UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CLEARCORRECT OPERATING, LLC,
Petitioner,

v.

ALIGN TECHNOLOGY, INC.,
Patent Owner.

IPR2025-00821
Patent No. 11,648,091

PATENT OWNER'S MOTION TO SUBMIT SUPPLEMENTAL INFORMATION

I. INTRODUCTION

Pursuant to 37 C.F.R § 42.123(b), Patent Owner Align Technology, Inc. hereby moves for leave to submit the following exhibits as supplemental information:

- Exhibits 2041-2046: Trial transcripts each of the six days of jury trial in *Align Technology, Inc. v. ClearCorrect Operating, LLC*, Case No. 6:24-cv-00187-ADA-DTG (W.D. Tex.)
- Exhibit 2040: Transcript of May 27, 2026, motions hearing in *Align Technology, Inc. v. ClearCorrect Operating, LLC*, Case No. 6:24-cv-00187-ADA-DTG (W.D. Tex.)
- Exhibit 2037: U.S. Patent No. 5,939,519 to Daniel Joseph Brunelle
- Exhibit 2038: U.S. Patent No. 9,963,543 to Kwang Sei Oh et al.
- Exhibit 2039: Won Jae Yoon et al., *Advanced Polymerization and Properties of Biobased High Tg polyester of lsosorbide and 1,4-Cyclohexanedicarboxylic Acid through in Situ Acetylation*, 46(8) Macromolecules 2930 (2013)

The Board authorized the filing of this motion via email in an August 14, 2026, order. Paper 59. The above exhibits have been filed in accordance with that order.

II. LEGAL STANDARDS

Under 37 C.F.R § 42.123, the Board may authorize the filing of

supplemental information relevant to a claim for which trial has been instituted, even where the request is more than one month after institution of trial, upon a showing that "the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice." 37 C.F.R § 42.123(b).

For example, the Board has granted motions for submission of evidence responsive to changes in a petitioner's arguments after the patent owner response, including new arguments at the reply stage. *See, e.g.*, *Sony Interactive Entertainment LLC v. Intellectual Pixels Ltd.*, IPR2020-01248, Paper 28 at 5 (Aug. 18, 2021) (allowing supplemental information in response to arguments raised in reply, regardless of whether "Patent Owner could have been aware of Petitioner's position" earlier, and finding it in the interests of justice to "allow for a more complete record"); *SmartMatic USA Corp. v. Election Sys. & Software, LLC*, IPR2019-00531, Paper 32 at 4-5 (admitting as exhibits introduced in reply deposition as responsive to reply arguments and providing more complete record). The Board has also authorized submission of materials from court proceedings touching on issues relevant to the challenged patent, regardless of whether the proceedings have any preclusive effect in the *inter partes* review. *See, e.g.*, *Curt G. Joa, Inc. v. Fameccanica.Data S.P.A.*, IPR2016-00906, Paper 62 (Jun. 21, 2017) (authorizing filing of U.K. court's decision and factual findings after close of

briefing, where the decision was publicly released after petitioner's reply).

As discussed below, the requirements for late filing of supplemental information are met for each of Exhibits 2037-2046.

III. THE SUPPLEMENTAL INFORMATION REASONABLY COULD NOT HAVE BEEN OBTAINED EARLIER

Exhibits 2041-2046 are public transcripts of the jury trial in the related district court matter. That trial was held from June 22, 2026, through July 1, 2026, and the transcripts were released on the public docket on August 12, 2026.[1] Because the trial occurred after the POR was filed in this case (Feb. 20, 2026) and the transcripts were entered on the public docket later still, they could not reasonably have been obtained earlier.

Exhibit 2040 is a transcript of the May 27, 2026, pre-trial motions hearing in that related district court matter. Petitioner's expert Dr. Osswald was confronted with this transcript during his reply deposition. *See* EX2036, 86:15-101:18, 166-311 (Ex. D). Because this hearing occurred months after the POR was filed in this case, the transcript could not reasonably have been obtained earlier.

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[1] Dr. Osswald was questioned regarding the day three trial transcript during his reply deposition, before the full set of redacted transcripts was added to the docket. *See* EX2036, 102:8-112:21, 312-564 (Ex. E).

Exhibits 2037-2039 are two patents and a scientific article discussing plastic materials including PCCD. Dr. Osswald was confronted with these documents during his reply deposition. *See* EX2036, 34:21-63:5, 138-165 (Exs. A-C). Each exhibit unambiguously discloses that PCCD is a homopolyester, not a copolyester. *See* Sur-Reply, 8-10; EX2037, 2:55-58, 5:3-20, EX2038, 2:10-18, EX2039, 2935. These exhibits rebut Petitioner's new reply arguments attempting to substantiate the petition's unexplained, conclusory assertion that PCCD is a copolyester. *See* Pet., 54; EX1007, ¶182; Reply, 7-8. They further rebut Dr. Osswald's claim that the POR Brunelle exhibit's reference to mixed-isomer PCCD as a "homopolymer" (EX2019, 4104) was a convenience unique to its context and not technically accurate. EX1148, ¶32. These exhibits could not reasonably have been obtained earlier, as they respond to Petitioner's new arguments on reply, which could not have been anticipated due to the lack of explanation for the relevant arguments in the petition materials. *See Sony*, IPR2020-01248, Paper 28 at 5.

IV. ADMITTING THE SUPPLEMENTAL INFORMATION IS IN THE INTERESTS OF JUSTICE

Admitting exhibits 2037-2046 is in the interests of justice because these exhibits show that Petitioner has taken inconsistent positions in parallel proceedings, has mischaracterized the art, and has failed to name all real parties in interest (RPIs) as required. Indeed, Align raised its request for supplemental information after Petitioner not only failed to disclose these inconsistent positions

and mischaracterizations to the Board on its own but went so far as to seek to strike the limited subset of documents in question that were discussed during the deposition of Petitioner's expert. Admitting these exhibits would also provide a more complete record in relation to both Petitioner's arguments and the relevant art. Moreover, admitting EX2037-EX2040 and EX2043 as stand-alone exhibits, instead of just as inclusions in EX2036 (the second deposition transcript of Petitioner's expert), would provide a logical grouping in the docket and consistent pagination between transcript volumes as well as allow more convenient citation.

First, Petitioner has persistently taken inconsistent positions in this proceeding and in the parallel district court proceeding regarding the unpredictability of the art. As the Director has explained, this is unacceptable. *See Magnolia Medical Techs., Inc. v. Kurin, Inc.*, Paper 17 at 4 (precedential) (noting it is a misuse of AIA Review to "take inconsistent positions, without sufficient reasoning, on overlapping issues between district court and the PTAB, suggesting that parties are misleading one tribunal or the other"). Exhibits 2040-2046 provide ample illustration of Petitioner's inconsistent positions regarding unpredictability.

For example, in this IPR Petitioner and Dr. Osswald have advanced combinations premised on predictability of substituting materials into layers in a multilayer aligner. Pet., 59 (asserting combination was "likely to be obvious when it does no more than yield predictable results" (quoting *KSR Int'l Co. v. Teleflex*

Inc., 550 U.S. 398, 416 (2007)). Petitioner attempted to avoid its own arguments that such substitutions were *unpredictable* by inserting numerous caveats and exceptions to such unpredictability, claiming use of adhesive lamination eliminated unpredictability, that "guidance" from the prior art made a substitution predictable, or even that unpredictability somehow applied to all substitutions ***except*** those proposed in the petition. *See* Pet., 22 n.4; EX1148, ¶76 & n.4; EX2017, 99:5-18 (substituting Tritan is predictable, but any other substitution "would have entered a domain of unpredictability"), 100:4-6 ("no motivation to switch to other materials" because that "would introduce unpredictable results"); EX2036, 81:6-86:14.

In contrast to Petitioner's arguments here, in court Petitioner emphatically argued dental aligner development was unpredictable without exception:

> This is not a so-called predictable art in terms of developing these clear aligners. The particular research and development process required to develop an efficacious clear aligner is very complicated and frankly very unpredictable.

EX2040, 56:13-24 (ClearCorrect pre-trial motions argument); *see also id.*, 115:4-116:8 ("unpredictable science" in which "work required to arrive at an efficacious aligner is immense").

> It turns out that the materials used in aligners, it can be quite unpredictable how they're going to interact with each other, and it's difficult and takes hard work and research and development to find an effective composition of materials that will work well, that will be

> safe and effective for patients.

EX2041, 46:7-14 (ClearCorrect's opening statement).

> As context, this is a technology area making multi-layer aligners out of several polymers that involves unpredictable technology, as Dr. Li acknowledged. The ways in which the materials interact with each other is unpredictable.

EX2046, 1980:2-13 (ClearCorrect's closing argument); *see also id.*, 1985:8-9 ("This is trial and error in an area of unpredictable technology.").

Throughout the trial, Petitioner elicited witness testimony to this same effect:

> Q. Mr. Lahlouh, when you make a multi-layer product with multiple layers each with their own individual characteristics, are the properties of the ultimate final multi-layer product predictable or unpredictable?
> A. They're unpredictable.

EX2042, 597:17-22 (testimony of John Lahlouh); *see id.*, 577:17-20 (principal polymer engineer employed at Bay Materials for 24 years); EX2010 (inventor on Bay Materials patent challenged in IPR2022-01214); POR, 61-66.

> Q. And when you say there's a difference between the polymer in the -- in a layer versus a polymer in a -- polymer in a product, what's the difference?
> A. The properties of the product cannot be predicted from the properties of the sheet. The elongation to break in the product is totally different and not predictable from the sheet.

EX2042, 575:17-23 (Lahlouh testimony).

> Q. During your development of Zendura FLX, did you use technical data sheets?
> A. I used them as guidelines, not to predict the outcome of the three layer.
> Q. And based on your experience, how did the properties that were listed on the technical data sheets for the individual polymers relate to the characteristics and properties of the layers in the completed Zendura FLX multi-layer product?
> A. They're different. Totally different.

EX2042, 600:13-601:11 (Lahlouh testimony).

> Q. And if you – if you need a lot of trial and error, does that make a – an art – a field predictable or unpredictable?
> A. No, a lot of trial and error means it's unpredictable.
> Q. Now, is making a multi-layer material for use in a dental aligner, is that predictable or unpredictable?
> A. It is unpredictable.

EX2043, 773:2-10 (testimony of ClearCorrect expert Dr. Stephen Spiegelberg).

As these examples illustrate, Petitioner has taken inconsistent positions regarding the degree of unpredictability in developing multi-layer aligners between district court and this IPR, and its district court arguments are incompatible with the obviousness positions advanced here. As the petition's challenge relies on predictability contradicted by Petitioner's own district court arguments, it is in the

interests of justice to admit these transcripts as supplemental information so that the record of this IPR reflects the full extent of Petitioner's inconsistency.

Exhibits 2040-2046 also provide further evidence that Petitioner has failed to name all RPIs as required. As explained in the POR (66-67) and Sur-Reply (26-27), Petitioner failed to identify Bay Materials as an RPI, despite Bay Materials's close, pre-existing relationship with Petitioner and prospect to benefit from these proceedings. This relationship was further confirmed during the district court proceeding through testimony and attorney argument. For example, in contrast to Petitioner's argument here that Bay Materials "has no infringement risk" (Reply, 26), ClearCorrect argued in court that Align specifically targeted Bay Materials's Zendura FLX with its patents, and testimony also showed that Bay Materials developed its Zendura FLX after producing simulates of SmartTrack.

> Q. Based on the evidence you've seen, what did Align do next with respect to Zendura FLX and Bay Materials?
> A. They filed some more patents.

EX2043, 716:9-12 (Spiegelberg testimony).

> [Y]ou saw that there were changes that went from narrowly tailoring the statements of the Patent Office to SmartTrack in soft-hard-soft. They changed it to broaden it out, broaden it out to get new claims to stop Bay Materials and Zendura FLX.

EX2046, 1992:16-23 (ClearCorrect's closing argument); *see* EX2041, 66:8-68:17

(arguing objective of Align prosecution was "to get this asset off the market. Meaning Bay Materials and Zendura FLX" and that "the patents that they were applying for were going to be used against Zendura FLX and ClearCorrect" to "knock Zendura off the market"); EX2043, 716:9-12; EX2040, 11:14-17; *see also* EX2042, 546:22-21 (John Lahlouh obtained SmartTrack to produce simulates for Bay Materials), 549:11-550:20 (analysis of SmartTrack when developing Zendura FLX, identifying Tritan and Texin materials), 432:11-24, 686:7-19 (same materials in Zendura FLX and SmartTrack); Reply, 5 (claiming Petitioner was unaware of SmartTrack's layers before filing petition); Sur-Reply, 12-13, 25 (discussing relevance of simulates to hindsight and copying).

Finally, as explained above, Exhibits 2037-2039 rebut Petitioner's and Dr. Osswald's new theories on reply trying to recast PCCD as a copolyester, to which Dr. Osswald was unable to provide a satisfactory response. These exhibits would provide the appropriate context for Dr. Osswald's deposition testimony, avoid mischaracterization of the art, provide a more complete trial record, and allow for citation to their content via unique exhibit number separate from the deposition transcript. Admitting them would thus be in the interests of justice.

V. CONCLUSION

For the reasons set forth above, Patent Owner respectfully requests the Board grant this motion to submit supplemental information.

Respectfully submitted,

Date: August 21, 2026

/ Michael T. Rosato /
Michael T. Rosato, Lead Counsel
Reg. No. 52,182

CERTIFICATE OF SERVICE

I certify that the foregoing Patent Owner's Motion to Submit Supplemental Information and exhibits 2037-2046 were served on August 21, 2026, on the Petitioner at the following electronic service addresses:

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