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 11,648,091

PATENT OWNER'S MOTION FOR ROUTINE OR ADDITIONAL DISCOVERY

Pursuant to email authorization (March 27, 2026), Patent Owner Align submits this motion seeking discovery of a narrow set of documents containing information inconsistent with positions taken by Petitioner ClearCorrect. The documents will support Align's showing that Bay Materials, LLC is an unnamed RPI and that both Bay Materials and Petitioner's expert Dr. Osswald took inconsistent positions in an earlier IPR relevant to objective indicia.

Align has explained that Bay Materials is a subsidiary of the Straumann Group (two Straumann entities are named RPIs here) and a corporate sibling to Petitioner. *E.g.*, Paper 19 at 3, 11-12; Paper 27 (POR) at 62, 67. Bay Materials provides the multilayer material of ClearCorrect's aligners accused of infringing the challenged claims. *Id*. Bay Materials was involved in IPR2022-01214 in which it used the same lead counsel and the same expert witness (Dr. Osswald) as ClearCorrect uses here. Bay Materials and Dr. Osswald presented arguments and testimony regarding, e.g., unexpected results and commercial success. POR, 62-66. Due to substantial similarities between the claims at issue in IPR2022-01214 and this IPR, those arguments and testimony are highly relevant to the same objective indicia here, as well as copying. *Id*. However, many of the exhibits cited in the Bay Materials POR are under seal and redacted in whole or part in the public version. Align thus seeks production of six unredacted, under seal exhibits from IPR2022-01214: exhibits 2006, 2008, 2010, 2014, 2015, and 2016, as well as any other

documents containing information inconsistent with Petitioner's positions here.

A party must serve as routine discovery relevant information inconsistent with a position it has advanced during the proceeding. 37 C.F.R. §42.51(b)(1). As explained herein, the discovery sought in this motion relates to information inconsistent with Petitioner's positions in these IPRs. *Cf. Baby Trend, Inc. v. Wonderland Nurserygoods Co.*, IPR2015-00841, Paper 24 at 3-5 (Sep. 28, 2015) (granting discovery of unredacted versions of documents "relevant to secondary indicia of nonobviousness"). Additional discovery is also available where the party seeking discovery shows that the discovery is in the interests of justice. 37 C.F.R. §42.51(b)(2). The *Garmin* factors control this inquiry. *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 (March 5, 2013) (precedential).

The first *Garmin* factor assesses whether there is more than a mere possibility and allegation of finding something useful. *Garmin*, 6. There is no doubt that the requested documents exist—they are of record in an IPR. Nor have Petitioner and its overlapping lead counsel denied that they can access the requested exhibits. *See* EX2035. Align is "in possession of evidence tending to show beyond speculation that in fact something useful will be discovered": the public versions of the Bay Materials POR and Osswald declaration cited in Align's POR. *Garmin*, 6. Align merely seeks access to the full versions of evidence Bay Materials cited regarding secondary considerations, which are applicable to the

claims challenged here and will further demonstrate that Bay Materials is an RPI.

For example, EX2006 from IPR2022-01214 is the Osswald declaration, cited in Align's POR. POR, 62-66 (citing ¶¶171-76, 179-82). Those paragraphs are heavily redacted in the public version. *See* EX2026. They contain his testimony regarding Zendura FLX properties and comparison to both the Bay Materials patent claims and Align's SmartTrack material. This testimony demonstrates Petitioner and the RPIs (including unnamed RPI Bay Materials) taking inconsistent positions by arguing obviousness here despite knowledge of relevant objective indicia, and is important to assessing Dr. Osswald's credibility. POR, 62-67.

EX2008 is a declaration from W. Todd Schoettlkotte, a Bay Materials expert analyzing commercial success. IPR2022-01214, EX2008, ¶1. Like the Osswald declaration, the Schoettlkotte declaration contains redacted portions comparing Zendura FLX to Align's SmartTrack and describing the market's views of Align. *E.g.*, *id*., ¶¶13-14, 25, 27-31, 45. As Align explained (POR, 63-65), Bay Material's arguments and evidence regarding commercial success confirm the commercial success of Align's SmartTrack. The Schoettlkotte declaration also contains redacted discussion of Bay Materials' relationship to ClearCorrect/Straumann and will demonstrate, e.g., the percentage of Zendura FLX sales attributable to ClearCorrect. *E.g.*, *id*., ¶¶23-24 (citing EX2059), 32-34. Thus, this declaration is demonstrably relevant to secondary considerations, inconsistent positions taken

between the Bay Materials IPR and this one, and the RPI inquiry.

EX2010 is a declaration from John Lahlouh, a Senior Polymer Scientist and Project Manager at Bay Materials, relied upon in the portions of the Bay Materials POR and Osswald Declaration cited in Align's POR. *See* EX2025, 53-54; EX2026, ¶¶173, 175 (each citing EX2010); IPR2022-01214, EX2002, ¶1. Likewise, EX2014-EX2016 are product specifications and data sheets relied upon in the Bay Materials POR and Osswald declaration cited in Align's POR. EX2025, 52, 54; EX2026, ¶¶173-75; *see* IPR2022-01214, Paper 22, 2. Production of EX2010 and EX2014-2016 is in the interest of justice to provide a more fulsome record of evidence underlying the positions taken by Bay Materials and Dr. Osswald, which are relevant to objective indicia here and highlight inconsistent positions.

The additional *Garmin* factors also favor authorizing discovery. Align's request does not seek litigation positions. Align cannot obtain the discovery without the Board's help—indeed, Petitioner has refused to provide it. EX2035. To the extent Petitioner may argue Align could instead use district court discovery, such a path would only offer Petitioner and its counsel further opportunity to evade their responsibility under Rule 51(b)(1)(iii). Align's instructions are easily understandable and not overly burdensome, as they merely seek six documents already filed in a PTAB proceeding. Further, the parties already agreed to use the default protective order, removing any concern about document protections.

Petitioner has argued this motion is moot in view of denial of Align's request for Director review of the institution decision. But Petitioner argued in opposing that request that the RPI issue was not yet ripe for review and the Director agreed in denying the request. Align promptly raised this motion when its request was denied. Moreover, the documents are not just relevant to RPI but also objective indicia, inconsistent positions, and Dr. Osswald's credibility.

Petitioner has also argued Align's request falls "outside its discovery period" (EX2035) but the scheduling order does not set a discovery period, only a time for cross-examination. Paper 18. Nor do the IPR rules place any time limit on motions for additional discovery under Rule 51(b)(2)(i), let alone an expiration for a party's duty of candor or its obligation under Rule 51(b)(1)(iii). Align therefore requests authorization to enter the documents into the record prior to Petitioner's reply. Alternatively, the present circumstances warrant an exception permitting Align to file the documents as surreply exhibits, along with any other information that may come to light as a result of obtaining them. *See, e.g., Dolby Labs., Inc. v. InterTrust Techs. Corp.*, IPR2020-00662, Paper 25 at 3 (exercising discretion under 37 CFR §42.5(b) to allow surreply evidence); *Interactive Comm's Int'l, Inc. v. Blackhawk Network Inc.*, IPR2023-01235, Paper 34 at 60-61 (noting this option).

For the reasons set forth above, Patent Owner respectfully requests that its motion for discovery be granted and surreply evidence be authorized.

Respectfully submitted,

Dated: April 8, 2026

/ Michael T. Rosato /
Michael T. Rosato, Lead Counsel
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APPENDIX – EXHIBIT LIST

EXHIBIT NO.	DESCRIPTION
2001	Claim Construction Order, *Align Technology Inc. v. ClearCorrect Operating LLC*, et al., No. 24-cv-00187-ADA-DTG (W.D. Tex. Jun. 5, 2025)
2002	Scheduling Order, *Align Technology Inc. v. ClearCorrect Operating LLC*, et al., No. 24-cv-00187-ADA-DTG (W.D. Tex. Aug. 5, 2024)
2003	Fourth Scheduling Order, *Align Technology Inc. v. ClearCorrect Operating LLC*, et al., No. 24-cv-00187-ADA-DTG (W.D. Tex. Jun. 12, 2025)
2004	DocketNavigator Median Time-to-Trial Statistics for Judge Alan D. Albright and for W.D. Tex. Overall, July 1, 2020 – July 1, 2025
2005	Judge Albright Patent FAQ, https://www.txwd.uscourts.gov/for-attorneys/judge-albright-courtroom-faq/ (accessed July 3, 2025)
2006	Joint Request to Amend the Claim Schedule, *Align Technology Inc. v. ClearCorrect Operating LLC*, et al., No. 24-cv-00187-ADA-DTG (W.D. Tex. Jun. 6, 2025) (ECF No. 187)
2007	Preliminary Claim Constructions, *Align Technology Inc. v. ClearCorrect Operating LLC*, et al., No. 24-cv-00187-ADA-DTG (W.D. Tex. Jan. 21, 2025)
2008	Defendants' Answer, Affirmative Defenses, and Counterclaims (Public Version), *Align Technology, Inc. v. ClearCorrect Operating*

	LLC, Case No. 6:24-CV-00187 (W.D. Tex. Jul. 16, 2024) (ECF No. 56)
2009	International Application Publication No. WO 2018/222864 to Stewart et al.
2010	U.S. Patent No. 10,946,630 to Stewart et al.
2011	U.S. Patent No. 7,641,828 to DeSimone et al.
2012	U.S. Patent No. 2006/0078841 to DeSimone et al.
2013	ClearCorrect Prior Art Narrowing Disclosure, *Align Technology, Inc. v. ClearCorrect Operating, LLC*, Civil Action No. 6:24-cv-00187-ADA-DTG
2014	Declaration of Dr. Robert Kimmel
2015	Curriculum Vitae of Dr. Robert Kimmel
2016	Declaration of Yan Chen – Parties and Board Only
2017	Osswald Deposition Transcript
2018	Declaration of Naga Kusima
2019	Daniel J. Brunelle et al., "Optimization of poly(1,4-cyclohexylidene cyclohexane-1,4-dicarboxylate (PCCD) preparation for increased crystallinity," 47(11) *Polymer* 4094 (2006)
2020	James L. Throne, Understanding Thermoforming, Ch. 11 (2008)
2021	U.S. Patent No. 8,178,647 (Hawkins)

2022	ClearCorrect Support – Aligner FAQs, https://support.clearcorrect.com/hc/en-us/articles/204800937-Aligner-Material-FAQs
2023	ClearCorrect – The Premier Aligner Clinical Evidence Summary, https://www.straumann.com/content/dam/sites/clearcorrect/xy/landing/aao-2025/113896_ClearCorrect_PremierAligner_SummaryClinicalEvidence_Superside_V3.pdf
2024	Zendura Dental – Why Zendura, https://www.zenduradental.com/pages/why-choose-zendura
2025	*3M Co. v. Bay Materials LLC*, IPR2022-01214, Paper 21 (Patent Owner's Response) (Apr. 12, 2023)
2026	*3M Co. v. Bay Materials LLC*, IPR2022-01214, Exhibit 2006 (Osswald Declaration, Public Version) (Excerpt) (Apr. 12, 2023)
2027	Align Technology, "SmartTrack: Technology that's made to move" (2018)
2028	Timothy Wheeler et al., "Effect of aligner material on orthodontic tooth movement," 1(1) Journal of Aligner Orthodontics 21 (2017)
2029	Zendura Dental – The Zendura Story, https://www.zenduradental.com/pages/the-zendura-story
2030	Align Technology 2013 Q1 Financial Slides
2031	Align Technology 2012 Q4 Financial Slides
2032	Align Technology 2025 Q5 Financial Slides
2033	*3M Co. v. Bay Materials LLC*, IPR2022-01214, Paper 77 (Final Written Decision) (Jan. 16, 2024)

2034	Supplemental Declaration of Dr. Robert Kimmel [Served, not filed]
2035	Email to Board regarding request for authorization for motion for discovery (Mar. 27, 2026)

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing Motion for Routine or Additional Discovery and EX2035 was served on April 8, 2026, at the following electronic service addresses:

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Respectfully submitted,

Dated: April 8, 2026

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