

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 PRELIMINARY SUR-REPLY

The Reply advances two arguments, neither of which withstands scrutiny.

First, the Reply conflates the different standards for discretionary denial and institution on the merits in arguing that trial should be instituted based on the Director's referral. No such prejudicial effect is warranted. The Director's note that the Examiner should have explained why he found the present claims allowable over different art applied in an earlier IPR (IPR2019-00134) of a different patent is of no impact here. Reply, 1 (citing Paper 13). The -134 IPR addressed a different patent with claims of materially different scope compared to the '936 patent's claims, and also addressed different prior art references that nobody, including Petitioner here, has ever asserted satisfy the '936 patent claims.

Second, the Reply (2-5) fails to cure the petition's deficient arguments relying on Boerjes. Like the petition, the Reply continues to distort Boerjes's disclosure in attempt to manufacture a teaching that simply isn't there. Stripped of Petitioner's rewriting, as explained in the POPR, Boerjes simply fails to disclose the operations of forming a composite model by replacing an identified part of a pre-modification model with post-modification scan data as claimed.

I. THE DIRECTOR'S DECISION TO REFER DOES NOT MEAN "TRIAL SHOULD BE INSTITUTED"

Petitioner asserts that "[t]rial should be instituted" because the Director noted that the Examiner should have explained why the claims were patentable over the art (Paley and Kriveshko) applied to different claims in IPR2019-00134.

Reply, 1; Paper 13 at 3-4. This argument fails for multiple reasons.

First, the claims at issue in this case differ from those in of the '192 patent at issue in IPR2019-00134. For example, whereas claim 1 of the '936 patent requires removing a surface portion identified by user input and replacing it with second scan after the surface is physically changed, the Board found that the claims of the '192 patent did “not require removing or deleting,” but could be met by stitching together old and new data of the same structure. EX1026, 29. Moreover, the limitations in claim 18 of the '192 patent involving physical alteration were found to be satisfied merely because Paley had taught that a scan could be performed during a process of tooth surface preparation. *See id.*, 46-47. Thus, the surface would have been altered prior to both scans, not between scans. The art applied to the claims of the '192 patent thus involved corrections of scans without the process claimed in the '936 patent of identifying and removing data to replace with scans reflecting an intervening physical change, thereby producing a composite model. Indeed, the Examiner discussed prior art including Paley and Kriveshko and in the Notice of Allowance, finding it taught away from these claims. EX1002, 374-75. The Examiner was intimately familiar with Paley and Kriveshko, having discussed them at length in a 42-page office action in the parent application. *See* U.S. 16/176,474, Non-Final Office Action of May 17, 2019.

Second, the same issues were not litigated in IPR2019-00134, so the prior

decision does not address the challenge raised here. In that IPR, the Board considered a different combination of prior art, and did not address the Boerjes reference advanced by Petitioner here. Indeed, despite the *same petitioner* (3Shape) also bringing a separate IPR challenge to the '936 patent in IPR2021-01241, that challenge did not advance Paley or Kriveshko to challenge any claims. *See* IPR2021-01241, Paper 16 at 4. Nor has Petitioner here advanced Paley or Kriveshko in the present grounds of challenge. *See* Pet., 3. Indeed, no challenger has claimed that Paley or Kriveshko renders the claims of the '936 patent unpatentable. The Board's prior proceeding about different prior art, applied to different claims, fail to resolve the issues in the present IPR.

II. PETITIONER FAILS TO SHOW UNPATENTABILITY OVER BOERJES

As explained in the POPR, the petition failed to show that Boerjes taught the independent claim elements regarding the production of composite scans. In particular, despite relying on Boerjes to teach the step of “replac[ing] 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,” as recited in element 1[h], or corresponding elements 9[e] and 17[j] of the remaining two independent claims, the petition failed to demonstrate such a teaching in Boerjes. *See* POPR, 10-19.

The Reply fails to remedy this shortcoming of the petition's case. The Reply

relies nearly exclusively on paragraph 199 of Boerjes (*see* Reply, 2-4); however, like the petition, the reply continues to misconstrue its disclosure. The relevant portion of this paragraph reads as follows:

If the data is not satisfactory, the process 400 may proceed to step 414 where the digital model may be supplemented or replaced with new scan data. 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. The process 400 may then return to step 404 where a new digital model is obtained.

EX1004, [00199]. This paragraph lays out two alternatives for step 414: (1) the digital model may be supplemented; or (2) the digital model may be replaced. Paralleling these two options, Boerjes describes how each may be performed, in order, disclosing that this can include (1) new scanning to replace apparently erroneous or inadequate scan data; or (2) a new scan of the dental subject matter following, e.g., additional surface preparation. The two alternatives match in the order written: new scanning to replace only erroneous or inadequate scan data corresponds to *supplementing*, while obtaining a “new scan of the dental subject matter” corresponds to *replacing* the digital model of the dental subject matter.

The Reply ignores the structure of this paragraph, reversing the labels and claiming that the supplementing option, despite being listed first, is actually performed by the second option disclosed by Boerjes, not the first. Reply, 2. This

is not what Boerjes states. The Reply's further argument (3-4) merely muddies the issue. Petitioner argues (3) that "physical modifications of the dentition can occur between the scans." This alone fails to address that Boerjes teaches obtaining an entirely new scan of the modeled dental subject matter in such a case, and thus that a new model is produced, rather than the claimed composite model. Likewise, even if "Boerjes teaches modifying part of the intraoral cavity" (4), Boerjes also teaches that when part of the intraoral cavity is modified, a new scan is obtained to produce a new model. Different models are not combined to generate a composite scan.

The only other paragraph cited in the Reply (paragraph 196) also fails to address the claim limitation. Boerjes lists two alternatives in paragraph 196: (1) identifying regions "requiring additional preparation or reduction" or (2) identifying regions "requiring additional or supplemental scanning." EX1004, [00196]. Contrary to Petitioner's arguments, this paragraph maintains the same distinction: supplemental scanning is used to compensate for an inadequate scan, not to stitch together before-and-after models that have undergone an intervening physical change. Boerjes's differentiation between these options confirms that it does not provide the teachings relied on by Petitioner. Petitioner's continued attempts to rewrite Boerjes should be rejected.

Accordingly, for at least the reasons set forth above, as well as those explained in the POPR, institution should be denied.

Respectfully submitted,

Date: September 24, 2025

/ Michael T. Rosato /
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CERTIFICATE OF SERVICE

I certify that the foregoing Patent Owner's Preliminary Sur-Reply was served on this 24th day of September, 2025, on Petitioner at the following electronic service addresses:

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Respectfully submitted,

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