

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. IPR2025-00817
Patent No. 10,791,936

**PATENT OWNER'S BRIEF IN SUPPORT OF
DISCRETIONARY DENIAL**

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Patent Owner Align Technology, Inc. (“PO” or Align) requests the Director to exercise discretion to deny institution of *inter partes* review of U.S. Patent No. 10,791,936 (“the ’936 patent”), pursuant to Memorandum, *Interim Processes for PTAB Workload Management* (USPTO Dir. Mar. 26, 2025) (“Workload Memo”).

I. INTRODUCTION

The present case was already subject to a failed IPR challenge (IPR-----), where the Board denied institution on the merits. Here, Petitioner attempts a second bite at the apple based on a reference Petitioner fails to mention is a companion publication to a reference (with the same author) the Examiner considered and rejected during *ex parte* prosecution as teaching away from the subject matter claimed. In addition to concerns of using a prior unsuccessful IPR of the ’936 patent as a roadmap, Petitioner not only fails to grapple with the Office’s prior findings but also raises a challenge based on art that is even more deficient regarding the same limitation the Board identified as absent from the prior art in its prior decision denying institution.

Regardless, the present case, like all the related IPR petitions (IPR2025-00814 – IPR2025-00821), is a waste of Board resources given the duplication of issues with the advanced-stage parallel district court case and, therefore, warrants exercising discretion to deny the challenge. Due to Petitioner’s delay, the Board’s final written decision wouldn’t be expected until 6 months after the trial in the

Western District of Texas. Petitioner's lack of diligence is inexcusable and the resulting waste of judicial resources self-inflicted. Despite challenging a patent that issued and was unsuccessfully challenged in an IPR years ago, litigation between the parties since 2011, and dozens of failed patent challenges initiated more than a decade ago, Petitioner went dormant for years and waited until the last day of the statutory period to file IPRs.

The *Fintiv* framework favors discretionary denial, as Petitioner is currently pursuing the same invalidity arguments raised in the petition in a parallel district court proceeding. Petitioner has long known of Align's patent portfolio, including the patents challenged in its currently-pending IPR challenges, but it waited to file this IPR until nearly the statutory bar date.¹ As a result, the district court case is now at an advanced stage and Petitioner's arguments will be addressed by the

¹ Petitioner has now belatedly filed IPR challenges against four related multilayer dental appliance patents (IPR2025-00818, -00819, -00820, & -00821), three related dental treatment planning patents (IPR2025-00814, -00815, & -00816), and a dental model imaging patent (IPR2025-00817). All eight challenged patents (plus another related patent unchallenged in IPR) are asserted in the same copending district court litigation.

district court months before a final written decision in this proceeding. Petitioner's promise of a *Sotera* stipulation subsequent to institution does not mitigate the waste of judicial resources arising from overlapping issues, given the late stage of the case by the time of an expected institution decision, and given Petitioner's failure to challenge (or direct its stipulation to) all of the patents asserted in the parallel litigation.

The weakness of the petition and the parties settled expectations further support denial of institution. Petitioner was aware of the Office's prior findings—including in the prior IPR of the same patent—that the prior art failed to disclose certain claim elements related to replacing portions of a dental model with new scans of modified intraoral surfaces. Yet Petitioner fails to show that the art it relies on teaches these same limitations, resorting instead to mischaracterization of the art's disclosure. Indeed, Petitioner fails to even acknowledge the Office's finding that prior art with the same filing date and overlapping inventors taught away from these limitations that Petitioner claims to be present. The Office already considered and rejected the closest prior art, and Petitioner's lengthy acquiescence to the validity of Align's patents further supports denial of institution based on the parties' settled expectations.

Accordingly, the present petition is a poor use of the Board's limited time and resources. Align respectfully requests the Director exercise discretion and *deny institution*.

II. BACKGROUND

Align Technology, Inc. designs, develops, manufactures and markets high-technology, custom-manufactured orthodontic devices, as well as providing related products and services including dental scanning and treatment planning.

Petitioner ClearCorrect, a competing dental-aligner manufacturer, has been aware of Align's patent portfolio since at least 2011, when Align first sued Petitioner for patent infringement in *Align Technology, Inc. v. ClearCorrect Inc.*, No. 4:11-cv-00695 (S.D. Tex. Feb. 28, 2011). Align also filed two ITC actions against Petitioner in 2012: *In the Matter of Certain Incremental Dental Position Adjustment Appliances and Methods of Producing Same*, Inv. No. 337-TA-562; and *In the Matter of Certain Digital Models, Digital Data, and Treatment Plans for Use in Making Incremental Dental Positioning Adjustment Appliances, the Appliances Made Therefrom, and Methods of Making the Same*, Inv. No. 337-TA-833.

Beginning in 2015, Petitioner launched a multi-year campaign challenging Align's patent portfolio. From 2015 to 2017, Petitioner filed a total of 26 reexamination requests challenging Align's patents: Reexamination Control Nos.

90/013,581;

90/013,947;

90/013,457;

90/013,904;

90/013,905;

90/013,917;

90/013,606;

90/013,946;

90/013,775;

90/020,116;

90/013,506;

90/013,788;

90/014,090;

90/013,491;

90/013,911;

90/013,912;

90/013,918;

90/013,607;

90/013,777;

90/014,049;

90/013,579;

90/013,981;

90/013,505;

90/013,928;

90/013,929; and

90/013,931.

These challenges failed almost entirely: only one patent claim was canceled (*see* Reexamination Control No. 90/013,788) and only a single patent claim was amended (*see* Reexamination Control No. 90/013,607), while all other challenged claims were upheld as patentable.

Petitioner also filed two IPRs challenging Align's patents, neither of which resulted in any canceled claims. *See ClearCorrect Operating LLC v. Align Technology, Inc.*, IPR2016-00270, Paper 55 (Apr. 9, 2019) (terminating case after remand from Federal Circuit); *ClearCorrect Operating LLC v. Align Technology, Inc.*, IPR2017-01829, Paper 10 (Feb. 5, 2018) (denying institution). The second of these cases challenged U.S. Patent No. 8,038,444 (the '444 patent), which had never been asserted against Petitioner, but which is now asserted in the parallel litigation.

After its unsuccessful challenges to Align's patent portfolio and its proven infringement in both the ITC and in district court, Petitioner settled with Align.

EX2008, ¶2. Petitioner gave up on its strategy of challenging Align’s patent portfolio before the Office, and as of 2017, ceased filing new challenges against Align’s patents. Petitioner maintained this state of acquiescence until the filing of these IPR petitions in April of 2025.

In 2024, Align filed a new lawsuit (the “parallel litigation”) to remedy Petitioner’s continuing infringement of nine of Align’s patents. EX1023. The asserted patents include the ’936 patent, the ’444 patent and three related patents, and four other patents infringed by aligners made using materials manufactured by Bay Materials, LLC, which like ClearCorrect is a member of the Straumann Group. *Id.*, ¶42. The parallel litigation is currently pending in the Western District of Texas before Judge Albright, with jury trial scheduled on May 11, 2026.

Petitioner waited a year after being served with the complaint alleging infringement of these patents; then, with just ten months remaining before the court had scheduled trial, Petitioner filed IPR petitions challenging eight of the nine asserted patents, including the instant petition challenging the ’936 patent. *See* EX2002 (setting Feb. 16, 2026, trial date); EX2003 (updating trial date to May 11, 2026). The ninth is the ’444 patent that Petitioner previously challenged unsuccessfully in IPR2017-01829. Petitioner is now time barred on the ’444 patent, making it impossible for Petitioner’s IPR petitions to resolve the parallel litigation.

As explained below, the Director should exercise discretion to deny institution of the instant petition.

III. APPLYING *FINTIV*, THE DIRECTOR SHOULD EXERCISE DISCRETION TO DENY THE PETITION UNDER §314(A)

The Director should exercise discretion under 35 U.S.C. §314(a) to not institute this proceeding. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (March 20, 2020) (precedential). As Petitioner admits, a parallel District Court litigation is ongoing between the parties before Judge Albright in the Western District of Texas. *See* Pet., 84; *supra*, §II. This parallel litigation is already in its late stages and will finish long before a final written decision would issue in these proceedings. There is significant overlap of issues between this proceeding and the parallel litigation, and additional factors including settled expectations of the parties and the weakness of the petition grounds further favor discretionary denial.

A. Factor 1: The District Court Litigation Has Not Been Stayed And Is Unlikely To Be Stayed Even If This Petition Were Instituted

This factor weighs against institution because a stay of the parallel litigation is highly unlikely. Petitioner has not sought a stay, and the Board's institution decision is expected by November 8, 2025. Because the parallel litigation will be in its late stages by the expected time of the institution decision, it is unlikely that Judge Albright would grant a stay even if the Petition were instituted. *E.g., Sonrai Memory Ltd. v. Micron Tech., Inc.*, No. 1:23-CV-01407-ADA, 2024 U.S. Dist.

LEXIS 231280, at *2, *7 (W.D. Tex. May 29, 2024) (Albright, J.) (denying stay when *Markman* hearing was held and fact discovery opened two weeks before institution).

In particular, by mid-November—just six months before the trial is to begin—infringement and invalidity contentions will be finalized, document production will be complete, fact discovery will be closed, and expert reports will be imminently due. *See* EX2003. The *Markman* hearing was completed in the parallel litigation three months before the instant petition was even filed, and a final claim construction order has already issued. *Supra* §II. Given the advanced stage of the parallel litigation, the district court will have “expended significant resources” by the time of an institution decision and would be unlikely to grant a stay. *See Sonrai*, 2024 U.S. Dist. LEXIS 231280, at *2, *7.

Furthermore, although Align asserted nine patents against Petitioner in the parallel litigation, Petitioner only filed IPR challenges against eight of these patents. In 2017, Petitioner filed an IPR challenge against the remaining patent, U.S. Patent No. 8,038,444, but institution was denied on the merits. *See ClearCorrect Operating LLC v. Align Technology, Inc.*, IPR2017-01829, Paper 10 at 17 (Feb. 5, 2018). Petitioner is time barred from challenging the ’444 patent in an *inter partes* review, so even granting all pending IPR petitions would not eliminate all patents from the parallel litigation. These circumstances further

diminish any chance of a stay. *See, e.g., Smart Mobile Techs. LLC v. Apple Inc.*, No. 6:21-cv-00603-ADA, 2023 U.S. Dist. LEXIS 137593, at *18-19 (W.D. Tex. Aug. 8, 2023) (Albright, J.) (denying stay where institution was granted for some but not all asserted patents).

Accordingly, Factor 1 favors denying institution.

B. Factor 2: A Final Written Decision Would Likely Issue Six Months After Trial

This factor weighs against institution because trial is scheduled to begin six months before the projected final written decision is due. “If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution....” *Fintiv*, Paper 11 at 9.

Over a year into the litigation, the parties in the parallel litigation jointly requested trial in May 2026, and the court has issued a revised scheduling order setting trial for May 11, 2026. EX2003; EX2006.² Were the Director to not

² While the parties and the Court have all agreed on a May 2026 trial date, Petitioner (ClearCorrect) advocated for an even more accelerated pre-trial calendar. For example, Petitioner requested earlier pre-trial dates for the service of final infringement and invalidity contentions and the close of fact and expert discovery

discretionarily deny institution, the Board's institution decision would be expected by November 8, 2025. Accordingly, the projected statutory deadline for a final written decision would be November 8, 2026, six months after the trial date of May 11, 2026. Judge Albright is unlikely to grant any further adjustment to the trial date, as he has a practice of "not mov[ing] the trial date except in extreme situations." EX2005. The scheduling of the district court's trial date six months before the expected date of final written decision weighs strongly in favor of denying institution. *See, e.g., Samsung Elecs. Co. v. TrueSight Commc'ns LLC*, IPR2025-00123, Paper 12 at 7, 10-11 (Apr. 22, 2025) (instituting trial over *Sotera* stipulation where district court trial had been scheduled "at least six months before the projected statutory deadline for a final written decision," finding this factor "favors discretionary denial"); *Nokia of Am. Corp. v. Cellco P'ship*, IPR2025-00037, Paper 14 at 10, 15-16 (Apr. 25, 2025) (same).

The court's recent adoption of a trial date agreed to by both parties gives confidence that it is no mere preliminary estimate, but even if the Director

than was ordered by the Court. *See* EX2006; EX2003. Thus, while Petitioner was exercising a lack of diligence in bringing its IPR challenges, it was advocating for an accelerated pre-trial calendar.

considers median time-to-trial statistics instead of the scheduled trial date, the trial would still precede the expected final written decision. The median time-to-trial for the Western District of Texas as a whole is 25 months, with Judge Albright having the same median time-to-trial. EX2004. As the complaint was filed and served in the parallel litigation in April 2024, a 25-month time-to-trial would predict a trial date of May 2026, six months before a predicted final written decision date in this case. The median time-to-trial statistics thus dictate the same conclusion as the scheduled trial date: that trial will occur long before a final written decision would be expected.

Accordingly, Factor 2 strongly favors denying institution.

C. Factor 3: The Court And Parties Have Invested Heavily In The Parallel Litigation

This factor weighs against institution because the parties and the court have already invested and will continue to invest significant resources in the parallel litigation. The Board weighs “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, Paper 11 at 9. The Board has also explained that if, at the time of an institution decision, the district court will have issued substantive orders related to the challenged patent, such as a claim construction order, this fact weighs in favor of denial. *See Fintiv*, Paper 11 at 9-10. Here, the *Markman* hearing took

place before the petition was even filed and the district court has already issued its final claim construction order. Accordingly, the parties and the court have invested heavily, given the advanced stage of the litigation.

Moreover, the Board has explained it considers the Petitioner's diligence in filing the Petition in weighing this factor. *Id.*, 11 (considering whether "the petitioner filed the petition expeditiously, such as promptly after becoming aware of the claims being asserted..."). The Petitioner here has been anything but diligent.

The complaint in this case was served on April 15, 2024, and Petitioner waited until the last day before its statutory bar date to file the instant petition. Consequently, the parties and the district court had already completed a substantial amount of work before the petition was even filed. Fact discovery began and preliminary infringement contentions were served in July 2024, and invalidity contentions were served in September 2024, seven months before the instant petition was filed. *See* EX2002. The district court held a *Markman* hearing and issued preliminary constructions in January 2025, three months before the petition was filed. *See* EX2002; EX1023. The district court subsequently issued a final claim construction order adopting substantially identical constructions. *See* EX2001.

On or about the time the Board decides whether to institute this IPR in November 2025, still more resources will have been expended. Document production will have long been substantially completed (July 18, 2025); final infringement and invalidity contentions will be served (August 22, 2025); fact discovery, including all depositions of fact witnesses, will have closed (October 17, 2025); and expert discovery will be well underway with expert reports due contemporaneously (Nov. 14, 2025). EX2003. In sum, the parallel district court litigation will be in its late stages with a substantial amount of work already completed.

As the Director has noted, “factor 3 strongly favors discretionary denial” when around the time of institution, “the parties had served extensive infringement and invalidity contentions, served opening and rebuttal expert reports, filed claim construction briefs, and conducted several depositions” and the court “also had held a claim construction hearing and construed the disputed claim terms.”

Motorola Sols., Inc. v. Stellar, LLC, IPR2024-01205, Paper 19 at 3 (Mar. 18, 2025) (Order Granting Director Review, Vacating the Decision Granting Institution, and Denying Institution of *Inter Partes* Review). Here, the similarly late posture and degree of expended resources confirm that factor 3 strongly favors denying institution.

D. Factor 4: There Is Significant Overlap Between Issues Raised In The Petition And In The Parallel Litigation

This factor weighs against institution given the significant overlap between the petition and the parallel litigation. The parallel litigation involves the '936 patent challenged in the instant proceeding as well as eight other patents, seven of which are subject to IPR challenges by Petitioner.

In its invalidity contentions, Petitioner has identified the same art advanced in the instant petition, along with other art it reasonably could have raised earlier. *See* EX2009, 68-69 (identifying references including Boerjes, Geng, and Babayoff, matching art asserted in instant IPR). Furthermore, Petitioner has identified other alleged prior art, including system and device art, as available in obviousness combinations with the same art relied on in the petition grounds. EX2009, 60-67 (alleging device and system art), 70-71 (identifying references as teaching knowledge in art), 232 (identifying various combinations including some or all **references cited in instant IPR** along with system art: “Boerjes Grounds: One or more of **Boerjes**, Cadent iTero, Lava C.O.S., CEREC, OraScanner, and/or E4D alone or combined with one or more of **Geng**.... Babayoff Grounds I: Boerjes Grounds alone or combined with **Babayoff-065**....”).

While Petitioner has offered a *Sotera* stipulation not to pursue for this patent “any ground raised or that could have been reasonably raised in this petition” (Pet.,

76-77),³ the Director has confirmed that such a stipulation does not eliminate the overlap of issues considered in factor 4, as such a stipulation is not sufficient to ensure that IPR proceedings are a “true alternative” to district court proceedings. *Motorola*, Paper 19 at 3-4; see also Chief Admin. Pat. J., *Guidance on USPTO’s Recission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation”* 2-3 (March 24, 2025) (*Sotera* stipulation not dispositive of *Fintiv* analysis). The stipulation offered here does little to mitigate overlap of issues and waste judicial resources for several reasons.

First, Petitioner at district court has entangled the same prior art references asserted here together with non-IPR eligible art and arguments in a way that minimizes the impact of its stipulation. Here, as in *Motorola*, Petitioner’s district court invalidity contentions “include combinations of the prior art asserted in these proceedings with unpublished system prior art,” which Petitioner’s stipulation does not moot. *Motorola*, Paper 19 at 4; cf. *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th

³ Petitioner states that all defendants in the parallel litigation have agreed to be bound by the stipulation. To avoid confusion or misleading argument from Petitioner, the defendants named in the parallel litigation are member entities of the same Straumann Group.

1354, slip op. at 15-16 (Fed. Cir. May 7, 2025) (any ground including art “known or used by others, on sale, or in public use” is a ground that “could not have been raised during the IPR”).

Second, the belated filing of the petition and advance stage of the litigation ensures that significant amounts of overlapping efforts will be completed that are not undone by stipulation. Specifically, the late timing of the institution decision, scheduled after all fact discovery is complete and at about the same time expert reports are due, means that most of the overlapping efforts in the district court proceeding will already have occurred before Petitioner’s stipulation could go into effect.

Third, Petitioner has offered no stipulation regarding the ’444 patent, which is not subject to an IPR challenge, so the district court will still be required to consider a full panoply of art combinations during trial for at least that patent. This further diminishes any potential effect Petitioner’s stipulation might otherwise have had regarding judicial efficiency.

Accordingly, Petitioner’s *Sotera* stipulation at best mitigates only some concerns of duplication, and this factor still favors denial.

E. Factor 5: The Parties Are The Same In Both Proceedings

Petitioner is a defendant in the parallel litigation, as is each real party-in-interest, so “this factor weighs in favor of discretionary denial.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 15 (May 13, 2020) (informative).

F. Factor 6: Other Circumstances Weigh Against Institution

Consistent with the Director’s memorandum providing for interim processes for PTAB workload management, additional factors favor discretionary denial. *See* Workload Memo, 2 (“all relevant considerations” to be evaluated in determining whether to exercise discretionary denial).

1. The petition presents a deficient case not warranting further reconsideration of the Office’s prior findings

To begin with, the merits of the petition are weak, as the petition fails to overcome deficiencies in the prior art found by both the Board in a prior IPR and by the examiner during prosecution.

Claim 1 recites steps of user-identification of a portion of a computer-generated dental model to be removed, and then replacing “at least a portion of the removed surface portion of the model using the received second scan data of the patient’s teeth including surface data of a physically changed portion of the patient’s intraoral cavity,” and the remaining independent claims include similar limitations. *See* EX1001, claims 1, 9, 17; Pet., 58-62, 80-82 (mapping elements of claims 9 and 17 to prior discussion of claim 1). As the petition concedes, the ’936

patent was previously challenged in an IPR petition by 3Shape, and the Board found, among other deficiencies, that the prior art failed to disclose this element. *See 3Shape A/S v. Align Technology, Inc.*, Paper 16 at 15 (Jan. 26, 2022); Pet., 8.

This finding by the Board is consistent with the prosecution of the '936 patent, in which the examiner found, far from teaching or suggesting a step of replacing a user-selected portion of an earlier model with new scan data, the prior art actually “teaches away from this, teaching that entirely new scans should be made” when intra-oral modifications are made. EX1002, 96. In support of this conclusion, the examiner relied on WO2007084647 (EX2013), a companion application to the Boerjes reference (EX1004, WO2007084727) now used as the petition’s primary reference in this IPR. The Boerjes reference is assigned to the same entity (3M Innovative Properties Company), shares a common priority claim (to US60/761,078), has the same filing date (Jan. 19, 2007), and includes overlapping inventors (including Boerjes himself). *Id. Compare* EX1004, face; with EX2013, face. The petition never addresses this overlap or even acknowledges the Office’s prior finding, much less explain the inconsistency between Petitioner’s characterization of the Boerjes references with contradictory statements by Boerjes and his co-inventors in a simultaneously-filed application. This deficiency in the petition not only provides a basis for denial not only under 35 U.S.C. §325(d) (as Petitioner has advanced similar art and arguments as

considered during prosecution, yet failed to show material error by the examiner), but also supports denial under the *Fintiv* framework. See *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GMBH*, IPR2019-01469, Paper 6 at 8-9 (Feb. 13, 2020) (precedential) (framework for denial under Section 325(d)); *Fintiv*, Paper 11 at 16 (“For example, factors unrelated to parallel proceedings that bear on discretion to deny institution include...considerations implicated by 35 U.S.C. § 325(d).”).

Indeed, to camouflage the deficiencies in its challenge, the petition misleadingly clip-quotes and mischaracterizes the disclosure in its primary grounds reference. As noted above, the claims recite limitations requiring the replacement at least a portion of a user-selected region of a dental model with new scan data after physically changing the scanned dental surface region. The petition maps this to a new scan of a region in which a tooth preparation is modified (e.g., by cutting down the surface of a tooth). See Pet., 41 (mapping “additional surface preparation” to “a physically changed portion of the patient’s intraoral cavity”). Yet the portions of Boerjes cited by the petition as purportedly teaching such operations fail to do so.

For example, the petition cites to paragraph 199 of Boerjes as purportedly teaching an updated partial scan to replace a sub-portion of an existing digital model after a physical change (additional preparation), yet this paragraph does not

teach such an operation. The portion of Boerjes cited by the petition states “This may include, for example, new scanning to replace apparently erroneous or inadequate scan data, or a new scan of the dental subject matter following, e.g., additional surface preparation consistent with errors identified during quality control.” EX1004, [00199]. The *replacement* operation described here is of “erroneous or inadequate scan data” by re-scanning portions of the same existing structure. Separately, and by contrast, when “*additional surface preparation*” is performed, Boerjes calls for an entirely “new scan of the dental subject matter,” rather than piecemeal updating an old scan with a replacement of a region showing modified and updated dental structure. The petition clip-quotes and mischaracterizes this disclosure in the art to conflate distinct operations and camouflage deficiencies vis-à-vis the challenged claims.

This distinction is consistent with the disclosure in Boerjes paragraph 196, which is also cited by the petition for this and associated claim elements. *See* Pet., 40-41, 45 (citing EX1004, [00196]). In this paragraph, Boerjes states that “an evaluation may conclude with an identification of regions of a prepared tooth surface requiring additional preparation or reduction, or regions of a digital model requiring additional or supplemental scanning due to incomplete, erroneous, or potentially erroneous data.” EX1006, [00196]. Here again, Boerjes’ identification of “regions of a digital model requiring additional or supplemental scanning” is

associated with re-scanning an existing structure (not a physically modified one later in time) to address “incomplete, erroneous, or potentially erroneous data.” This is also distinct from “regions of a prepared tooth surface requiring additional preparation or reduction,” which (as Boerjes describes in paragraph 199) require a new scan, not scanning to amalgamate two different physically modified structures and piecemeal replace a region of a prior scan. *Id.* Thus, rather than teaching the required replacement of data in a prior model subsequent to physical modifications, these portions of Boerjes instead teach an entirely new scan in such a case, consistent with the findings of the examiner regarding Boerjes’s simultaneously-filed application (EX2013).

Other disclosure Petitioner relies on for these claim steps is similarly deficient, but the petition clip-quotes and mischaracterizes content to camouflage shortcomings in the art. For example, Petitioner points to paragraph 163 of Boerjes as teaching “combining historical three-dimensional data with a three-dimensional representation of the prepared surface.” Pet., 45 (quoting EX1004, [00163]). However, this quotation is misleading, as Boerjes does not disclose combining these data *into a new model*; rather Boerjes describes this as being performed so that “the temporary restoration (or a final restoration) may be fabricated.” EX1004, [00163]. In other words, Boerjes is using both a historical model and a new (post-preparation) model to fabricate a temporary or final restoration (e.g., making a

crown to match both the original tooth surfaces and the new preparation surfaces), not combining them to make a new dental model. Likewise, its annotations added to Fig. 4 (*see, e.g.*, Pet., 42, 44) are grounded in Petitioner's misstatements and misunderstandings of Boerjes, not Boerjes's actual disclosure.

In sum, the petition mischaracterizes Boerjes's disclosure in an attempt to manufacture teachings it needs to reach the claims of the '936 patent. Yet this argument is inconsistent both with the teachings of Boerjes as well as the Office's own findings regarding the prior art, including a patent application simultaneously filed by Boerjes and other co-inventors. Petitioner fails to address the Office's findings and provides no adequate explanation for its inconsistent reading of Boerjes. The petition is thus fatally flawed, favoring discretionary denial.

2. The Office's prior expenditures and the parties' settled expectations also favor denial

The Office's prior expenditure of resources in response to challenges raised against Align patents (including many previous challenges by ClearCorrect), and the resulting settled expectations of the parties, further favor discretionary denial. Stewart Memorandum, 2. As discussed above, the Office as previously considered and rejected closer prior art and previous challenges to the present patent, both during *ex parte* prosecution and a previous IPR challenge. In addition, the Director has held that a petitioner's awareness of a patent owner's applications related to a

challenged patent “and failure to seek early review of the patents favors denial,” holistically outweighing even multiple *Fintiv* factors that may otherwise weigh against denial. *E.g.*, *iRhythm Techs. Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 3 (Jun. 6, 2025) (petitioner’s knowledge of one of patent owner’s applications and decision to leave it unchallenged for years after it issued strongly favored discretionary denial for the same and related patents). As discussed above in Section II, Petitioner raised multiple challenges against Align’s patent portfolio dating back a decade, demonstrating Petitioner’s longstanding familiarity with Align’s portfolio. These failed challenges have already resulted in the expenditure of substantial Office resources to no significant effect. For example, between 2015 and 2017, Petitioner filed 26 reexamination requests challenging patents assigned to Align, resulting in only one canceled claim and one amended claim. *Supra* §II.

Petitioner has also raised unsuccessful IPR challenges against Align’s patents in the past, including a petition against a patent that had not been asserted in district court at the time, and which is in the same family as three other patents challenged in its current IPRs. *See ClearCorrect Operating LLC v. Align Technology, Inc.*, IPR2017-01829, Paper 10 at 2 (Feb. 5, 2018) (challenging U.S. Patent No. 8,038,444, of which the patents challenged in IPR2025-00814, IPR2025-00815, and IPR2025-00816 are continuations). The Board denied institution, finding no reasonable likelihood that any claim was unpatentable. *Id.*,

17. Despite knowing of this patent family since 2017, Petitioner then sat on its hands for years. Petitioner has raised no further challenge to any family member, or any other Align patent, until 2025.

In total, Petitioner has now advanced 26 reexamination requests and 10 IPR petitions against Align's patents, with essentially no success to date. *See supra* §II. These unsuccessful challenges against Align's patent portfolio stretching back a full decade not only show a waste of Office resources, but also show that Petitioner abandoned its challenges against Align's patent portfolio and maintained this abandonment for many years. This longstanding acquiescence to the validity of Align's patents, including patents related to those currently challenged by Petitioner, confirms the parties' settled expectations of validity for Align's patents, including the patent subject to the instant petition.

Thus, in view of the settled expectation of the parties, Petitioner's waste of Office resources, and the overall weakness of the petition, the factor 6 considerations weigh in favor of discretionary denial.

Accordingly, given the totality of the circumstances present in this case, discretionary denial is justified.

IV. CONCLUSION

For at least the reasons above, Patent Owner respectfully requests that the Director exercise discretion to deny institution of the petition.

Respectfully submitted,

Date: July 08, 2025

/ Michael T. Rosato /
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Reg. No. 52,182

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 5147 words.

Respectfully submitted,

Date: July 08, 2025

/ Michael T. Rosato /

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V. APPENDIX

Exhibit No.	Description
2001	Claim Construction Order, <i>Align Technology Inc. v. ClearCorrect Operating LLC</i> , et al., No. 24-cv-00187-ADA-DTG (W.D. Tex. Jun. 5, 2025)
2002	Scheduling Order, <i>Align Technology Inc. v. ClearCorrect Operating LLC</i> , et al., No. 24-cv-00187-ADA-DTG (W.D. Tex. Aug. 5, 2024)
2003	Fourth Scheduling Order, <i>Align Technology Inc. v. ClearCorrect Operating LLC</i> , et al., No. 24-cv-00187-ADA-DTG (W.D. Tex. Jun. 12, 2025)
2004	DocketNavigator Median Time-to-Trial Statistics for Judge Alan D. Albright and for W.D. Tex. Overall, July 1, 2020 – July 1, 2025
2005	Judge Albright Patent FAQ, https://www.txwd.uscourts.gov/for-attorneys/judge-albright-courtroom-faq/ (accessed July 3, 2025)
2006	Joint Request to Amend the Claim Schedule, <i>Align Technology Inc. v. ClearCorrect Operating LLC</i> , et al., No. 24-cv-00187-ADA-DTG (W.D. Tex. Jun. 6, 2025) (ECF No. 187)
2007	International Application Publication No. WO 2007/084647 to Kriveshko et al.
2008	Complaint for Damages and Injunctive Relief, <i>Align Technology, Inc. v. ClearCorrect Operating, LLC</i> , Case No. 6:24-cv-00187 (W.D. Tex. Apr. 11, 2024) (ECF No. 1)
2009	ClearCorrect’s Preliminary Invalidity Contentions, <i>Align Technology, Inc. v. ClearCorrect Operating LLC</i> , Case No. 6:24-CV-00187 (W.D. Tex. Sept. 26, 2024)

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing Patent Owner's Brief In Support of Discretionary Denial and accompanying Exhibits 2001-2009 were served on July 8, 2025, on the Petitioner at the electronic correspondence address of the Petitioner as follows:

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