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. IPR2025-00821
Patent No. 11,648,091

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 10 ("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 Board resources pursuant to *Fintiv* as Petitioner's delay ensures the Board's FWD would occur well after the scheduled trial in the Western District of Texas. DD Brief, 1, 8, 11-13. Attorney speculation in the Opp regarding potential rescheduling should be given no weight. Opp 17-21. There is no dispute that the parties here jointly requested trial in May 2026, and the court has issued a revised scheduling order setting trial for May 11, 2026. DD Brief, 11; EX2003, EX2006. This means the projected deadline for FWD (November 2026) is *six months after the trial date*. There is also no dispute that Judge Albright's stated practice is "not mov[ing] the trial date except in extreme situations." DD Brief 12; EX2005. Despite the Opp's (19) complaints, that practice is still in effect.

Under these circumstances, speculation of re-scheduling 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 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 similar petitioner's argument as "merely speculative, and we decline to guess what the district court might do."). The cases cited in the Opp (20-21) do not support Petitioner's argument. In *Shenzen*, Factor 2 still favored denial. In *Amazon*, the trial date and FWD were so close it was unclear which would occur first. Neither case involved an agreed-upon, scheduled trial date preceding FWD by 6 months. At bottom, the evidence of record reflects a May 2026 trial date, whereas the Opp's proposed re-scheduling is merely speculative attorney argument.

The Opp argues the district court grounds may narrow "consistent with a *Sotera* stipulation." Opp. 30. 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.

Second, the Opp attempts to subvert the analysis with extensive focus on the alleged merits of the petition. There is no dispute that each of Tadros, Kalili, Texin 990R, and Wen was cited during prosecution and considered by the Examiner. DD Brief 26-28. The Opp responds with at least the first 15 pages of its brief arguing *Advanced Bionics* and rehashing the alleged merits of its petition case. 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”).

The only “new” reference cited is the Porter reference, which the Opp leans into heavily. But the non-analogous “Dishwasher” reference of Porter is hardly “compelling” as the Opp alleges. Opp 1. Porter describes its plastic as useful in “commercial and residential kitchenware and small kitchen appliances, including reusable food containers, sports bottles, mugs, pitchers and containers for food processors and blenders.” EX1006, 6. While Porter describes in detail the suitability of its plastic for use in kitchenware, nowhere does it mention orthodontics or dental appliances. The Opp (1, 4-5, 7-8, 12-14) expounds on a “BPA-free” argument as rationale to replace polycarbonate in Kalili but ignores the cited paragraph in Kalili discussing many non-polycarbonate options. EX1005, [0053]. That is, Kalili already provides non-polycarbonate options Petitioner argues would be desired. The petition is similarly defective regarding Tadros, ignoring Tadros’s polycarbonate-free options, and failing to justify abandoning Tadros’s central teaching to use polymer blends. *See* POPR, 27-33. There is no non-hindsight driven reason to turn to Porter and Petitioner offers none. To the extent the merits are weighed as a factor they are exceptionally weak, and there was certainly no error in the Examiner not citing Porter during prosecution.

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
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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 2013) was served on this 20th day of August, 2025, on Petitioner at the following electronic service addresses:

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