UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CLEARCORRECT OPERATING, LLC,
Petitioner,

v.

ALIGN TECHNOLOGY, INC.,
Patent Owner.

IPR2025-00818
Patent No. 10,973,613

PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO STRIKE

I. INTRODUCTION

Petitioner's motion to strike (Motion, Paper 63) is an attempt to shield Petitioner and its expert from their own inconsistent arguments and failure to meet their burden of proof in the petition materials. Exhibits A-E to EX2036 constitute proper evidence testing Dr. Osswald's new testimony on reply, and the Sur-Reply both responds to Petitioner's Reply arguments and is consistent with the POR.

II. THE DEPOSITION EXHIBITS PROPERLY RESPONDED TO AND IMPEACHED DR. OSSWALD'S REPLY TESTIMONY

The petition identified PCCD as a copolyester, with no evidence beyond a bare, conclusory assertion parroted in the expert declaration. Pet., 30; EX1007, ¶169. After Dr. Osswald failed to offer a coherent explanation in his first deposition (EX1148, 22:19-25:9), Petitioner on Reply advanced new evidence and argument addressing this issue for the first time. *See* EX1148, ¶¶5-40. This new testimony included citing a new, non-grounds exhibit (EX1151) that Dr. Osswald said referred to PCCD as a copolyester. EX1148, ¶¶39-40. He also attempted to minimize the impact of Brunelle (EX2019)—which teaches even mixed-isomer PCCD was a homopolymer—by arguing that terminology was merely chosen for convenience specific to the unique context of that article. EX1148, ¶¶32, 39-40.

Exhibits A-C, presented during Dr. Osswald's July 2, 2026, reply deposition, properly responded to these belated arguments. For example, Align confronted Dr. Osswald with both the remaining text of EX1151 and other

references describing PCCD as a homopolyester, not a copolyester, even when incorporating mixes of *cis* and *trans* isomers. EX2036, 17:2-63:5. Dr. Osswald then conceded that the composition described in EX1151 was different from Tadros's PCCD and abandoned his reliance on it, asserting instead that he was relying on an express definition of "copolyester" in Tadros distinct from how the term is used generally in the art. *See* EX2036, 27:3-28:18 (EX1151's composition different from Tadros's PCCD), 37:19-38:17 (claiming "people will define and call things different ways," asserting that "Tadros defines this PCCD as a copolyester" by employing a different definition than others in the art, and misquoting Tadros as saying "PCCD is a copolyester"), 60:16-21; *see also id.*, 34:24-25, 62:12-22 (relying on Tadros's purported definition, inconsistent with others in art).

When a witness offers expert testimony regarding a topic, it is entirely proper on cross-examination to test that testimony by confronting him with evidence inconsistent with his opinions, and such exhibits are properly included in a deposition transcript. *See, e.g.*, *Ascend Performance Materials Operations LLC v. Samsung SDI Co., Ltd.*, IPR2020-00349, Paper 53 at 12 (July 15, 2021) ("[I]f exhibits are introduced during a deposition for the purposes of testing the witness' testimony, a party should be able to submit those exhibits with the transcript, so the Board has the full context available in order to evaluate the testimony"). In addition to calling those specific areas of the expert's testimony into doubt, such

exhibits also impeach the witness more generally by calling into question their credibility and the reliability of their opinions. *See, e.g.*, *Qiagen Scis., LLC v. Tecan Genomics, LLC*, IPR2025-00028 Paper 46 at 51-54 (May 13, 2026) (denying motion to strike deposition exhibits included with sur-reply because the "Board does not categorically forbid the use of impeachment deposition materials," and finding it proper to include materials that could serve a purpose in assessing credibility of an expert witness). As Exhibits A-C undermined Dr. Osswald's reply testimony, they were properly included as part of the deposition transcript.[1]

The same conclusion applies for Exhibits D-E. The petition and Dr. Osswald also advanced arguments regarding unpredictability in the art inconsistent with those made by Petitioner and its experts in district court. For example, here Petitioner and Dr. Osswald asserted idiosyncratic unpredictability that applied everywhere except to the petition's own proposed combinations, while in district court Petitioner argued for unpredictability with no caveats at all. *E.g.*, Pet., 22-23 n.4, 34; EX1007, ¶145; EX2017, 99:5-18; *see* EX2036, Exs. D-E. On reply,

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[1] Petitioner also contends Align's supplemental information requests concede the deposition exhibits' impropriety. Motion, 1. Not so. Granting the requests would admit the exhibits as substantive evidence without restriction, promote clarity in the record, and prevent Petitioner from misleading the Board. Paper 62.

Petitioner and Dr. Osswald added further caveats to try and claw back predictability in the art, while simultaneously advancing inconsistent arguments in district court that the art was unpredictable without qualification. Reply, 13 (arguing district court positions informed predictability); EX1148, ¶¶70, 73, 76 & n.4, 81 (arguing adhesive lamination circumvents unpredictability), 92.

On cross-examination, both before and after being confronted with Petitioner's inconsistent district court arguments, Dr. Osswald continually shifted his testimony regarding unpredictability in an attempt to maintain Petitioner's obviousness theories. For example, Dr. Osswald repeatedly confirmed his position that a POSITA would not make a substitution in the face of unpredictability. *See, e.g.*, EX1148, 82:11-18, 85:2-15, 94:11-13 (repeatedly emphasizing that a POSITA would want predictability), 95:3-9 (substituting materials in Tadros's aligner will "end up having some unpredictable results, and a person with ordinary skill of the art doesn't want to do it"). Yet when asked to square this need for predictability with Petitioner's unpredictability arguments in Exhibits D-E, Dr. Osswald tried to minimize the unpredictability by claiming it applied only if "you start from zero" (that is, in the absence of any prior art), or by asserting that adhesive lamination was a panacea for unpredictability. EX2036, 100:13-20, 101:2-13. Dr. Osswald's inability to persuasively defend his opinions in the face of these exhibits confirm that they properly related to, and impeached, his testimony.

While Petitioner asks to strike Exhibits A-E because Dr. Osswald had not seen them, during cross-examination Dr. Osswald repeatedly offered opinions regarding the exhibits after their introduction. EX2036, 49:17-50:7 (opining POSITA would not have looked to Exhibit B because it involves a "·heat-resistant biobased polycarbonate mixture," which "falls outside, I think, of dental aligners."), 58:15-59:6, 62:8-11 (opining POSITA would not look to Exhibit C because it had different goals from Tadros), 93:13 ("I mean, I can comment on [Exhibit D]."), 105:8-107:17 (familiar with Dr. Spiegelberg from Exhibit E, stating "he's a good scientist"); *see Edwards Life Scis. Corp. v. Cardiovalve Ltd.*, IPR2021-00383, Paper 60 at 87 (July 18, 2022) (denying motion to strike deposition exhibits and finding no prejudice to Petitioner because expert had opportunity to respond to exhibits during deposition).

Lastly, Petitioner asks to strike Dr. Osswald's testimony because it had objected on various evidentiary grounds (Motion, 3 n.1); however, evidentiary objections are no basis for a motion to strike. Beyond that, the transcript portions Petitioner seeks to strike are overbroad even if Petitioner's arguments are credited, encompassing testimony relating to a POSITAs' perspective or previously-filed exhibits. *See, e.g.*, EX2036, 38:1-39:20, 41:11-43:24, 61:13-62:11, 93:15-94:13, 100:13-101:15. Accordingly, Petitioner has failed to justify its motion to strike any of Exhibits A-E or the identified portions of deposition testimony.

III. THE SUR-REPLY ARGUMENTS WERE PROPER

Petitioner fails to show that the identified arguments in the Sur-Reply constitute improper new argument. Rather, these arguments were consistent with the POR and properly responded to and rebutted Petitioner's Reply.

As pointed out in the POR, Petitioner failed to show PCCD to be a copolyester. POR, 14-16. The POR introduced evidence showing polyesters were chains of *polyester monomer units*, with *each monomer unit formed of a reaction of a diacid and a diol*, and a copolyester was a polyester formed of different types of these polyester monomer units. *Id.*; EX2014, ¶¶49-50; *see also* EX2020, 173 (polyester formed by reacting diacid and diol is a homopolymer because it has "only one type of repeat unit"); EX2019, 4101, table 6 (PCCD not a copolyester).

In the Reply, Petitioner for the first time provided an explanation of why it thought PCCD was a copolyester, pretending that the POR had proposed a "monomer theory" under which a sub-component of PCCD's single recurring unit (e.g., a diol or diacid alone), could be a monomer. Reply, 3-6. It then claimed that this would make PCCD a copolyester, as well as asserting a non-grounds patent publication (EX1151) had called PCCD a copolyester. *Id.* The Reply further argued that if different isomers were incorporated into PCCD, that would make it a copolyester, which again was a theory absent from the petition materials. *Id.*

The arguments in the Sur-Reply, including those using Exhibits A-C to rebut

Dr. Osswald's opinions, are both consistent with the arguments presented in the POR and properly responsive to Petitioner's new Reply arguments. Each of Exhibits A-C expressly teaches that PCCD is not a copolyester, a point Dr. Osswald could not dispute when confronted in deposition. Petitioner complains that the Sur-Reply (consistent with the scientific literature) used the term "homopolyester" to concisely refer to a polyester like PCCD that is not a copolyester, but there can be no dispute that this is consistent with the POR. *See, e.g.*, POR, 16-17 (PCCD is "only a polyester, not a copolyester"). It is not a new argument to use a synonym to say the same thing that was previously argued.

Petitioner's further suggestion (Motion, 8) that Align should have made these arguments in the POR is a blatant burden shift. The petition included no evidence or explanation of petitioner's theory that PCCD was a copolyester. Precluding the Sur-Reply from rebutting the Reply's new theories would deny Align any chance to respond. The Board should not countenance Petitioner's attempt to shield its arguments from rebuttal by sandbagging them in the Reply.

As to Exhibits D-E and Petitioner's unpredictability positions, Petitioner does not dispute that Align has consistently highlighted inconsistencies between Petitioner's obviousness positions and its varying characterizations of unpredictability in the art. *See, e.g.*, POR, 1-2 (noting inconsistency between obviousness and unpredictability arguments), 18 (noting untenability of arguments

regarding layer unpredictability as tied to arguments in litigation), 22-23 (Petitioner's unpredictability positions "here and elsewhere" undermine its petitions), 26-27, 43 (noting implausibility of unpredictability positions).

Petitioner argues the Reply "did not…justify" pointing out the continuing inconsistency in its arguments across multiple forums. This fails for multiple reasons. First, the timing of the district court trial (June 22-July 1, 2026) meant that this was Align's first opportunity to introduce evidence of Petitioner's representations to the judge and jury. Moreover, as discussed above, Petitioner and Dr. Osswald introduced new argument and testimony on reply adding caveats and exceptions to limit unpredictability, such that Petitioner's IPR and district court arguments increasingly diverged. *See, e.g.*, EX1148, ¶¶73, 76 & n.4, 81, 92.

As discussed above, Dr. Osswald further altered these opinions during cross-examination, emphasizing POSITAs' need for predictability while trying to minimize the unpredictability he and Petitioner had previously argued. *See* EX2036, 100:13-20; *see also id.*, 79:23-3, 82:7-84:20, 85:2-86:14, 94:11-13, 95:3-9, 97:1-3. These new caveats further exacerbate the differences between Petitioner's arguments here and in district court. Pointing out these shifting, inconsistent positions is appropriate and does not constitute new argument.

The Reply also specifically argued that the litigation positions being maintained by the parties in district court regarding predictability were relevant to

the issues being decided here. *See* Reply, 13. Thus, Petitioner's Reply arguments and Dr. Osswald's testimony raised concerns of inconsistencies regarding predictability of the art.

Exhibits D-E show that Petitioner took an entirely different tack in district court, arguing that developing aligners was unpredictable without qualification. Indeed, Petitioner argued that despite there being sufficient written description to show that the inventors were in possession of each asserted claim, a POSITA would be unable to make an aligner out of a TPU and copolyester according to those claims. *See* EX2036, 292(125:11-13) (Ex. D) (summary judgment of validity regarding written description), 770:16-771:10 (eliciting testimony that "making a multi-layer material…is unpredictable" to argue lack of enablement).

As the Director recently confirmed, advancing inconsistent positions on overlapping issues between IPRs and district court proceedings as Petitioner has done is unacceptable. *See Magnolia Medical Techs., Inc. v. Kurin, Inc.*, Paper 17 at 4 (precedential) (May 14, 2026) (It is a misuse of AIA Review to "take inconsistent positions, without sufficient reasoning, on overlapping issues between district court and the PTAB, suggesting that parties are misleading one tribunal or the other."). The inconsistency between Petitioner's and Dr. Osswald's arguments here and Petitioner's arguments in district court, as shown by Exhibits D-E and as explained in the Sur-Reply, implicate this concern raised by the Director and

undermine Petitioner's arguments and expert testimony. Align was entitled to explain this in the Sur-Reply. Petitioner's request should thus be denied.

IV. PETITIONER'S WORD-COUNT ARGUMENTS FAIL TO JUSTIFY STRIKING THE IMAGES IN THE SUR-REPLY

Petitioner asks to strike images of Exhibits D and E included in each Sur-Reply. Motion, 9-10. However, the Trial Practice Guide expressly states that relying on a word-processor's word count suffices, with no need to account for text in images, except if the quantity of text is so great as to constitute "obvious abuse." TPG, §II.A.3. Petitioner does not dispute that the word count of each Sur-Reply, absent the images in question, is less than the limit. Nor does Petitioner provide any justification for a finding of "obvious abuse" or identify any prejudice caused by the inclusion of these images, particularly since the images just show the exhibits as they appear at the cited pages. In fact, despite conceding that there are no excessive words in the -819 Sur-Reply even if considering the images in question, Petitioner nonetheless asks to strike the images in that Sur-Reply as well. *See* IPR2025-00819, Paper 64 at 9-10. This request is nakedly unjustified, and Petitioner has not explained why it would be useful to strike these images from this proceeding while keeping the same images in place in IPR2025-00819, particularly where the cites and argument text would remain the same in each Sur-Reply.

V. CONCLUSION

Align respectfully requests the Board deny Petitioner's motion to strike.

Respectfully submitted,

Date: August 28, 2026

/ Michael T. Rosato /
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CERTIFICATE OF SERVICE

I certify that the foregoing Patent Owner's Opposition to Petitioner's Motion to Strike was served on August 28, 2026, on the Petitioner at the following electronic service addresses:

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