.

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. IPR2025-00820
U.S. Patent No. 11,648,090

PETITIONER'S MOTION TO STRIKE NEW EVIDENCE AND ARGUMENTS IN PATENT OWNER'S SUR-REPLY

TABLE OF CONTENTS

I. Introduction 1

II. Background on Align's Filing of the New Exhibits 1

III. Argument 2

A. Sub-Exhibits A-E to EX2036 Should Be Stricken as Improper New Sur-Reply Evidence 2

B. Align's New Sur-Reply Arguments Are Also Improper 4

1. Align Attempts to Change Its PCCD Arguments After ClearCorrect Debunked Its Previous "Monomer Theory" 5

2. Align's New Arguments on Purported Inconsistencies Between Obviousness and Enablement 8

IV. Align's Sur-Replies Exceed the Word Count 8

V. Conclusion 10

I. Introduction

As authorized, ClearCorrect moves to strike Align's new Sur-Reply evidence (sub-exhibits A-E within EX2036); deposition transcript sections parroting those exhibits (in EX2036); and new Sur-Reply arguments based on the exhibits. Further, as authorized, ClearCorrect includes a highlighted copy of Patent Owner's Sur-Reply marking the specific sentences that should be stricken (EX1169).

Align's co-pending motion to submit these same exhibits as supplemental information effectively concedes that the new Sur-Reply exhibits and corresponding arguments were improper, and thus that the present motion to strike should be granted. ClearCorrect will address the lack of good cause for refiling Align's improper exhibits as supplemental evidence in its opposition to Align's motion.

II. Background on Align's Filing of the New Exhibits

Sub-exhibits A-E to EX2036 are new documents that Align first introduced during its second deposition of Dr. Osswald and filed with its Sur-Reply. They are a 2013 journal article, two U.S. patents issued in 1999 and 2018, respectively, and two district court transcripts. Despite the Board's specific rules on the form of evidence and prohibition against new sur-reply evidence, Align declined to assign exhibit numbers to these new documents. 37 C.F.R. § 42.63(a) ("All evidence must be filed in the form of an exhibit."); *id.* § 42.23(b) ("A sur-reply . . . may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any

reply witness."). Instead, Align appended the sub-exhibits to Dr. Osswald's deposition transcript (EX2036) and cited portions of the sub-exhibits as if they were deposition testimony. *E.g.*, Sur-Reply at 3 (citing to "EX2036, 93:1-11, 221(56:13-24); *see also id.*, 280-81(115:4-116:8)"), 4 (citing to "EX2036, 107:18-108:11, 388(771:2-13)"), 8 (citing to EX2036, "138-41(2:55-58, 5:3-20), 142-54(2:10-18)").

III. Argument

A. Sub-Exhibits A-E to EX2036 Should Be Stricken as Improper New Sur-Reply Evidence

37 C.F.R. § 42.23(b) is unequivocal: a sur-reply "may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness." TPG (Nov. 2019) at 73-74. This "blanket prohibition" is essential to "minimize . . . undue prejudice" to petitioners, as the sur-reply concludes the merits briefing in an IPR. *Netflix, Inc. v. DivX, LLC*, IPR2020-00511, Paper 46, at 53-56 (P.T.A.B. Aug. 13, 2021); *FedEx Corp. Servs., Inc. v. Roambee Corp.*, IPR2022-00934, Paper 41, at 9 (P.T.A.B. Nov. 3, 2023); *3M Co. v. Westech Aerosol Corp.*, IPR2018-00576, Paper 45, at 7 (P.T.A.B. Apr. 26, 2019); *see also LifeScan, Inc. v. Cellspin Soft, Inc.*, IPR2025-00102, Paper 27, at 3-4 (P.T.A.B. June 24, 2026) (there is no "extraordinary circumstances" exception to the prohibition on new evidence).

When ClearCorrect asked Align to withdraw improper sub-exhibits A-E, Align argued that they were properly appended as "part of the transcript of Dr. Osswald's second deposition." July 20, 2026 Email (submitted to Board on August

3, 2026). The Board, however, has repeatedly rejected such "clear attempt[s] at circumventing" § 42.23(b)'s blanket prohibition by repackaging new documents as "deposition evidence." *Netflix*, IPR2020-00511, Paper 46, at 53-56; *see also 3M*, IPR2018-00576, Paper 45, at 3, 7. Moreover, although not required, ClearCorrect objected to Align's actions during Dr. Osswald's deposition on the basis of § 42.23(b), relevance, scope, hearsay, and foundation. EX2036 35:22-36:6, 46:8-14, 55:8-15, 87:1-8, 102:19-23, 132:11-17; *Netflix*, IPR2020-00511, Paper 46, at 54-55. These exhibits should thus be stricken.

The Board has also rejected patent owners' "awkward and improper" attempts to introduce new Sur-Reply evidence by using a petitioner's witness "as a mouthpiece" to read the new documents into the record during deposition. *Aylo Freesites Ltd. v. Dish Techs. L.L.C.*, IPR2024-00044, Paper 60, at 92-93 (P.T.A.B. Apr. 14, 2025). That is exactly what Align did here, even after Dr. Osswald testified he had never seen any of these exhibits. This improper discussion of the new exhibits, spanning 34:21-63:15 and 86:15-112:22 in EX2036, thus should also be stricken.[1] *Netflix*, IPR2020-00511, Paper 46, at 55; *compare Dish*, IPR2024-00044,

[1] In addition to violating § 42.23(b), the testimony should be stricken as outside the scope and lacking relevance and foundation. EX2036, 36:11-12, 47:23-48:5, 57:12-16, 87:14-89:25, 102:3-7 (Dr. Osswald testifying he had never seen the new

Paper 60, at 92-93 (striking portions of expert deposition transcript where "Patent Owner's counsel merely paraphrased [a different person's] testimony and asked [the expert] if he saw the testimony in the transcript"), *with e.g.*, Sur-Reply, 4 (citing EX2036, 107:18-108:11, where Align's counsel reads testimony from the trial transcript and asks Dr. Osswald: "Do you see that? . . . Did I read that correctly?").

ClearCorrect thus respectfully asks that the Board strike the improper new Sur-Reply evidence and Align's parroting of it in the EX2036 deposition transcript.

B. Align's New Sur-Reply Arguments Are Also Improper

The new arguments in Align's Sur-Replies based on the improper new evidence should likewise be stricken. 37 C.F.R. § 42.23(b); TPG at 73-74 (explaining a sur-reply may not "embark in a new direction with a new approach"); *Lenovo Holding Co., Inc. v. Dodots Licensing Solutions LLC*, IPR2019-00988, Paper 34, at 5 (P.T.A.B. June 9, 2020) (noting a petitioner may strike evidence if the sur-reply "raises new issues"). Align's new arguments appear in the highlighted portions of the attached Sur-Reply from IPR2025-00818 and are substantively the same across the other Sur-Replies. In particular, Align (1) relies on sub-exhibits A-C to argue a new "homopolyester" theory and (2) relies on sub-exhibits E-D to newly

---

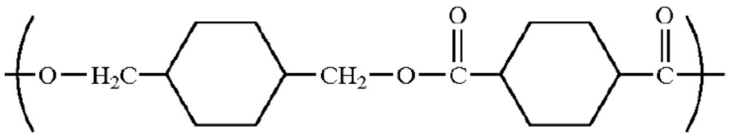
exhibits); EX2036 35:22-36:6, 46:8-14, 55:8-15, 87:1-8, 102:19-23, 132:11-17 (objections on record).

argue purported inconsistencies between the IPR obviousness grounds and district court enablement positions that Align had known since at least January 2026, before filing its PORs.

1. Align Attempts to Change Its PCCD Arguments After ClearCorrect Debunked Its Previous "Monomer Theory"

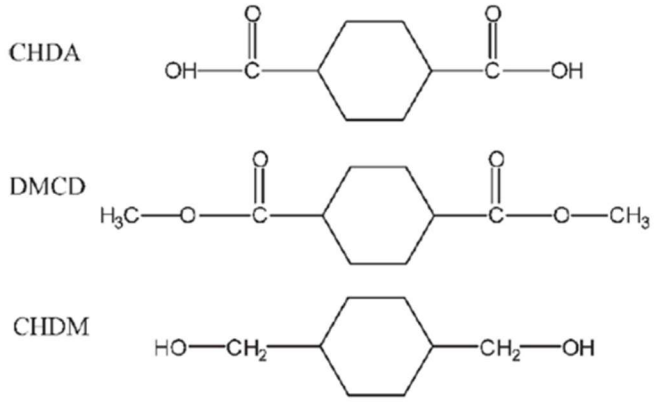
Align relies on sub-exhibits A-C to make new arguments regarding the *Tadros* reference (EX1003). Align argues that the PCCD polymer in *Tadros* is not a *copolyester*, as *Tadros* discloses, but instead is a "homopolyester" composed of a single "polyester unit." Neither of these terms, however, appears in Align's PORs or expert declaration—the terms come from sub-exhibits A-C. Further, Align's "homopolyester" and "polyester unit" arguments based on these documents are brand new and directly contradict the PORs. They should therefore be stricken.

In the PORs, Align disputed *Tadros*'s disclosure of the claimed hard layer comprising a "copolyester." Align argued that one of the polymers the Petition relies upon, PCCD, is not a copolyester because it is made from only a single "monomer." EX2014, ¶¶49-50. This argument hinged on Align's assertion that the recurring unit of PCCD in Formula VIII (reproduced below) was allegedly a *single monomer*:



POR at 16 (Align asserting that the "recurring unit [in Figure VIII] is a *single monomer*, meaning that PCCD is a homopolymer, not a copolymer, and accordingly not a copolyester" (citing EX2014, ¶50, EX1003, ¶[0050])).

ClearCorrect and its expert, Dr. Osswald, debunked Align's monomer theory, explaining that Formula VIII actually depicts a *polymer* formed by combining at least two different monomers. Reply, 3-6 ("Align's 'Monomer' Theory Is Wrong"); EX2017, 25:1-4 ("Q. Formula VIII depicts a monomer, right? A. No. It depicts a polymer."). Dr. Osswald testified that, "[c]ontrary to Dr. Kimmel's assertions, there are thus at least three monomer units used in the preparation of PCCD—CHDM, DMCD, and CHDA":



EX1148, ¶¶13-15; ¶16 ("Dr. Kimmel appears to conflate 'monomers' with 'repeat units.'"). Dr. Osswald also pointed to *Tadros*'s disclosure that making PCCD using cis- and trans- monomers of CHDM, DMCD, or CHDA further results in a "copolyester." *Id.*, ¶27; Reply, 4-7 (citing EX1003, [0042], [0045], [0047]).

In its Sur-Replies, Align did not attempt to defend its monomer theory. Instead, Align abandoned it, contending for the first time that "[i]t is *ultimately irrelevant* whether Tadros's single polyester unit might be reimagined by its (non-polyester) subcomponents and whether those subcomponents *may or may not be called* '*monomers*.'" Sur-Reply, 6 (emphases added).

Align pivoted to a new theory, arguing that PCCD is "a polymer formed by a single type of recurring polyester unit" and thus "is a homopolyester." Sur-Reply, 5-6. Accordingly, whereas the PORs argued that PCCD is not a copolyester because it is made from only one monomer, the Sur-Replies newly argue that PCCD is not a copolyester *even though* it is formed from multiple monomers because those monomers combine to make a single "polyester unit," resulting in a "homopolyester." Sur-Reply, 5-9. Align's Sur-Reply arguments thus reflect a reversal of its POR position. Likewise, Align's new "recurring polyester unit" argument contradicts the PORs' argument that Formula VIII depicts a "monomer"—a monomer by definition cannot be a "polyester unit."

Like the PORs, Dr. Kimmel's declaration never mentions a "homopolyester" or a "polyester unit." *See* EX2014, ¶¶49-50. Although Align wrongly suggests that Dr. Kimmel originally testified that "a polymer formed by a single type of recurring *polyester unit* is a *homopolyester*" (he did not), the Sur-Replies acknowledge that Align's new theory is based on new sub-exhibits A-C. *See* Sur-Reply, 8 ("*Additional*

literature . . . confirms PCCD (including cis/trans mixes) is a *homopolyester*, not a copolyester." (citing EX2036, 138-141, 142-154, 160 (emphasis added)).

Align's new arguments are the kind of gamesmanship that § 42.23(b) prohibits. As the Board has consistently recognized, such untimely arguments leave a petitioner unable to respond to new theories that "*could have (and should have been)* raised in the [POR]." *3M*, IPR2018-00576, Paper 45, at 4-6 (emphasis in original); *Intel Corp. v. ParkerVision, Inc.*, IPR2020-01265, Paper 44, at 68-69 (P.T.A.B. Jan. 21, 2022). Here, Align could have and should have raised its "homopolyester" argument in the PORs. Indeed, sub-exhibits A-C were published many years before these IPRs began. ClearCorrect thus respectfully requests that Align's new exhibits and arguments be stricken. *See* EX1169. *See Ford Motor Co. v. Safe Driving Techs. LLC*, IPR2021-01446, Paper 28, at 82 (P.T.A.B. Mar. 10, 2023) ("The Board is not required to attempt to sort proper from improper portions of the reply or sur-reply." (quoting TPG, 73-74)).

2. Align's New Arguments on Purported Inconsistencies Between Obviousness and Enablement

Align relies on sub-exhibits D-E (trial transcripts) to advance a new argument on purported inconsistencies between the IPR obviousness grounds and district court enablement arguments. Sur-Reply, 2-5. ClearCorrect's Replies did not make any arguments that could justify Align's new Sur-Reply arguments. Indeed, the Petitions

expressly explain why there is no inconsistency between IPR obviousness grounds following express prior-art guidance to make *an embodiment* within the claims and the litigation argument that Align failed to enable the *full scope* of its expansive claims. Pet., 1, 22 n.4. Moreover, ClearCorrect's district court expert report detailing the enablement positions was served on January 6, 2026, more than a month before Align filed its PORs. Yet, the PORs failed to address the district court proceedings or identify any document showing alleged inconsistency with the IPRs. Indeed, no such inconsistencies exist. EX3103 (the Director denying Align's request for Director Review based on the jury verdict and enablement arguments at trial).

Align improperly waited to raise these new arguments in its Sur-Replies. These belated arguments should thus be stricken.

IV. Align's Sur-Replies Exceed the Word Count

The Trial Practice Guide cautions that "[p]arties should not abuse the [word count verification] process." TPG at 25. This includes "[e]xcessive words in figures, drawings or images . . . in order to circumvent the word count." *Id.* Word-count violations "may lead to a party's brief not being considered."

Align's copy-and-paste of pictures of transcript text from sub-exhibits D-E circumvents the word limits in the -00818, -00820, and -00821 IPR Sur-Replies. Align pasted two pictures of district court transcripts totaling 151 words but omitted the words from pictures in its word-count certification. An example is shown below.

13 And I'll make one note here, Your Honor,
14 which we'll pick up as we go through this. This is not
15 a so-called predictable art in terms of developing
16 these clear aligners. The particular research and
17 development process required to develop an efficacious
18 clear aligner is very complicated and frankly very
19 unpredictable. And it takes a lot of experimentation
20 to develop an efficacious clear aligner that will
21 function for its purpose of straightening teeth that
22 will be safe, that will be sufficiently comfortable,
23 sufficiently stain resistant. This takes an enormous
24 amount of work to develop these types of aligners.

EX2036, 93:1-11, 221(56:13-24); *see also id.*, 280-81(115:4-116:8) ("this is an

Sur-Reply, 3. Align pasted a similar 53-word excerpt on page 4.

Align's certification that its -00818 IPR Sur-Reply contains 5,582 words—just under the 5,600-word limit—excludes the 151 words from the pasted textual images, which would bring the word count to 5,733 words (assuming Align's certification was otherwise correct). The -00820 and -00821 Sur-Replies are likewise over-length (5,710 and 5,711 total words, respectively). Align has offered no explanation for its violation—when ClearCorrect identified the word-count issue in a July 17 email to Align, Align's response failed to address word count. Align's abuse of the word-count processes warrants, at the very least, striking portions of the Sur-Replies referencing the new exhibits. Sur-Reply at 3-4; TPG at 25.

V. Conclusion

ClearCorrect respectfully asks the Board to strike the above-mentioned new exhibits and corresponding deposition testimony and new Sur-Reply arguments.

Respectfully submitted,

Dated: August 21, 2026

By: / Charles T. Collins-Chase /
Charles T. Collins-Chase, Lead Counsel
Reg. No. 78,019

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing **PETITIONER'S MOTION TO STRIKE NEW EVIDENCE AND ARGUMENTS IN PATENT OWNER'S SUR-REPLY** was served on August 21, 2026, via email directed to counsel of record for Patent Owner at the following:

Michael T. Rosato
Patrick M. Medley
Wilson Sonsini Goodrich & Rosati
701 Fifth Avenue, Suite 5100
Seattle, WA 98104-7036
Email: mrosato@wsgr.com
Email: pmedley@wsgr.com

Matthew A. Argenti
Wilson Sonsini Goodrich & Rosati
650 Page Mill Road
Palo Alto, CA 94304
Email: margenti@wsgr.com

Dated: August 21, 2026

By: / William Esper /
William Esper
Senior Litigation Paralegal
Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP