

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 REPLY TO PETITIONER'S OPPOSITION TO THE
REQUEST FOR DISCRETIONARY DENIAL**

On July 8, 2025, Patent Owner Align filed its Discretionary Denial request. Paper 7 (“DD Brief”). August 8, 2025, Petitioner filed its opposition. Paper 8 (“Opp”). The Director authorized this reply. EX3101. While Align disagrees with the entirety of the Opp, this reply addresses certain flaws as authorized.

First, this case presents a straightforward waste of resources pursuant to *Fintiv* as Petitioner’s delay ensures the Board’s FWD would occur well after the scheduled W.D. Tex. trial. DD Brief, 1, 8, 10-12. Speculation regarding potential rescheduling should be given no weight. Opp. 24-29. There is no dispute that the parties here jointly requested trial in May 2026, and the court set trial for May 11, 2026. DD Brief, 10; EX2003, EX2006. This means the projected FWD deadline (November 2026) is six months after the trial date. Judge Albright’s stated practice is “not mov[ing] the trial date except in extreme situations.” DD Brief 11; EX2005. Despite the Opp’s (27) complaints, that practice is still in effect.

Under these circumstances, speculation based on cherry-picked statistics should be given little weight, if any. Boalick Memo (the Board may consider...median time-to-trial statistics”); *see also Innoscience Am., Inc. v. Infineon Techs. Ams. Corp.*, IPR2025-00010, Paper 11 at 9-10 (dismissing similar petitioner speculation about potential postponement of a trial date “which Petitioner itself requested”); *Ericsson Inc. v. Pegasus Wireless Innovation LLC*, IPR2025-00084, Paper 17 at 12-13 (“We are not swayed by Petitioner’s

speculation as to the trial date”); *Cipla Ltd. v. Gilead Scis., Inc.*, IPR2025-00033, Paper 22 at 10 (dismissing petitioner’s similar argument as “merely speculative, and we decline to guess what the district court might do.”). The cases cited in the Opp (28) do not support Petitioner. In *Shenzen*, Factor 2 still favored denial. In *Amazon*, the trial date and projected FWD were in close enough proximity such that it was unclear which would occur first. Neither case involved an agreed-upon and scheduled trial date preceding FWD by 6 months. At bottom, the evidence of record reflects a May 2026 district court trial date, whereas the potential re-scheduling proposed in the Opp is no more than speculative attorney argument.

Second, the Opp argues the district court grounds may narrow “consistent with a *Sotera* stipulation.” Opp. 37. Yet Petitioner’s recent narrowing *maintained* all IPR-asserted art (*see* EX2012, 3-4), and the Opp confirms Petitioner intends to tailor its grounds to circumvent *Sotera*, confirming the stipulation’s minimal effect.

Third, the Opp attempts to subvert the *Fintiv* analysis with extensive focus on the alleged merits of the petition. The DD Brief in discussing Factor 6 briefly discusses that the PTAB already adjudicated the challenged ’936 patent in a prior IPR four years ago and that the currently cited art is consistent with prior art approaches (obtain a new scan following physical modifications of teeth). DD Brief 18-23. The Opp responds with at least the first 19 pages of its brief arguing *Advanced Bionics* and rehashing the alleged petition merits. To the extent the Opp

argues its case presents “compelling merits,” that is both wrong and the incorrect standard. Boalick Memo (discussing a “balanced assessment”).

In any event, there is nothing compelling about the newly cited Boerjes reference. The petition critically relies on Boerjes as allegedly disclosing the key claimed feature of building a composite model of a patient’s teeth by updating an earlier scan of the patient’s teeth specifically with portions of a later scan capturing subsequent physical modifications of the teeth. Boerjes simply fails to provide this disclosure, as is evident from the petition’s reliance on mixed clip-quotes and attorney-annotated figures not found in the reference. DD Brief, 20-23. Indeed, the Opp (11) argues its reading of the challenged claims “meshes perfectly with Figure 4 of Boerjes” yet points to an attorney-supplemented version of that figure, not content from the reference itself. The Opp (3) attempts to falsely cabin the prior IPR challenge as failing due to “a wrong claim construction,” whereas the Board also acknowledged the lack of any “sufficient non-hindsight biased rationale” to modify the prior art to reach the ’936 patent claims. IPR2021-01241, Paper 16 at 15. The Opp’s (3) attempted pivot to an IPR of the different ’192 patent is misplaced as those claims lacked the physical modification limitation at issue here.

Accordingly, Patent Owner respectfully requests the Director exercise discretion to deny institution of the petition.

Respectfully submitted,

Date: August 20, 2025

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

CERTIFICATE OF SERVICE

I certify that the foregoing Patent Owner's Reply to Petitioner's Opposition to the Request for Discretionary Denial (and accompanying Exhibit 2010) was served on this 20th day of August, 2025, on Petitioner at the following electronic service addresses:

Kathleen A. Daley
Anthony J. Berlenbach
Xirui Zhang
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
Kathleen.Daley@finnegan.com
Anthony.Berlenbach@finnegan.com
Xirui.Zhang@finnegan.com
ClearCorrect-IPR-Attorneys@finnegan.com

Respectfully submitted,

Date: August 20, 2025

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