to revisit the same prior art references that Petitioner already advanced and the Board rejected years ago" in IPR2017-01829, where claims of a related patent, U.S. Patent No. 8,038,444, were challenged (the "'444 IPR"). Req., at 1. Petitioner's sole invalidity ground here relies on:

- Becker—a reference undisputedly not before the Examiner or the Board—for the round-tripping feature, which the Examiner and the Board deemed missing from the prior art and led to allowance of the claims;
- Sachdeva—also undisputedly not before the Examiner or the Board—for the claimed delaying feature, which the Board deemed missing from the prior art; and
- Chishti-511 and Chishti-876—references that were previously considered by the Office—for only features that the Examiner found were taught in the prior art and that Patent Owner did not dispute.

The substantial differences between the art presented here versus the art previously presented to the Examiner and the Board are sufficient to defeat Patent

Owner's attempt to satisfy part one of *Advanced Bionics* is satisfied, which should end the *Advanced Bionics* inquiry.

But even if the Director were to proceed to part two of *Advanced Bionics*, material error by the Examiner supports referral, not discretionary denial. In the case of Sachdeva, evidence shows that the Examiner was *expressly* directed to Sachdeva as a relevant reference, and yet it is undisputed that the Examiner did *not* locate it. This was a material error by the Office. Moreover, the Examiner materially erred by not locating Becker, which discloses the claimed round-tripping feature that the Examiner identified as the express reason for allowance. Patent Owner does not dispute in its Request that Becker meets the express definition of round-tripping provided in the '879 patent. It is therefore appropriate for the Office to deny Patent Owner's Request and use its resources to review that material error.

Finally, with respect to *Fintiv*, Patent Owner argued at length in its Request that a district court trial on the '879 patent would precede a Final Written Decision in this proceeding. Req., 8-18. But shortly after submitting its Request, Patent Owner withdrew its infringement assertions for all claims of the '879 patent, meaning that no trial involving the '879 patent is currently scheduled, or will take place, before a Final Written Decision issues. Despite withdrawing its infringement allegations, Patent Owner did *not* dismiss its infringement claims against Petitioner with prejudice, meaning that there is a likelihood that Patent Owner will reassert the

challenged patent against Petitioner in the future. This case is fundamentally different from other cases where the Office has discretionarily denied institution on patents challenging claims dismissed from litigation where the dismissal was with prejudice or pursuant to a joint motion by the parties, or there was some indication that the challenged claims would not be reasserted against petitioner, such as a stipulation of noninfringement. Where the withdrawal in district court is *without* prejudice, like here, Patent Owner is free to reassert the patent but Petitioner would be time-barred from a later challenge.

Because Patent Owner no longer asserts the challenged patent against Petitioner in the underlying litigation, *Fintiv* does not apply, and taken together, material error, settled expectations, strength of the unpatentability challenge, efficiency and fairness considerations here weigh in favor of the Board denying Patent Owner's Request.

II. EVIDENCE OF NON-CUMULATIVE PRIOR ART AND EXAMINER ERROR SUPPORTS REFERRAL UNDER ADVANCED BIONICS

Advanced Bionics provides a two-part framework for evaluating whether denial under Section 325(d) is warranted. *First*, the Director considers whether the same, or substantially the same, prior art or arguments were previously presented to the Office. If the Patent Owner fails to make that showing, the *Advanced Bionics* inquiry ends. *Second,* if the first prong is satisfied, then the Director considers whether the petitioner has demonstrated that the Office erred in a manner material

to the patentability of the challenged claims. *See, e.g.*, *Advanced Bionics, LLC v. MED-EL Elektromedizinishe Gerate Gmbh*, IPR2019-01469, Paper 6 at 7-8 (PTAB Feb. 13, 2020).

Here, the Director should refer the Petition and decline to discretionarily deny institution under Section 325(d) because the Petition's ground relies on new references—Becker and Sachdeva—that Patent Owner concedes were not of record during prosecution or during the '444 IPR. Moreover, contrary to Patent Owner's assertions, those references are not cumulative of those previously considered.

Discretionary denial under Section 325(d) is particularly inappropriate here, where there is evidence the Office materially erred during prosecution. *Xencor, Inc. v. Merus N.V.*, IPR2025-00604, Paper 12 at 2-3 (Director July 17, 2025). Not only did the Examiner err by failing to locate Sachdeva and Becker, which disclose features that the Examiner and/or the Board found to be missing from the prior art, but the Examiner's failure to consider Sachdeva is exacerbated by the fact that a different reference cited during prosecution expressly directs one to "refer to" Sachdeva. It is undisputed that, despite being faced with a clear indication that Sachdeva may be relevant, the Office did not locate it during examination of the challenged patent. This evidence of material error by the Examiner can outweigh other considerations that would otherwise support discretionary denial. *Id.* Under

these circumstances, referral to the Board for consideration on the merits is appropriate.

Accordingly, the Director should not exercise § 325(d) denial discretion, and there is no need to reach the second *Advanced Bionics* factor. But even if the Director does address the second *Advanced Bionics* factor, it also warrants referral here.

A. The Petition Includes Prior Art Combinations That Were Not Previously Presented to the Office

Patent Owner has not met its burden of showing that part one of the *Advanced Bionics* framework is satisfied because neither Becker nor Sachdeva was provided, considered, or cited during prosecution of the ’879 patent or related family patents, and Patent Owner has not shown that Sachdeva and Becker are substantially the same as or cumulative of any reference previously considered by the Office.

Patent Owner wrongly relies on the ’444 IPR to summarily argue it supports discretionary denial here. But Patent Owner does not actually analyze any of the prior art in that case or compare it to the new prior art relied on in the Petition (Becker and Sachdeva). It is improper for Patent Owner to extrapolate from the prior IPR and simply assume—without any detailed or careful analysis—that the Board’s prior determinations in the ’444 IPR mean that the Board has also effectively decided the patentability of the ’879 patent. As discussed below, a proper analysis of the prior art shows that Becker and Sachdeva present new and non-cumulative teachings that

were not considered by the Office and provide the very teachings that were previously found to be missing from the prior art.

1. Becker Is Not Cumulative

The Petition relies on Becker's teaching of round-tripping for independent claims 1, 9, and 20 of the '879 patent, which expressly recited round-tripping, and for claims 6 and 7, and 15, which recite limitations related to round-tripping. *See* Pet., 44-49, 57-58, 74-75. During prosecution of the application leading to the '879 patent, the Examiner allowed these claims, stating that the allowability of those claims was "limited to the definition [of round-tripping] found in the specification" and that the prior art did not teach or render obvious claim limitations reciting "round-tripping." Ex-1002, 233-34, 319-20; *see also* Pet., 6-7.

It is undisputed that Becker was not considered by the Office. Recognizing this, Patent Owner attempts to argue that Becker is cumulative of general assertions made during the '444 IPR, suggesting that round-tripping was a well-known technique in the prior art. Req., 27-28 (citing Ex-1028). However, contrary to Patent Owner's assertions, Becker's disclosures are not cumulative of those teachings.

During the '444 IPR, the Board found that the '444 patent included an express definition for the term round-tripping, specifically:

> moving a first tooth out of the path of a second tooth, and
> once the second tooth has moved sufficiently, moving the

> first tooth back to its previous position before proceeding to a desired final position of that first tooth.

Ex-1008, 6. The Board in the ’444 IPR found that references in the Chishti prior art to “round-tripping” generally referred to “something different than the ‘round tripping’ required by the ’444 patent.” *Id.* at 16. Chishti-511 states that “[r]ound-tripping is any motion of a tooth in any direction other than directly toward the desired final position,” and Chishti-876 describes round-tripping as “moving a tooth along a distance greater than absolutely necessary to straighten the teeth” Ex-1008, 15 n.4; Ex-1005, 14:46-50.

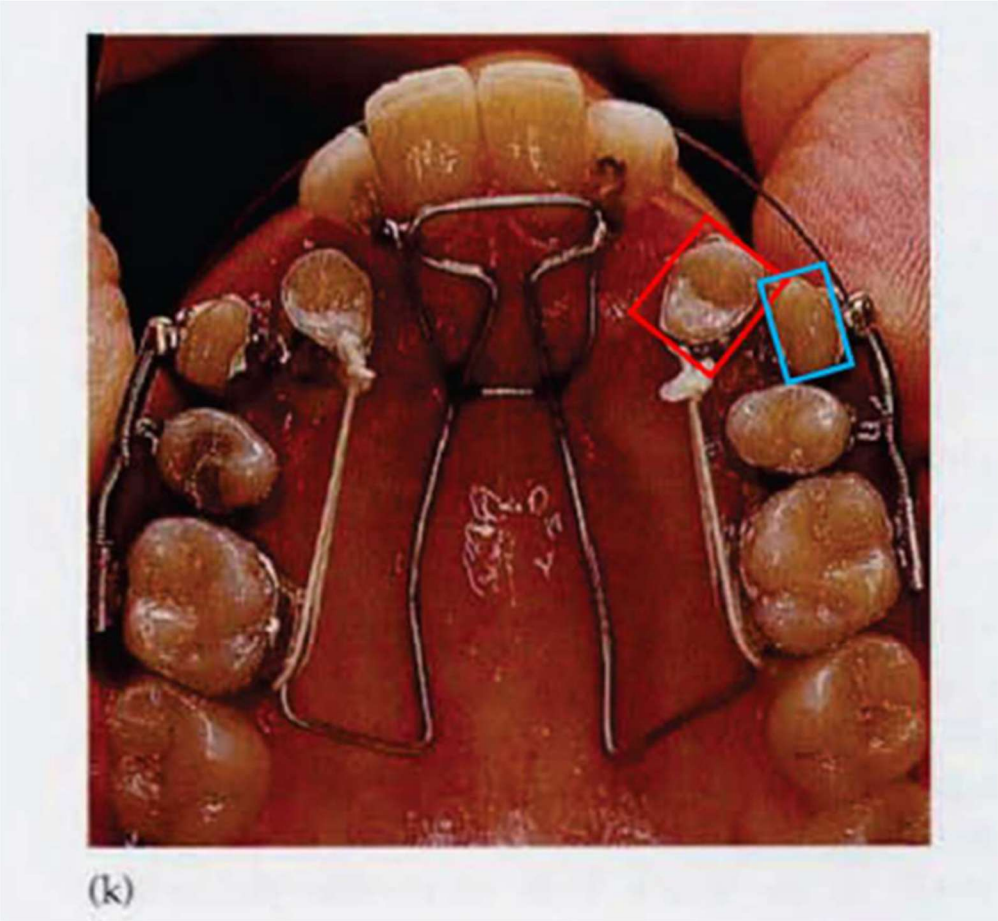
By contrast, Becker provides the specific tooth movement technique required by the ’879 patent—a fact that Patent Owner *does not dispute*. The express definition of round-tripping in the ’879 patent requires three steps:

> (1) moving a first tooth out of the path of a second tooth, and,
>
> (2) once the second tooth has moved sufficiently moving the first tooth back to its previous position
>
> (3) before proceeding to a desired final position of that first tooth.

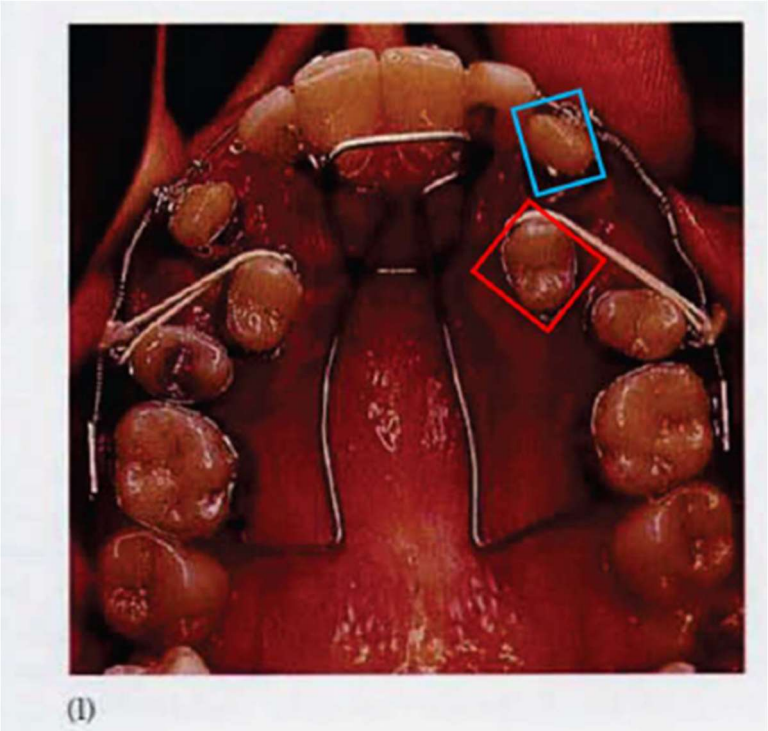
Ex-1001, 13:9-13; *see also* Ex-1008, 6. Becker discloses each of these three steps.

Becker discloses a method for treating a malocclusion where two teeth are initially transposed. As shown below, two teeth are transposed (highlighted in red in blue), where the teeth need to partially change places with one another. Pet., 13-16

(excerpting Ex-1006, 7 (Figs. 8.6(k), (l) (annotated))). Becker refers to the tooth highlighted in red as the "more lingual tooth" (i.e., closer to the tongue) and the tooth highlighted in blue as the "more buccal tooth" (i.e., closer to the cheek). Ex-1006, 5; Pet., 13-16. As shown below, the tooth in red is blocking the movement path of the tooth in blue.



Ex-1006, 7, Fig. 8.6(k) (annotated); *see also* Pet., 13-16. To address this blockage, Becker explains that the tooth in red "must be moved further lingually to allow its partner" (the blue tooth) "to pass by." Ex. 1006, 5. This is shown below.

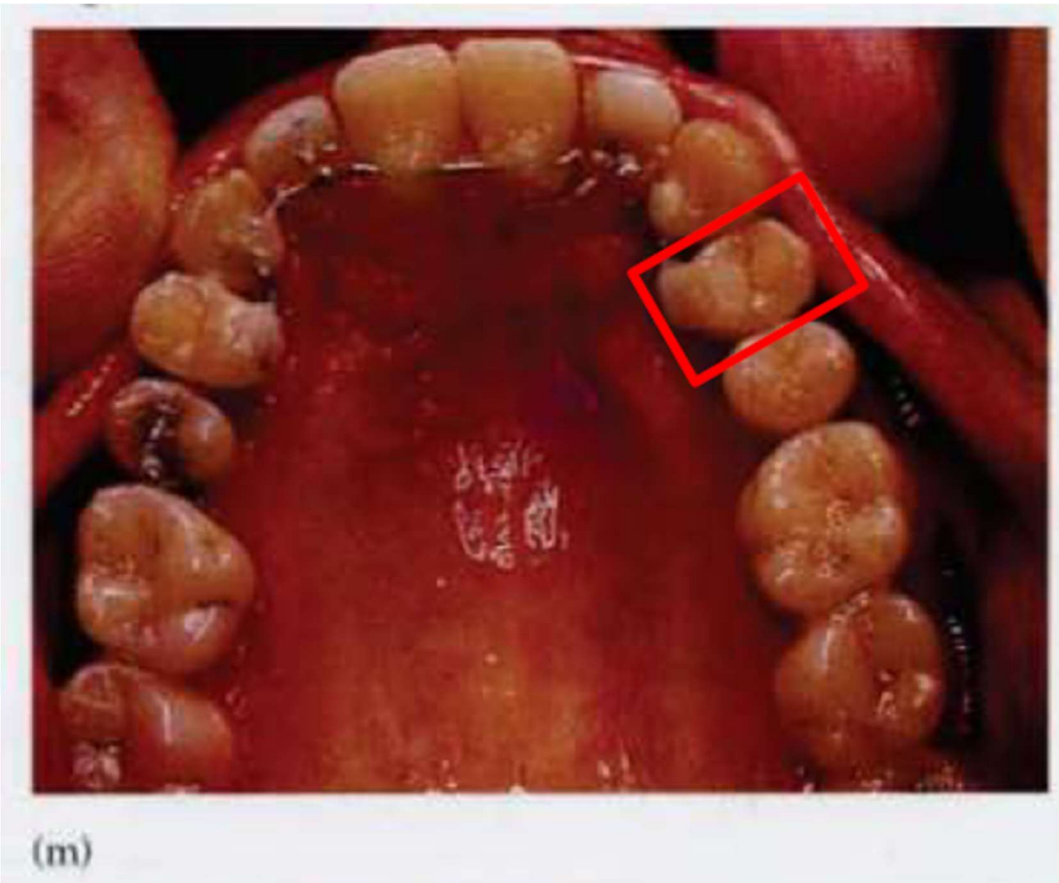


Ex-1006, 7, Fig. 8.6(l) (annotated); *see also* Pet., 13-16. As shown, Becker illustrates that the tooth in red has been moved closer to the tongue to move out of the way of the tooth in blue. Thus, Becker discloses "moving a first tooth" (red) "out of the path of a second tooth" (blue), as required by the '879 patent's round-tripping definition. *See* Pet., 46-48.

Becker also discloses "slid[ing] the more buccal of the transposed teeth . . . in the mesio-distal plane." Ex-1006, 5. This is shown above, as the blue tooth has slid toward the midline or center of the dental arch after the red tooth moved out of its path. Once this movement has occurred ("once the second tooth has moved sufficiently"), Becker discloses that the red tooth "must be moved in the opposite mesio-distal direction and back in the line of the arch." Ex-1006, 5. Moving the tooth

in the "opposite" direction it previously traveled will "mov[e] the first tooth back to its previous position," as required by step two of the '879 patent's round-tripping definition. *Id.*; *see also* Pet., 48.

Finally, Becker also discloses "proceeding to a desired final position of that first tooth," as recited in the '879 patent's round-tripping definition. As shown below, after the red tooth has moved to its previous position, it is thereafter moved to its final position (highlighted in red).



Ex-1006, 8 (Fig. 8.6(m)) (annotated); Pet., 49-50. Thus, Becker discloses the specific steps recited in the '879 patent's round-tripping definition that the Examiner and the

Board found was missing from the prior art, confirming that Becker is not cumulative. Ex-1002, 233-34, 319-20; *see also* Pet., at 6-7.

Rather than addressing Becker's disclosure or explaining how it is purportedly cumulative, Patent Owner merely resorts to unsupported attorney argument and attempts to extrapolate the Board's findings from the '444 IPR without providing an analysis that would justify application of the Board's prior findings to this proceeding. But Patent Owner's conclusory arguments do not meet *Advanced Bionics*' demand for a detailed analysis. In particular, the "substantially the same art" test demands "a detailed analysis of the similarities between the disclosures" of Becker and the allegedly cumulative references. *Geotab USA, Inc. v. Omega Patents, LLC*, IPR2023-00504, Paper 11 at 16 (PTAB July 25, 2023). Here, Patent Owner merely cherry-picks statements from the '444 IPR record discussing round-tripping at a high level, rather than actually addressing Becker's teachings. Req., 28. This does not constitute a "detailed analysis" comparing it to Becker's disclosure.

As shown above, Becker discloses the '879 patent's definition for round-tripping, which the Board found was "different" from the prior art involved in the '444 IPR. Ex-1008, 16. And despite its claims of cumulativeness, even Patent Owner admits that Chishti-511 discloses something different from the claims of the '879 patent (and therefore what is disclosed in Becker). *See* Req., 30-31 ("Chishti-511's use of the term "round-tripping" refers to an **<u>entirely different operation</u>** from what

the term means in the ’444 patent (and its continuation, the ’879 patent)” and “regardless of what Chishti-511 may or may not teach regarding its ‘round-tripping,’ this does not speak to the round-tripping disclosed and claimed by the ’879 patent”).

2. Sachdeva Is Not Cumulative

Patent Owner’s argument that Sachdeva is cumulative fails because it ignores that Sachdeva teaches the specific delaying technique recited in the challenged claims. Indeed, independent claims 1, 9, 15, and 20 of the ’879 patent recite “delaying initial movement of [one of the/the first] dental object[s]”—claim language that Patent Owner has argued “parallel[s]” the “staggering” feature that the Board in the ’444 IPR found was missing from the prior art. *See ClearCorrect Operating, LLC v. Align Techs. Inc.*, IPR2025-00816, Paper 7 at 20 (July 8, 2025) (arguing that the ’444 patent’s “staggering” feature “parallel[s] the steps described in . . . similar limitations” of claims reciting “delaying initial movement of the first dental object”).

In the ’444 IPR, the Board found that the prior art did not meet the definition of “staggering,” which requires “***delaying*** one or more teeth from moving one or more stages where it would otherwise move in order to prevent another tooth from colliding with and/or obstructing the path of the delayed tooth.” Ex-1008, 6 (emphasis added); *see id*. at 12 (finding that the prior art did not teach staggering

because it was "silent as to any consideration of purposefully 'delaying' the movement of a tooth where it would otherwise move.").

By contrast, the Petition establishes that Sachdeva discloses the claimed concept of delaying initial movement. In particular, Sachdeva discloses identifying "whether a conflict in movement arose between at least two teeth" such that "one tooth interferes with the direct path movement of another tooth." Ex-1007, 5:3-8. Sachdeva resolves these conflicts by delaying one of the teeth. In the case of an "intra-arch conflict," the system will determine which tooth has "priority." *Id.* at 5:13-26. It explains further that "[i]f the lower tooth protrudes preventing the upper tooth from moving back, the lower tooth must be moved before the upper tooth can be positioned" (delaying initial movement of the upper tooth). *Id.* Conversely, "if the upper tooth is interfering with the lower tooth from being moved out, the upper tooth must be moved first" (delaying initial movement of the lower tooth). *Id.*; *see also* Pet., 46. Thus, Sachdeva teaches one of the very features the Board previously found was missing. Patent Owner simply ignores this teaching.

Rather than addressing Sachdeva's disclosure of the claimed delaying feature, Patent Owner argues that Sachdeva "add[s] nothing new to the art and argument previously considered by the Office" because Sachdeva teaches collision detection and avoidance, which was "already taught by other art previously considered by the Office." Req., 26-27. It is true that, in *addition* to teaching the previously-missing

delaying feature, the Petition also relies on Sachdeva for well-known and conventional collision detection and avoidance disclosures. However, it is improper for Patent Owner to analyze *only* conventional techniques in support of its cumulativeness arguments, while ignoring crucial ways that Sachdeva is *not* cumulative of previously considered art. To the extent Patent Owner argues that the existence of *any* overlap with previously considered art warrants denial, that argument has been rejected. *See CallMiner, Inc. v. NICE Ltd.*, IPR2020-00221, Paper 11 at 32 (PTAB June 17, 2020) ("some overlap in arguments will likely always occur because the same claims are being analyzed," and "although we acknowledge that there is some overlap in arguments, we are not persuaded that they are sufficient to warrant application of our discretion [under § 325(d)]"); *see also* Section II.A.3, *infra*.

Moreover, pointing to mere similarities in underlying technology alone does not satisfy the "substantially the same art" test of the *Advanced Bionics* framework. *Geotab, USA Inc. v. Omega Patents, LLC*, IPR2023-00504, Paper 11 at 16 (PTAB July 11, 2023) ("common technology" alone does not satisfy the "substantially the same art" test of *Advanced Bionics* where patent owner failed to establish that the examiner relied on the previously considered references in the same manner petitioner relies on a new reference in the petition).

Patent Owner also wrongly argues that Sachdeva was considered because a *different* reference was cited during prosecution of the '879 patent—U.S. Patent No. 6,350,120 to Sachdeva et al. (hereinafter "the '120 patent"). In particular, Patent Owner claims that the '120 patent "incorporates Sachdeva by reference." Req., 26-27. This is not true. Patent Owner incorrectly argues that the following language from the '120 patent incorporates Sachdeva by reference:

> For a detailed discussion of determining whether the teeth move along the three-dimensional path refer to co-pending patent application having Ser. No. 09/451,609, entitled METHOD AND APPARATUS FOR SIMULATING TOOTH MOVEMENT FOR AN ORTHODONTIC PATIENT, now U.S. Pat. No. 6,250,918, having a filing date the same as the present patent application, and is assigned to the same assignee as the present patent application.

Req., 26-27 (citing Ex-2010, 7:21-35).

This is not an incorporation by reference. Indeed, 37 C.F.R. § 1.57(c) states that an incorporation by reference in the specification must "[e]xpress a clear intent to incorporate by reference by using the root words 'incorporat(e)' and 'reference' (e.g., 'incorporate by reference')." The portion of the '120 patent cited by Patent Owner uses *neither* "incorporate" nor "reference." *See* Req., 26-27. While the '120 patent does suggest that one "refer to" Sachdeva, that is insufficient to incorporate

material by reference. *See* 37 C.F.R. § 1.57(h)(1) ("A mere reference to material does not convey an intent to incorporate the material by reference."); *see also In re De Seversky*, 474 F.2d 671, 674 (CCPA 1973) ("[A] mere *reference* to another application, or patent, or publication is not an *incorporation* of anything therein into the application containing such reference" (emphasis in original)). Thus, the '120 patent does not include Sachdeva's teachings merely because the '120 patent made a "mere reference" to it.

Even assuming *arguendo* that the language related to the '120 operated as an incorporation by reference (it does not), any incorporation would not include the portions of Sachdeva relied on by Petitioner. The Federal Circuit has made clear that, "[t]o incorporate material by reference, the host document must identify with detailed particularity *what specific material it incorporates*." *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000) (emphasis added). The '120 patent, however, does not even refer to Sachdeva's disclosure of "delaying." Instead, the '120 patent identifies only Sachdeva's discussion of "determining whether the teeth move along the three-dimensional path." Ex-2010, 7:21-35. Petitioner, however, relies on Sachdeva for its delaying technique, not for "determining whether the teeth move along the three-dimensional path." Thus, even if Patent Owner were correct that the '120 patent incorporates Sachdeva by reference (it does not), it would incorporate only text related to "determining whether the teeth

move along the three-dimensional path," as opposed to incorporating Sachdeva in its entirety or even Sachdeva's delaying technique for collision avoidance. *See Zenon Envtl., Inc. v. U.S. Filter Corp.*, 506 F.3d 1370, 1379 (Fed. Cir. 2007) (finding that the plain language of the incorporation by reference statement expressly limited the incorporation to "details relating to the construction and deployment of a vertical skein," thus indicating that the disclosures were not incorporated in their entirety).

As discussed below in Section II.B, certainly the '120 patent would direct a reader (such as the Examiner) that they *should* refer to Sachdeva as a relevant reference. Here, however, it is undisputed that the Examiner did *not* cite Sachdeva during examination of the '879 patent, indicating an error by the Office weighing in favor of referral. *See* Section II.B.

3. Prior Consideration of Chishti-876 and Chishti-511 Does Not Support Discretionary Denial

Patent Owner argues that discretionary denial is warranted in this proceeding because Chishti-876 and Chishti-511 were considered by the Examiner during prosecution and by the Board during '444 IPR. Req., 25-26. But this argument fails for at least two reasons: (1) Patent Owner ignores the differences between the Petition and previous prior art (as discussed above, the Petition relies on Becker and Sachdeva, neither of which the Office previously considered); and (2) the Petition

relies on Chishti-876 and Chishti-511 only to show features that the Examiner found were taught by the prior art and that Patent Owner did not dispute.

The Office's prior consideration of Chishti-511 and Chishti-876 shows that institution should not be precluded here. During prosecution of the '879 patent, and after considering the '444 IPR Institution Decision, the Examiner maintained rejections of the challenged patent based on Chishti-511 and U.S. Pub. App. No. 2004/0137400 ("Chishti-400"), which has a disclosure identical to Chishti-876, for claim limitations that were not in dispute in the IPR. Ex-1002, 225-232. In particular, the Examiner stated that claim rejections based on Chishti-400 and Chishti-511 were being maintained because "the [] prior art [used in the '444 IPR] includes other elements and limitations that where [sic] not in question in the IPR, therefore [Chishti-511] and [Chishti-400] have been used in the present rejection." Ex-1002, 234. Patent Owner did not dispute these findings, and instead amended the rejected claims to positively recite round-tripping and moot the Examiner's rejection. Ex-1002, 246-56, 319-20.

Here, Petitioner relies on the Chishti references to demonstrate features unrelated to the Board's "round-tripping" and "staggering" analyses, and for features that Patent Owner did not dispute as being present in the prior art during prosecution. The prosecution history supports Petitioner's challenge.

Discretionary denial under § 325(d) is not justified here because the new, non-cumulative references and combinations of references asserted in the Petition, which are properly supported by the evidence, present a fresh challenge to the ’879 patent based on new prior art disclosing the features the Board and Examiner deemed missing from the prior art during prosecution. Ex-1002, 233-34, 319-20; Ex-1008, 16. Indeed, discretionary denial under §325(d) has been consistently denied where there are crucial differences between the combination of asserted references presented in the petition and the prior art previously considered by the Office. For example, in *Embody, Inc. v. LifeNet Health*, the Director found that discretionary denial under Section 325(d) was not appropriate where petitioner had demonstrated that the prior art was not previously considered by the Office and new prior art disclosed the exact feature that patent owner argued was missing from the prior art. IPR2025-00249, Paper 12 at 2 (Director June 26, 2025); *see also Geotab,* IPR2023-00504, Paper 11 at 16-17. Similarly, in *Meta Platforms, Inc. v. Mobile Data Technologies, LLC*, the Board declined to discretionarily deny institution under Section 325(d), despite two references having been previously considered by the Examiner, because the petition set forth a new reference that disclosed different features from the previously considered references. IPR2024-00246, Paper 12 at 14-16 (PTAB June 11, 2024). Indeed, where previously considered prior art is presented in combination with other references that were not previously considered,

discretionary denial is not warranted. *See e.g., Samsung Elecs. Co., Ltd. v. Netlist, Inc.*, IPR2022-00063, Paper 13 at 13-14 (PTAB May 5, 2022); *Thorne Rsch., Inc. v. Trs. of Dartmouth Coll.*, IPR2021-00491, Paper 18 at 7-9 (PTAB Aug. 12, 2021).

B. The Office Erred in a Manner Material to the Patentability of the Challenged Claims

Because the Petition presents new prior art, grounds, and arguments not yet presented to the Office, *Advanced Bionics* step 2 is moot and the Director need not consider whether the Office materially erred in its prior evaluation. Even if the Director does reach the second step of *Advanced Bionics*, however, discretionary denial under § 325(d) would still be improper because the record establishes that the Office committed a material error during prosecution of the challenged patent. As a result, it is appropriate for the Office to use its resources to review that material error. *See Microsoft Corp. v. Partec Cluster Competence Center GMBH*, IPR2025-00318, Paper 9 at 3 (Director June 12, 2025) ("discretionary denial of institution is not warranted because of Petitioner's showing of material error during patent examination" and "it is an appropriate use of Office resources to review the potential error"); *see* Section II.C, *infra*.

The Examiner erred in a manner material to the patentability of the challenged patent by not locating the teachings of Becker, which was not presented to the Office, and allowing the claims based on the incorrect determination that the claimed

"round-tripping" limitation was missing from the prior art. The Petition establishes that Becker discloses the round-tripping limitation, and Patent Owner's Request does not dispute these teachings of Becker. *See* Section II.A.1.

Additionally, the Examiner erred by not locating Sachdeva, which discloses the "delaying" feature that the Board deemed missing from the prior art during the '444 IPR. *See* Section II.A.2. Although the Examiner cited the '120 patent during prosecution, it does not incorporate Sachdeva by reference. The '120 patent instead directs one to "refer to" Sachdeva. It is undisputed, however, that the Examiner did not cite Sachdeva. Thus, despite being faced with clear disclosure that Sachdeva may be relevant, the Office failed to consider it during examination of the '879 patent. This error was especially material, since Sachdeva discloses the "delaying" feature that the Board previously found was missing from the prior art. Ex-1008, 16.

Where, as here, the evidence shows that the examiner materially erred by not locating relevant prior art, the Director and Board have consistently declined to exercise discretion under § 325(d). *See e.g., Microsoft Corp.*, IPR2025-00318, Paper 9 at 2-3 (declining to exercise discretion under § 325(d) where petitioner explained how the Examiner erred by "overlooking" the teachings of prior art not previously presented to the examiner); *Eunsung Global Corp. v. HydraFacial LLC*, IPR2025-00445, Paper 14 at 3 (Director July 10, 2025) ("discretionary denial is not appropriate" because "the patent examiner overlooked certain teachings in [the prior

art] that appear to disclose the allowable features of the claims"); *Tesla, Inc. v. Charge Fusion Technologies, LLC*, IPR2025-00152, Paper 11 at 1 (Director June 12, 2025) ("discretionary denial of institution is not appropriate" because the Office "erred in a manner material to the patentability of the challenged claims" by overlooking the teachings of a reference not previously considered by the Office that petitioner relied on for a feature deemed missing from the prior art); *CSPC Pharm. Group Ltd. v. Ipsen Biopharm Ltd.*, IPR2025-00505, Paper 11 at 3 (Director July 11, 2025) (referring petition where the Office materially erred by "not considering or overlooking specific teachings" in the prior art "that disclose critical limitations in the claims").

C. Evidence of Material Error Favors Referral

The Director should not discretionarily deny the Petition because it is an appropriate use of Office resources to review the evidence of material error, even if other considerations support discretionary denial. Thus, even if the Director were to find that discretionary denial were permissible under either of Patent Owner's other arguments—e.g., *Fintiv* and settled expectations—it would be appropriate to deny Patent Owner's Request. This is because "the determination not to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented," and on balance, supports referral here. For example, in *Microsoft*, the Director declined to discretionarily deny the petition, despite the

scheduled district court trial date weighing in favor of discretionary denial, because the petitioner had demonstrated material error by the Office. IPR2025-00318, Paper 9 at 3. Similarly, the Director has declined to discretionarily deny petitions because evidence of material error supported referral and outweighed settled expectations favoring discretionary denial. *See Eunsung Global Corp.*, IPR2025-00445, Paper 14 at 3; *Xencor,* IPR2025-00604, Paper 12 at 2-3.

III. DISCRETIONARY DENIAL UNDER *FINTIV* IS UNWARRANTED

A. The *Fintiv* Factors Are Inapplicable Because the '879 Patent Was Withdrawn from Co-pending Litigation

Patent Owner premises a significant portion of its Request on *Fintiv* and the '879 patent being asserted in the co-pending district court litigation. The *Fintiv* analysis examines factors relating to "whether efficiency, fairness, and the merits support the exercise of authority to deny institution *in view of an earlier trial date in the parallel proceeding*." *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (emphasis added). Indeed, throughout its Request, Patent Owner emphasizes the importance of the district court trial date and district court proceedings. *See* Req., 8, 9, 11-13. But despite these issues being a focal point of its brief, Patent Owner ***withdrew all asserted claims of the '879 patent*** just 10 days

after filing its Request.[1] Ex-1033, 1. Moreover, Patent Owner ***never informed the Office*** of this very significant change in circumstances. This withdrawal could not have been a surprise to Patent Owner given that the deadline for narrowing claims (July 18, 2025) was set in a scheduling order nearly a month before Patent Owner filed its Request. *See* Ex-1034, 2.

Because there is no longer any parallel proceeding involving the challenged patent, the "same patent" is not at issue in the co-pending litigation and this IPR, and the *Fintiv* factors are inapplicable. *See, e.g.*, *Fintiv*, IPR2020-00019, Paper 11 at 8-11 (analysis focused on "the challenged patent," "the patent at issue in the petition," and overlap of the "same or substantially the same claims" of the patent).

While the Director has declined to refer some petitions where patent claims were withdrawn from litigation, such as when they were dismissed *with prejudice*, that is not the case here. *See Cellco Partnership v. Procomm International Pte. Ltd.*, IPR2024-01453, Paper 16 (Director June 25, 2025). In this case, Patent Owner withdrew all claims of the '879 patent from the currently pending district court case as part of its litigation strategy, but it remains free to assert the '879 patent in the

[1] In addition to withdrawing the '879 patent from the litigation, Patent Owner also withdrew from the litigation the related '217 and '456 patents, which are the subject of IPR2025-00814 and IPR2025-00816, respectively.

future. To avoid inefficient use of Office resources, Petitioner contacted Patent Owner to propose that Petitioner would withdraw its petition if Patent Owner agrees to dismiss the ’879 patent from the litigation with prejudice. Patent Owner did not respond. Ex-1035, 1.

Discretionary denial of this Petition would leave Petitioner in an untenable position—exposed to a potential assertion of the ’879 patent in the future, but time-barred from filing a new IPR. Patent Owner should not be permitted to play both sides, temporarily withdrawing claims to avoid *inter partes* review and, at the same time, maintaining the right to reassert those same claims after Petitioner is time-barred from filing another petition. Especially because there are currently no parallel proceedings involving the ’879 patent, this weighs against discretionary denial. *See, e.g.*, *Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00603, Paper 8 at 2-3 (Director July 24, 2025) (denying request for discretionary denial because there were no parallel proceedings involving the challenged patent and thus “no concern of inconsistent outcome and duplication of efforts”); *see also Microsoft Corporation v. D3D Technologies, Inc.*, IPR2021-01325, Paper 11 at 10 (PTAB Feb. 18, 2022); *Toyota Motor Corp. v. Emerging Automotive LLC*, IPR2024-00814, Paper 11 at 41 (PTAB Nov. 22, 2024); *ETN Capital, LLC v. FBA Operating Co.*, IPR2024-01445, Paper 14 at 11 (PTAB Feb. 28, 2025).

B. Even if Considered, the *Fintiv* Factors Do Not Support Discretionary Denial

Although *Fintiv* no longer applies, Petitioner addresses Patent Owner's argument for discretionary denial under *Fintiv* below.

Factor 1 (Likelihood of Stay): Because the challenged patent is no longer asserted in the district court, the district court's proceedings related to the '879 patent are more than stayed—they are entirely ended. Thus, this factor weighs in favor of referral.

Factor 2 (Parallel Trial Date): Because no trial date is associated with the challenged patent, this factor weighs in favor of referral.

Factor 3 (Investment in Parallel Proceeding): With the challenged patent no longer asserted in the litigation, this factor weighs in favor of referral as the district court will have no activity in adjudicating its invalidity.

Factor 4 (Overlap): Factor 4 weighs in favor of referral because the challenged patent has been withdrawn from the litigation and thus, the district court will not decide any issues related to the '879 patent.

Factor 5 (Whether the Parties Are the Same): Factor 5 weighs in favor of referral because the challenged patent is not being asserted against any party.

Factor 6 (Likelihood of Success on the Merits): Factor 6 weighs in favor of referral now that the challenged patent is no longer at issue in the litigation.

However, to the extent that the Director considers the merits, the Petition presents strong grounds of unpatentability that were not previously considered by the Examiner or the Board, mapping every claim limitation to specific disclosures in the prior art and providing detailed, well-supported explanations of motivation to combine and reasonable expectation of success. Indeed, as explained above, Patent Owner's Request does not even dispute that the Becker and Sachdeva references discloses the exact features that were found to be missing from the prior art. *See* Sections II, IV.B.

IV. ADDITIONAL FACTORS SET FORTH IN THE WORKLOAD MEMORANDUM DO NOT SUPPORT DISCRETIONARY DENIAL

The March 26, 2025 Memorandum ("Workload Memo") states that "parties are permitted to address all relevant considerations" and identifies several example considerations. At best, Patent Owner analyzes only two of these factors: "strength of the unpatentability challenge" and "settled expectations." Req., 18-24. These factors strongly weigh in favor of referral to consider the petition's merits rather than discretionary denial, as do the other factors identified in the Workload Memo.

A. Settled Expectations

1. Petitioner's early challenge supports referral

Patent Owner has no settled expectations of validity for the '879 patent, and referring the Petition here would be consistent with the other referral decisions by the Director.

To start, the ’879 patent is a recent patent, issuing approximately five years ago on January 7, 2020. Referring the Petition here is in line with the Director’s past decisions referring petitions involving patents, like the ’879 patent, that issued in 2020 or even earlier. The Director explained that those patents “have not been in force for a significant period of time . . . and, accordingly, Patent Owner has not developed strong settled expectations that favor discretionary denial as to at least those patents”). *See Cambridge Industries, USA, Inc., v. Applied Optoelectronics, Inc.*, IPR2025-00437, Paper 10 at 2-3 (Director June 26, 2025) (referring petitions for two patents issued in 2019); *see also TankLogix, LLC v. SitePro, Inc.*, IPR2025-00650, Paper 10 at 2-3 (Director July 31, 2025) (referring petition for patent issued in 2019); *Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, Paper 23 at 3 (Director July 2, 2025) (referring petitions for patents issued in 2019 and 2020).

The Director has consistently referred petitions on patents that have not been in force for a significant period of time. *See e.g.*, *Yealink (USA) Network Tech. Co., Ltd. v. Barco N.V.*, IPR2025-00491, Paper 18 at 3 (Director June 25, 2025) (patent issued 2020); *Shenzen Tuozho Tech., Ltd. v. Stratasys, Inc.*, IPR2025-00438, Paper 10 at 2 (Director July 17, 2025) (patents issued in 2020 and 2021); *Micron Tech. v. Yangtze Memory Tech. Co., Ltd.*, IPR2025-00244, Paper 23 at 3 (Director June 25, 2025) (patent issued 2021); *Amazon.com, Inc. v. Soundclear Tech. LLC*, IPR2025-

00565, Paper 11 at 2 (Director July 10, 2025) (patent issued 2021); *Advanced Micro Devices, Inc. v. Concurrent Ventures, LLC*, Paper 10 at 2 (Director July 10, 2025) (patent issued 2021). For this reason, Patent Owner's reliance on a decision involving a patent that had "been in force since as early as 2012 and Petitioner was aware of it as early as 2013" does not support Patent Owner's contentions regarding settled expectations resulting from "failure to seek early review of the patents." Req., 21 (citing *iRhythm Techs. Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 3 (Director June 6, 2025)).

Moreover, the Director has referred a set of petitions involving a patent that recently issued in 2022, and its parent, finding that "it is an efficient use of Board resources" to address the earlier-issued parent patent along with the more recently issued patent. *See Embody*, IPR2025-00249, Paper 12 at 2-3. Here, the '879 patent is a parent to the '456 patent, which issued recently in 2022, and for which Patent Owner has not developed any settled expectations. Thus, similar to the parent patent in *Embody,* it is an efficient use of Board resources to address the '879 patent along with the '456 patent, which is being challenged in IPR2025-00816.

Even if the Director finds that settled expectations favor discretionary denial here, it would be appropriate to deny Patent Owner's Request based on a holistic assessment of the evidence presented, including the strong evidence that the Office

materially erred by allowing the claims of the challenged patent. *See* Section II.C, *supra*.

2. The Office's prior expenditure of resources in other proceedings does not warrant denial

Patent Owner's arguments related to other patents are red herrings—having little, if any, relevance to the current proceeding—and to the extent they are relevant, actually support referral. *See* Req., 4-6, 22-24. To start, Patent Owner cites past reexamination requests, none of which involve, or are related to, the '879 patent or related patents currently being challenged in IPR2025-00814 ('217 patent) and IPR2025-00816 ('456 patent). The reexaminations that Patent Owner cites relate to older technology asserted in litigation more than 13 years ago, and all patents challenged in these reexaminations are now expired. Indeed, some of those patents issued as early as 1999. In fact, the only reason Patent Owner provides as to why the reexaminations are relevant here is that they were filed by Petitioner. Thus, they do not relate to any settled expectations for these patents.

And contrary to Patent Owner's assertion, any time that passed between the prior challenges and this IPR does not reflect Petitioner's "acquiescence to the

validity of Align's patents."[2] *See* Req., 6, 23-24. Rather, it demonstrates Petitioner's commonsense approach of not burdening the Board with IPRs challenging patents that were not being asserted against Petitioner (or anyone). Indeed, Petitioner filed the prior *ex parte* reexaminations involving different patents after being accused of infringing those patents in district court and the ITC. Thus, the prior proceedings do not support Patent Owner's arguments that settled expectations support discretionary denial.

B. Strength of Petitioner's Unpatentability Grounds

The Petition's strong merits counsel against discretionary denial. Patent Owner characterizes the Petition's merits as "weak," arguing that the Petition (1) relies on "recycled references" and (2) fails to "properly address[] known findings supporting nonobviousness." Req., 18-24. As detailed herein, however, each of these arguments fails.

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[2] Patent Owner's claim that Petitioner "sat on its hands for year" despite having "know[n] of this patent family since 2017" is contradicted by the fact that the '217, '879, and '456 patents had not issued for much of that time, and thus, it would have been impossible to have challenged the validity of those patents at that time.

1. The Petition's Ground Includes Becker and Sachdeva, Which Teaches the Claim Limitation Found Missing from the Prior Art

Patent Owner's criticism of the Petition as "weakly based on recycled references" fails because it ignores that the Petition's invalidity ground includes new, non-cumulative art—Becker and Sachdeva—that squarely discloses key claim limitations that the Examiner and/or Board deemed missing from the prior art. *See* Section II.A.1-2, *supra.* Moreover, Chishti-511 and Chishti-876 are used for their disclosures of conventional features the Office agreed the prior art taught, and Patent Owner does not dispute the materiality of these references. *See* Section II.A.3, *supra*. Petitioner's reliance on previously considered prior-art references for such features does not support discretionary denial here, where new, non-cumulative references disclose the exact feature deemed missing from the prior art, and there is evidence of material error by the Office. *See* Sections II.A-C, *supra*.

2. The Petition Appropriately Addresses Relevant Findings From the '444 IPR

Patent Owner's criticism that Petitioner allegedly failed to rebut the Board's teaching away findings in the '444 IPR fails for several reasons. Req., 19-21.

First, Patent Owner's assertion that Petitioner failed to address relevant findings is false. The Petition appropriately addresses and rebuts prior-art evidence describing the disadvantages of round-tripping, including the relevant prior art teaching cited in the '444 IPR. During the '444 IPR, the Board was persuaded that

"because Chishti '876 uses the terms 'while avoiding' and 'highly undesirable' in connection with the use of 'round tripping,' [] Chishti '876 sufficiently discourages the practice of 'round tripping' enough to teach away from that practice." Ex-1008, 11. The Petition acknowledges the Board's determination in the '444 IPR that Chishti-876 and Chishti-511 did not disclose the claimed "round-tripping" limitation, and provides a thorough analysis of why the prior art cited in the Petition discloses the claimed round-tripping feature. The Petition explains the prior art matches the disclosure of the '879 patent in terms of identifying the general concept of round-tripping as something that should be avoided if possible, but that was also understood to be a necessary option for some patients, even if only as "a last resort." Pet., 16-17 (citing Ex-1003, ¶¶66-71); *see also* Pet., 26-27 ("Although round-tripping can have disadvantages, a POSITA would have recognized that for some patients, there may be no other option other than to roundtrip one or more teeth, particularly if the patient or clinician wishes to avoid extracting one or more teeth.") (citing Ex-1003, ¶82; Ex-1001, 13:13-19); Pet., 27 ("a POSITA would have been motivated to include roundtripping as one feature in a system with robust software for generating treatment plans for a broad range of patients with different needs, and this would have been obvious, even if those features are only used in rare cases or as a last resort for patients that might otherwise not be able to be treated") (citing Ex-1003, ¶82); Pet., 17-18 (discussing the prior art's disclosure of the disadvantages

of round-tripping and explaining that "while it is preferable to avoid ***unnecessary*** indirect movement techniques, for some patients, some indirect movement may be necessary.").

Second, the Board's finding in the '444 IPR that Chishti-876's disclosure teaches away from the combination proposed in that proceeding does not weigh against institution here because the Petition involves different evidence of obviousness, including different evidence for the claimed round-tripping feature. Unlike the '444 IPR, the Petition proposing combining Chishti-511 with ***Becker's*** disclosure of round-tripping, not any round-tripping disclosure from Chishti-511 or Chishti-876. *See* Section II.A.1, *supra*. Nothing in Chishti-511 or Becker teaches away from the claimed combination, nor does Patent Owner allege that either reference does. In fact, Chishti-511 states that the general concept of round-tripping—defined as "any motion of a tooth in any direction other than directly toward the desired final position"—is "sometimes necessary to allow teeth to move past each other." Ex-1004, 4:13-16.

The Petition also provides a thorough obviousness analysis for the Petition's proposed combination that addresses, and is consistent with, the Board's "round-tripping" findings in the '444 IPR. Pet., 16-18, 23-29. This approach is consistent with the Board's express recognition that evidence of secondary considerations may weigh differently against different evidence of unpatentability. *See Geotab*,

IPR2023-00504, Paper 11 at 48-49 (declining to discretionarily deny under § 325(d) based on the Board's treatment of secondary considerations from prior proceedings involving different references and acknowledging that "the Board weighs secondary considerations against the scope and content of the *asserted prior art* and any differences between that art and the challenged claims") (emphasis added).

Moreover, the cited case law does not support Patent Owner's position that the Petition is "incurably deficient." *See* Req., 20-21. In *Gilead Sciences, Inc. v. United States*, the evidence of nonobviousness was "well-known evidence of unexpected results ***in the prosecution record***" of the challenged patent and this evidence played a "pivotal role . . . in securing allowance of the claims." IPR2019-01456, Paper 17 at 50, 52 (PTAB Feb. 5, 2020). Here, there is no analogous assertion by Patent Owner that the Examiner relied, during prosecution, on the alleged teaching away evidence from the '444 IPR, which involved a different patent and a different combination of references than that presented in the Petition.

Finally, Patent Owner's argument should be rejected because it is inconsistent with both the Board's prior findings in the '444 IPR and with Patent Owner's own arguments. The Board found that Chishti-511's round tripping disclosures related to "something different than the 'round tripping' required by the '444 patent." Ex-1008, 16. And Patent Owner's Request itself argues that Chishti-511's generic use of the term "round-tripping" is an "**entirely different operation**" from that claimed

in the ’879 patent. Req., 30-31 (“Chishti-511’s use of the term ‘round-tripping’ refers to an **entirely different operation** from what the term means in the ’444 patent (and its continuation, the ’879 patent)” and “regardless of what Chishti-511 may or may not teach regarding its ‘round-tripping,’ this does not speak to the round-tripping disclosed and claimed by the ’879 patent”); *see also* Section II.A.1, *supra*. Patent Owner fails to explain how the Chishti prior art’s statements related to a *different* operation could teach away from the claimed technique, which is disclosed in Becker. The answer is that, by Patent Owner’s own argument, Chishti’s statements have no bearing on the applicability of Becker, and the Petition fully explains why a person of skill in the art would have been motivated to combine the prior art with Becker’s teachings. *See* Pet., 16-18, 23-29.

3. The Petition Is Not a Follow-On Petition and Does Not Trigger “Roadmapping” Concerns

Patent Owner’s assertions of improper “road mapping” (Req., 22-23) are meritless because the instant Petition challenges a different patent than the first filed petition. It is not a serial, or follow-on, petition, and concerns of “road mapping” therefore do not apply.

The only case cited by Patent Owner to support its assertion that the Petition raises “roadmapping” concerns is inapposite because it relates to “staggered petitions challenging the same patent and same claims.” *See Gen. Plastic Indus. Co.*

v. Canon Kabushiki Kaisha, IPR2016-01357, Paper 19 at 15 (PTAB Sep. 6, 2017) (precedential §II.B.4.i) (listing factors relevant to determining whether to exercise discretion to follow-on petitions after the Board's denial of one or more first-filed petitions ***on the same patent***); *see also id.* at 18 n.14 ("Allowing similar, serial challenges ***to the same patent***, by the same petitioner, risks harassment of patent owners and frustration of Congress's intent in enacting the Leahy-Smith America Invents Act." (citations omitted)).

Patent Owner has not identified any case where a second petition was denied for improper "roadmapping" over a first petition where, as here, the first and second petitions challenge different claims of different patents.

C. No Forum Has Adjudicated Any Claim of the Challenged Patent

No forum has yet considered the validity of the '879 patent. Other than this proceeding, the only case involving the '879 patent was the district court litigation. No claim of the '879 patent has been subject to reexamination, and the '879 patent has not been reissued. No prior PTAB decision has addressed the specific combinations or rationales now presented. Now that the '879 patent is no longer asserted in district court litigation, the Board is the only forum currently capable of adjudicating prior art invalidity issues against the challenged patent.

V. PATENT OWNER WAIVED ITS RIGHT TO RAISE OTHER BASES FOR DISCRETIONARY DENIAL

In its Request, Patent Owner only argues for discretionary denial based on *Advanced Bionics*, *Fintiv*, and settled expectations. Patent Owner should not be authorized to file a reply brief to supply new arguments supporting discretionary denial. This is because Patent Owner waited to withdraw the '879 patent from the litigation until ***after*** submitting its request for discretionary denial and, in doing so, wasted the Board's finite resources by asking it to consider arguments in its Request that are now moot. Moreover, no good cause for additional briefing exists due to changed circumstances because Patent Owner should have reasonably foreseen that it would withdraw the '879 patent from litigation less than two weeks after submitting its Request. Rather than anticipating such a possibility, Patent Owner limited the arguments advanced in its Request to its stale *Fintiv* arguments and *Advanced Bionics*. Patent Owner's tactics should not be rewarded with discretionary denial or with the opportunity to present new arguments.

VI. CONCLUSION

For the foregoing reasons, Petitioner requests that the Director deny Patent Owner's request for discretionary denial and refer the Petition to the Board for further consideration on the merits.[3]

Respectfully submitted,

Dated: August 8, 2025

By: /Luke McCammon/
Luke McCammon, Lead Counsel
Reg. No. 70,691

[3] Petitioner reserves the right to challenge the March 26, 2025 Interim Process for PTAB Workload Management at least because it is legally invalid as (1) exceeding the Director's authority, (2) arbitrary and capricious, and (3) adopted without notice-and-comment rulemaking.

CERTIFICATE OF COMPLIANCE

Pursuant to §42.24(d) and the Director's Memorandum on Interim Processes for PTAB Workload Management, the undersigned certifies that this paper contains no more than 14,000 words, not including the portions of the paper exempted by §42.24(b). According to the word-processing system used to prepare this paper, the paper contains 8,313 words.

Respectfully submitted,

Dated: August 8, 2025

By: /Luke McCammon/
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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Petitioner's Opposition to Patent Owner's Request for Discretionary Denial** was served on August 8, 2025, via email directed to counsel of record for the Patent Owner at the following:

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