

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 10,973,613 B2)
IPR2025-00819 (Patent 11,154,384 B2)
IPR2025-00820 (Patent 11,648,090 B2)
IPR2025-00821 (Patent 11,648,091 B2)¹

Before NEIL T. POWELL, KRISTINA M. KALAN, and
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

ORDER
Denying Request for Routine or Additional Discovery
37 C.F.R. §42.51(b)(1)(iii), §42.51(b)(2)(i)

¹ We use this caption for efficiency. These cases are not joined. The parties may not use such a caption without prior authorization from the Board.

IPR2025-00818 (Patent 10,973,613 B2)
IPR2025-00819 (Patent 11,154,384 B2)
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IPR2025-00821 (Patent 11,648,091 B2)

We instituted *inter partes* review in the above-captioned cases following referral to the panel from the Director after consideration of discretionary issues. *See, e.g.*, IPR2025-00818,² Paper 17 (Institution Decision), Paper 14 (Director Discretionary Decision: Refer).

On November 20, 2025, Patent Owner requested “Director Review of the Director’s Discretionary Denial Decision (DD Decision, Paper 14) and the Decision to Institute Trial (DI, Paper 17)” in the above-captioned cases. *See, e.g.*, IPR2025-00818, Paper 19, 1. In its requests for Director Review, Patent Owner challenged the DD Decision and the DI, and argued real-party-in-interest issues, including that Bay Materials LLC was not identified as a real party in interest. *See, e.g., id.*, Paper 19, 1, 10–14 (citing *Corning Optical Commc’ns RF, LLC v. PPC Broadband, Inc.*, IPR2014-00440, Paper 68 (Aug. 18, 2015) (designated precedential Oct. 28, 2025 except § II.E.1)). Previously, Patent Owner had stated in its request to the Director for discretionary denial of the petitions, “Petitioner [Align Technology, Inc.] is a defendant in the parallel litigation, as is each real party-in-interest” *See, e.g.*, IPR2025-00818, Paper 7, 18. Petitioner states that Bay Materials LLC has never been a defendant in the parallel litigation. Ex. 3002.

On March 3, 2026, the Director denied the request for Director Review in each of the above-captioned cases. *See, e.g.*, IPR2025-00818, Paper 29.

² We cite to papers and exhibits filed in IPR2025-00818. Similar papers and exhibits were filed in IPR2025-00819, IPR2025-00820, and IPR2025-00821.

IPR2025-00818 (Patent 10,973,613 B2)
IPR2025-00819 (Patent 11,154,384 B2)
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On March 26, 2026, via email to the Board, Patent Owner requested “authorization to file a motion to compel discovery under 37 C.F.R. §42.51(b)(1)(iii) or, in the alternative, for additional discovery under §42.51(b)(2)(i)” for each of IPR2025-00818, -00819, -00820, and -00821. Ex. 2035. Patent Owner argued that good cause exists to either compel production of the documents sought, “or allow it as additional discovery pursuant to §42.51(b)(2)(i).” *Id.* On March 27, 2026, Petitioner, in its own email to the Board, argued: “Petitioner opposes Patent Owner’s untimely request outside its discovery period for sealed documents from a separate proceeding (IPR2022-01214) involving different parties and a different patent.” *Id.* Thereafter, pursuant to Board authorization (Ex. 3003), Patent Owner filed a Motion for Routine or Additional Discovery (Paper 35, “Mot.”) and Petitioner filed an Opposition to Patent Owner’s Motion for Routine or Additional Discovery (Paper 36, “Opp.”).

Patent Owner seeks discovery of documents that allegedly would support Patent Owner’s argument 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.”³

Mot. 1. More particularly, Patent Owner “seeks production of six unredacted, under seal exhibits from IPR2022-01214: exhibits 2006, 2008,

³ We note Patent Owner availed itself of its one permitted request for Director Review in these proceedings. *See, e.g.*, IPR2025-00818, Paper 19. Those requests, in which Patent Owner argued, *inter alia*, substantially the same the real-party-in-interest position it alludes to here, were denied. *See, e.g.*, IPR2025-00818, Paper 29.

IPR2025-00818 (Patent 10,973,613 B2)
IPR2025-00819 (Patent 11,154,384 B2)
IPR2025-00820 (Patent 11,648,090 B2)
IPR2025-00821 (Patent 11,648,091 B2)

2010, 2014, 2015, and 2016, as well as any other documents containing information inconsistent with Petitioner’s positions here.” *Id.* at 1–2. Patent Owner argues that under the first *Garmin* factor, there is “more than a mere possibility and allegation of finding something useful,” because there is “no doubt that the requested documents exist.” *Id.* at 2 (citing *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 (March 5, 2013) (precedential)). “Nor have Petitioner and its overlapping lead counsel denied that they can access the requested exhibits,” Patent Owner argues. *Id.* Patent Owner also argues that the “additional *Garmin* factors also favor authorizing discovery.” *Id.* at 4–5. More particularly, regarding the fifth *Garmin* factor, Patent Owner argues that its requests are “not overly burdensome, as they merely seek six documents already filed in a PTAB proceeding.” *Id.* at 4.

Petitioner argues that Patent Owner “previously argued that Bay Materials is *not* an RPI” in Patent Owner’s request for discretionary denial and effectively made the same argument in its Preliminary Response. Opp. 2 (citing Paper 7, 18; Paper 9). Petitioner further argues that Patent Owner’s request is untimely and that “no substantive paper remains where [Patent Owner] could submit and discuss any of the requested documents.” *Id.* at 2–3. According to Petitioner, Patent Owner has not established any basis for its requested routine discovery or its requested additional discovery. *Id.* at 3–5. Petitioner argues, finally, that Petitioner “does not have the requested documents.” *Id.* at 5.

Regarding Patent Owner’s request for additional discovery, *Garmin* lists five factors that are relevant to whether the requested additional

IPR2025-00818 (Patent 10,973,613 B2)
IPR2025-00819 (Patent 11,154,384 B2)
IPR2025-00820 (Patent 11,648,090 B2)
IPR2025-00821 (Patent 11,648,091 B2)

discovery is in the interests of justice: (1) the request is based on more than a mere possibility of finding something useful; (2) the request does not seek the litigation positions of the other party; (3) the information is not reasonably available through other means; (4) the request is easily understandable; and (5) the request is not overly burdensome to answer.

Garmin, Paper 26 at 6–7. We focus our inquiry on *Garmin* factor 5.

All the documents requested by Patent Owner in its Motion were filed in IPR2022-01214. Petitioner states: “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.” Opp. 5. We find this representation persuasive on the record before us. Given that Petitioner does not possess or have access to the requested documents, contrary to Patent Owner’s assertion that Petitioner has not denied that it does (Mot. 2), we are unaware of any authority that can compel us to require Petitioner to produce documents that Petitioner does not possess or have access to. To the extent Patent Owner is requesting documents in the possession of Petitioner’s outside counsel, this would be overly burdensome to the point of violating counsel’s confidentiality obligations. As Petitioner notes, Patent Owner’s request that Petitioner’s outside counsel “can access the requested exhibits” is without authority. Opp. 5 (citing Mot. 2). We agree with Petitioner that “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.” *Id.* This creates what appears to be an insurmountable burden. Consequently,

IPR2025-00818 (Patent 10,973,613 B2)
IPR2025-00819 (Patent 11,154,384 B2)
IPR2025-00820 (Patent 11,648,090 B2)
IPR2025-00821 (Patent 11,648,091 B2)

Garmin factor 5 weighs dispositively over the other factors against Patent Owner's argument that it is in the interests of justice to grant additional discovery. Accordingly, we deny Patent Owner's request for discovery under Rule 42.51(b)(2)(i).

Regarding Patent Owner's request for routine discovery, for substantially the same reasons, Patent Owner does not persuade us that the Petitioner can or should produce the requested documents under the provisions of Rule 42.51(b)(1)(iii) regarding routine discovery of "information that is inconsistent with a position advanced by the party." *See, e.g.,* Mot. 2 (citing *Baby Trend, Inc. v. Wonderland Nurserygoods Co.*, IPR2015-00841, Paper 24, 3–5 (Sep. 28, 2015)). Patent Owner criticizes Petitioner for "taking inconsistent positions by arguing obviousness here despite knowledge of relevant objective indicia." *Id.* at 3. Contrary to Patent Owner's suggestion, the record does not contain persuasive evidence that Petitioner knows the content redacted from the confidential documents entered in another proceeding by another party. *See id.* Absent such evidence, we find persuasive Petitioner's argument that ethical requirements related to confidentiality prevent Petitioner from accessing and producing the requested documents. Opp. 5. This dispositive issue did not arise in *Baby Trend*, which did not involve such an intractable barrier. *See Baby Trend*, IPR2015-00841, Paper 24, 2 (discovery opponent not arguing inability to access and produce).

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IPR2025-00819 (Patent 11,154,384 B2)
IPR2025-00820 (Patent 11,648,090 B2)
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ORDER

In view of the foregoing, it is

ORDERED that Patent Owner's motion is *denied*.

IPR2025-00818 (Patent 10,973,613 B2)
IPR2025-00819 (Patent 11,154,384 B2)
IPR2025-00820 (Patent 11,648,090 B2)
IPR2025-00821 (Patent 11,648,091 B2)

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