

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
U.S. Patent No. 11,648,091

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
MOTION FOR ROUTINE OR ADDITIONAL DISCOVERY**

TABLE OF CONTENTS

I.	Introduction.....	1
II.	Argument	2
	A. Align Previously Argued That Bay Materials Is <i>Not</i> an RPI.....	2
	B. Align’s Request Is Untimely	2
	C. Align Has Not Established Any Basis for Its Requested Discovery.....	3
	D. ClearCorrect Does Not Have the Requested Documents.....	5
III.	Conclusion	5

TABLE OF AUTHORITIES

Page(s)

Cases

<i>Baby Trend, Inc. v. Wonderland Nurserygoods Co.</i> , IPR2015-00841, Paper 24 (PTAB Sept. 28, 2015).....	4
<i>Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC</i> , IPR2012-00001, Paper 26 (PTAB Mar. 5, 2013)	3, 4, 5
<i>Luminex Int’l Co., Ltd. v. Signify Holdings B.V.</i> , IPR2024-00101, Paper 26 (PTAB Dec. 11, 2024)	4

Regulations

37 C.F.R. § 42.23	3
37 C.F.R. § 42.51(b)(1).....	3
37 C.F.R. § 42.51(b)(2).....	4

I. INTRODUCTION

Align sought to avoid institution by arguing that “each real party-in-interest” (“RPI”) was a defendant in the parallel district court litigation. Bay Materials (“Bay”) has never been a defendant there and is not an RPI here. After institution, Align pivoted to make the exact opposite argument in its Request for Director Review, asserting that Bay *is* an RPI. When that argument also failed, Align sought leave to file another motion arguing the RPI issue (which the Board denied). Now, Align belatedly seeks discovery of sealed documents from a years-old IPR, which Align speculates might support yet another bite at the apple on the RPI issue. Align does not even attempt to justify its long delay in seeking the materials, which is the product of Align’s shifting and inconsistent RPI positions. Due to Align’s delay, there also is no remaining paper in which Align might use those documents.

The Board should deny these speculative requests for several additional reasons. Align fails to identify any inconsistency between Petitioner’s arguments in this proceeding and the documents Align is seeking from IPR2022-01214. And no wonder: the requested documents are from a different IPR involving different parties, a different patent, and a different commercial product. ClearCorrect also had no involvement in that IPR and does not possess the requested documents. Align further fails to explain how the redacted portions of the requested documents could possibly show that Bay is an RPI.

II. ARGUMENT

A. Align Previously Argued That Bay Materials Is *Not* an RPI

In its Request for Discretionary Denial, Align argued that institution should be discretionarily denied because ClearCorrect “is a defendant in the parallel litigation, as is *each real party-in-interest*.” Paper 7, 18 (emphasis added). Bay has never been a defendant in that case. Since Align correctly believed all RPIs were named, it chose not to raise any RPI issue in its Preliminary Response. *See* Paper 9.

Only after the Board granted institution of the IPRs did Align pivot to its new RPI argument, asserting that Bay was an RPI for the first time in a Request for Director Review. Paper 19. After the Director denied this request, Paper 29, Align raised the RPI argument again in its Patent Owner Responses and in a request to move to terminate, which the Board denied. Paper 27, 65-67; Order No. 31.

Align’s shift in position is not a result of any new facts. Bay is still not a defendant in the litigation. Align fails to explain its shifting and contradictory positions or articulate any reason why the requested documents would allegedly demonstrate that Bay is an RPI. Align’s request is instead a fishing expedition seeking to find (nonexistent) facts to support its late-raised RPI argument.

B. Align’s Request Is Untimely

Despite being aware of the requested documents more than eight months ago, Align chose not to pursue the requested discovery until after filing its Patent Owner

Response. The requested documents are from a years-old IPR, and Align even cited IPR2022-01214 in the same Discretionary Denial Request where it acknowledged Bay is not an RPI. *See* Paper 7, 23. The Board should reject Align’s “attempt to alter the Board’s trial procedures under the pretext of discovery.” *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6 (PTAB Mar. 5, 2013) (precedential).

As a consequence of Align’s delay, no substantive paper remains where Align could submit and discuss any of the requested documents. Align is not permitted to introduce new evidence with its Sur-Reply (37 C.F.R. § 42.23), and the Board denied Align’s request to file a motion to terminate. Order 31; EX2035, 2 (Align admitting its requests are “directly relevant” to its now-denied motion to terminate). It would prejudice ClearCorrect to allow Align to address the documents for the first time in its Sur-Reply, depriving ClearCorrect of a chance to respond. Paper 35, 5.

C. Align Has Not Established Any Basis for Its Requested Discovery

Align fails to provide any basis for routine discovery under 37 C.F.R. § 42.51(b)(1). Align contends the sealed documents will demonstrate inconsistencies between Petitioner’s positions here and Bay’s positions in the unrelated IPR. Paper 35, 1, 3-4. Align speculates that Bay’s position that its patent in IPR2022-01214 had unexpected results is somehow inconsistent with ClearCorrect’s position here that Align’s patents do not. Any alleged inconsistency

regarding RPI is even more opaque. Align offers no specifics as to how the requested documents would allegedly show that Bay is an RPI. *E.g.*, Paper 35, 3 (citing EX2008, ¶¶32-34, where the only redaction is the apparent purchase price of Bay). Align thus fails entirely to support its assertion that the sealed documents “demonstrate[]” any inconsistency. Paper 35, 3. This is fatal to Align’s request. Routine discovery “is narrowly directed to *specific information known* to the responding party to be inconsistent with a position advanced by that party in the proceeding.” *Garmin*, 4 (emphasis added); *see also Baby Trend, Inc. v. Wonderland Nurserygoods Co., Ltd.*, IPR2015-00841, Paper 24 at 3-5 (PTAB Sept. 28, 2015) (denying speculative requests for documents from “other proceedings”).

Likewise, it is not “necessary in the interest of justice” to grant Align’s speculative requests under the guise of additional discovery. *Garmin*, 6; 37 C.F.R. § 42.51(b)(2). Align provides no evidence of any inconsistency and thus fails to “show beyond speculation that in fact something useful will be uncovered.” *Garmin*, 6, 8 (Factor 1). Even if the documents were “relevant” as Align contends (Paper 35, 3-5), mere potential relevance is insufficient for additional discovery. *Garmin*, 6-8. But Align’s statement that it seeks the documents “to provide a more fulsome record” effectively admits that Align has no idea whether or how the documents might support its arguments. Paper 35, 4; *Luminex Int’l Co., Ltd. v. Signify Holdings B.V.*, IPR2024-00101, Paper 26 at 12-21, 34 (PTAB Dec. 11, 2024) (denying

additional discovery where patent owner did not show beyond speculation whether a third-party customer was “controlling, funding, or directing” IPRs of the supplier).

Align is also wrong that its mere possession of the redacted versions weighs in favor of granting discovery. Paper 35, 2. If that were true, redacted copies would always establish entitlement to the sealed portions. Align has not specifically identified a need for the sealed portions, and its reliance on the public documents for more than eight months shows that Align viewed the versions in its possession as equivalent. *See Garmin*, 6, 13-14 (Factor 3); *infra* § II.D.

D. ClearCorrect Does Not Have the Requested Documents

Finally, ClearCorrect does not possess or have access to the requested documents, which are sealed papers from an IPR between 3M and Bay. ClearCorrect had no role in that IPR, just as Bay has none here.

Recognizing that ClearCorrect does not have the documents it seeks, Align asserts that ClearCorrect’s *outside counsel* “can access the requested exhibits.” Paper 35, 2. ClearCorrect’s outside counsel cannot produce confidential information filed under seal on behalf of another client in another proceeding, which would violate its ethical duty of confidentiality to that client. Entry of the default protective order in this IPR in no way cures this problem.

III. CONCLUSION

For these reasons, ClearCorrect requests that the Board deny Align’s motion.

Respectfully submitted,

Dated: April 17, 2026

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

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **Petitioner's Opposition to Patent Owner's Motion for Routine or Additional Discovery** was served on April 17, 2026, via e-mail directed to counsel of record for the 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: April 17, 2026

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