

From: [Trials](#)
To: [Collins-Chase, Charles](#); [Trials](#)
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Subject: RE: Request for Authorization to File Replies in IPR2025-00817, -00818, -00819, -00820, and -00821
Date: Wednesday, September 10, 2025 10:05:54 AM
Attachments: [image001.png](#)
[image002.png](#)

Counsel,

The panel acknowledges Patent Owner's objection to the requested briefing, but determines that additional briefing would be helpful to consideration of the issues. Accordingly, pursuant to 37 C.F.R. § 42.5(a) and subject to the following deadlines and limitations, the Board authorizes (1) Petitioner to file a reply to Patent Owner's Preliminary Response, and (2) Patent Owner to file a sur-reply to Petitioner's reply, limited to addressing the issues Petitioner raises in the reply.

Petitioner shall file its reply no later than the close of business on September 17, 2025, and Patent Owner shall file its sur-reply no later than the close of business on September 24, 2025. Each party's brief is limited to 5 pages. Neither party is authorized to file any additional evidence with its brief.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
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Subject: Request for Authorization to File Replies in IPR2025-00817, -00818, -00819, -00820, and

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Dear Honorable Board,

Petitioner respectfully requests authorization to file a five-page reply to Patent Owner's preliminary responses in IPR2025-00817, -00818, -00819, -00820, and -00821 pursuant to 37 C.F.R. § 42.108(c).

Good cause warrants a reply in IPR2025-00817 to correct Patent Owner's incorrect assertion that the Boerjes reference does not disclose the key limitation found missing during prosecution and allegations that Petitioner "insert[ed]" these teachings into the Petition and relies on "clip-quotes and mischaracterizations" of Boerjes. *Id.* at 10, 12-17. This is particularly true given Boerjes's importance in correcting a material error by the Office and its use in all asserted grounds.

Good cause also exists in IPR2025-00818, -00819, -00820, and -00821 to address Patent Owner's incorrect assertions regarding purported unexpected results addressed in a prosecution declaration. *See, e.g.*, IPR2025-00818, Paper 9 at 5-6, 17-18, 23. A reply would note that, contrary to Patent Owner's arguments, the Petition squarely addressed the purported unexpected results—summarizing the declaration, analyzing its content, and explaining how it conflicts with Patent Owner's assertion of the claims in litigation. *See, e.g.*, IPR2025-00818, Paper 1 at 22 n.4, 23-26. A reply is further warranted to address the fact that the declaration was only submitted during prosecution of one of the patents (IPR2025-00818). Thus, while Patent Owner's arguments regarding the declaration are wrong as to IPR2025-00818 given Patent Owner's conflicting assertion of the patent claims in litigation, as to the other three patents, the Preliminary Responses offer no support for the position that a declaration never addressed during prosecution must be addressed in an IPR petition.

A reply is further warranted in IPR2025-00818, -00819, -00820, and -00821 to address Patent Owner's incorrect assertions regarding the Petition's discussion of adhesive lamination. IPR2025-00818, Paper 9 at 1, 9, 21, 25-32. Patent Owner incorrectly argues that the Petition does not address motivation to use adhesive lamination, ignoring the Petition's discussion of express prior-art disclosures of using adhesive lamination to produce desirable multi-layer dental aligners. *E.g.*, IPR2025-00818, Paper 1 at 7, 38 n.8, 47, 51, 54, 55, 69.

Accordingly, Petitioner seeks authorization to file a five-page reply in these IPRs. The parties have conferred, and Patent Owner's written statement is provided below:

Patent Owner respectfully opposes the request at least for being premature and lacking good cause:

- Discretionary denial briefing is currently pending before the Director and Petitioner's requests would be moot should discretionary denial be granted. Therefore, a decision on these requests for additional merits briefing should at least be held in abeyance until the Director reaches the unlikely decision to refer the cases to a merits panel.
- The request regarding IPR2025-00817 lacks good cause. No additional briefing is necessary for

the Board to assess whether the “Petition [] relies on ‘clip-quotes and mischaracterizations’ of Boerjes.”

- Regarding IPR2025-00818, -00819, -00820, and -00821, Petitioner’s request to address what it alleges “the Petition squarely addressed” illustrates the lack of good cause. No additional briefing is necessary or appropriate to re-address what is allegedly already addressed in the petition. Moreover, Petitioner’s request here to argue a missing motivation on the basis of alleged prior art disclosure is both improper and legally insufficient. Mere disclosure itself does not establish motivation to modify elsewhere.

Sincerely,
Charles

Charles T. Collins-Chase
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