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 LATE SUBMISSION OF SUPPLEMENTAL INFORMATION

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I. INTRODUCTION

ClearCorrect respectfully requests that the Board deny Align's late motion to supplement, which improperly seeks to circumvent the rule prohibiting new Sur-Reply evidence. 37 C.F.R. § 42.23(b).

Align's request to submit 2,183 pages of district court hearing and trial transcripts is not in the interests of justice. *See* EX2040-EX2046. Since the July 2, 2026 jury verdict of nonenablement, the Director has already rejected Align's allegation of inconsistency between ClearCorrect's litigation position that Align failed to enable the *full scope* of its broad claims and IPR arguments that *particular embodiments* within the claims would have been obvious. EX3103 (Director denying Align's July 14 request for Director Review). The Board has previously recognized that it "perceive[s] *no inconsistency* between arguing that the full scope of a claim is not enabled by the specification of a patent while, at the same time, arguing that it would have been obvious to make an embodiment of the claims." *PNC Bank N.A. v. United Servs. Auto. Ass'n*, IPR2021-01077, Paper 73, 83 (PTAB Jan. 20, 2023), *aff'd*, 2025 WL 341868 (Fed. Cir. 2025) (emphasis added).

Moreover, Align omits that it knew of the supplemental information in EX2040-EX2046 before filing its PORs, including when ClearCorrect served Align with an expert report detailing the *same enablement positions* later presented at trial. Align therefore fails to satisfy the requirements of Rule 42.123(b).

Align's request to supplement the record with EX2037-EX2039 should also be rejected. These documents—two U.S. patents issued in 1999 and 2018, respectively, and a 2013 journal article—were available to Align long before it filed its PORs. Align also uses them to improperly advance a new theory for the first time in its Sur-Reply, which is not in the interests of justice. TPG (2019) at 73-74 (a sur-reply may not "embark in a new direction with a new approach").

II. BACKGROUND

Align's motion follows its improper filing of new Sur-Reply evidence as sub-exhibits A-E to the deposition transcript in EX2036. After ClearCorrect approached the Board to strike the improper new evidence under Rule 42.23(b) (EX3004, 5), Align pivoted to belatedly submit the same documents (now EX2037-EX2040, EX2043) as supplemental evidence under Rule 42.123(b). Align also now seeks to add five *more* trial transcripts totaling more than 1,000 pages, much of which pertains to antitrust claims and a patent not at issue here.

III. ARGUMENT

A. Align's Request to Supplement the Record with 2,183 Pages of District Court Transcripts Should Be Denied (EX2040-EX2046)

1. Align Fails to Establish that the Supplemental Information Could Not Have Been Obtained Earlier

Align asserts, based solely on the May-July 2026 dates of EX2040-EX2046, that these "*transcripts* … could not reasonably have been obtained earlier." Paper

62, 3 (emphasis added). This elevates form over substance—Align omits that it previously obtained the *information* in the transcripts long before filing its PORs. 37 C.F.R. § 42.123(b) (requiring showing that the *information* could not reasonably have been obtained).

On January 6, 2026, ClearCorrect served Align with its litigation expert report from Dr. Spiegelberg containing "a complete statement of all opinions the witness will express and the basis and reasons for them," as required by Fed. R. Civ. P. 26(a)(2)(B). The report addressed the *same enablement arguments* that ClearCorrect presented at trial. ClearCorrect also served its final invalidity contentions, including the *same* enablement positions, on August 22, 2025. The trial testimony addressing enablement was limited to the same arguments from Dr. Spiegelberg's report and ClearCorrect's disclosures, as required under the Federal Rules of Civil Procedure.

Likewise, the May 2026 transcript Align cites is from a motion hearing, where ClearCorrect's litigation counsel presented the same arguments contained in the expert report. Finally, Align cites testimony by fact witness Mr. Lahlouh, ignoring that Align took his deposition on November 21, 2025, and that his trial testimony covers similar ground as Dr. Spiegelberg's.

If Align wanted to argue purported inconsistencies between the proceedings (there are none), Align had the *information* contained in the litigation transcripts—including ClearCorrect's enablement arguments—long before filing its PORs on

February 20, 2026. The Board should deny Align's motion to supplement for the same reasons it did so in *Samsung Electronics Co., Ltd. et al v. Maxell, Ltd.*, where the "Patent Owner obtained, or reasonably could have obtained, the *substance and basis* [of a witness's] testimony … in the district court long prior to filing [its] Motion" based on a previously served expert report and a deposition. IPR2024-00828, Paper 50, 3-4 (PTAB Oct. 22, 2025). Rule 42.123(b) does not permit withholding information and arguments from the PORs in favor of late supplementation after merits briefing is complete, as Align seeks to do here.

2. Submitting the District Court Transcripts Is Not in the Interests of Justice

Submitting the district court transcripts is also not in the interests of justice, including because there is no inconsistency between the district court and IPR arguments. Align omits that the Director already rejected Align's arguments based on the same district court jury verdict and the same unfounded allegations of inconsistency. EX3103, 1-3 (Align alleging "inconsistent positions"). Align fails to identify any reason why retreading these issues would be in the interests of justice, particularly as the oral hearing and Final Written Decision deadline approach.[1]

[1] Align's reliance on *Curt G. Joa*, involving submitting a UK court decision, is inapposite (Paper 62, 2), as ClearCorrect previously identified the jury verdict (Paper 47). Here, Align seeks to clutter the record with *everything but* the jury's decision.

Indeed, there is no inconsistency between following express prior-art guidance to make *an embodiment* within the claims (ClearCorrect's obviousness grounds) and noting Align's failure to enable the *full scope* of its expansive claims. *See* EX3103, 1 (ClearCorrect explaining same to the Director). From the outset of this IPR, ClearCorrect has been upfront about its enablement positions. Pet., 1-4, 22 n.4. The Petitions expressly state that, while general unpredictability in the art contributed to Align's failure to enable the full scope of its broad claims, those district-court disputes did "not affect the obviousness analysis here" because all challenged claims are unpatentable based on the particular prior-art embodiments set forth in the IPR grounds. Pet., 22 n.4. Despite the Petitions raising this point, Align never addressed the district court litigation in its POR and fails to justify that omission now in seeking supplementation of the record.

ClearCorrect's position that certain embodiments taught by the prior art would have been obvious while the full scope of the broad claims remains nonenabled is amply supported by the Board's precedent. The Board has explained, for example, that "the issue of whether the full scope of the claims is enabled is distinct from whether the prior art combination teaches an embodiment of the claims." *PNC*, IPR2021-01077, Paper 73, 37 n.25, 83. In *PNC*, the Board rejected arguments similar to Align's, concluding that testimony about enablement of the full claim scope was "*not particularly helpful* to determining whether an ordinarily skilled

artisan would have been motivated to combine [the cited art with] a reasonable expectation of success." *Id.* at 37-38 (emphasis added). It is not in the interests of justice to supplement the record with voluminous trial transcripts, where even the limited parts addressing enablement have no bearing on the obviousness issues here.

Since no obviousness arguments were presented at trial, Align's cited district court testimony does not address the express prior-art teachings forming the basis of the IPR grounds. For example, the trial testimony does not address the express guidance in *Kalili* (all grounds) to use TEXIN 990R as the soft layer in a multilayer aligner based on its "outstanding" properties. Pet., 31-35; EX1005, [0069]. Align cites no authority to support that it would have been anything other than obvious to use a specific, *outstanding* prior-art material for its same known purpose. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) (using "old elements with each performing the same function it had been known to perform" is obvious).

Similarly, none of Align's cited testimony addresses *Tadros*'s specific guidance to use a polycarbonate/copolyester mixture as the hard layer in a three-layer aligner, or *Porter*'s announcement of Tritan copolyester as a drop-in replacement for polycarbonate. *See id.* Nor does any of the cited testimony address the advantages of using adhesive lamination, which Dr. Osswald testified without rebuttal would maintain the desirable, *outstanding* properties of the materials in the Petitions' grounds. EX1149, 80:18-82:3 (Align's Dr. Kimmel declining to disagree).

Accordingly, the presence of specific, predictable prior-art embodiments within a broad claimed genus is not inconsistent with Align failing to enable the *full scope* of the claims. *See* EX1149, 109:5-111:12 (Dr. Kimmel conceding that Align's claims encompass using many copolyesters and TPUs, along with a third layer of "any polymer that exists"). As the Board has explained, enablement and obviousness are "distinct" issues, and enablement-directed testimony is "not particularly helpful" in assessing the specific prior-art grounds presented here. *PNC*, IPR2021-01077, Paper 73, 37-38, 83 ("no inconsistency" exists).[2] The interests of justice therefore do not support late supplementation of the record.

3. Align's Previously Rejected RPI Arguments Fail to Support Late Supplementation of the Record

Align's argument that Bay Materials is allegedly an unnamed RPI is wrong and also fails to justify late supplementation. Paper 29 (Director denying review of Align's RPI arguments); Paper 31 (Board finding no "good cause" to "hear another challenge based on these same [RPI] issues").

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[2] Align's reliance on *Magnolia*, which involved re-litigating the same §102 and §103 challenges that failed in district court, is inapposite. Paper 62, 5. Here, ClearCorrect raised no obviousness challenges in the district court trial, and as detailed above, the Board in *PNC* has explained that enablement and obviousness are distinct issues.

Align has long known that ClearCorrect is a Bay customer and uses Zendura FLX, which Bay independently developed before being acquired by Straumann. *See* POR (Paper 27), 61; Reply (Paper 39), 22-23, 27-28. Align's unsupported argument that Bay is at infringement risk, meanwhile, is contradicted by (1) Align choosing not to sue Bay in the parallel litigation, and (2) Align's previous representation to the Director that all RPIs were already named in both the IPRs and the district court litigation. Paper 7, 18. The interests of justice thus do not favor supplementation in view of Align's previously rejected RPI arguments.

B. Align's Request to Supplement the Record with Pre-POR Published Literature Should Be Denied (EX2037-2039)

EX2037-EX2039 are two U.S. patents published in issued in 1999 and 2018, respectively, and a 2013 journal article. They originate from only two research groups, with EX2037 sharing a common inventor/author with the Brunelle reference (EX2019) that Align previously submitted. Because the most recent of these publications is nearly a decade old, Align could have obtained them earlier.

The interests of justice also weigh against late supplementation. Align contends it should be permitted to submit EX2037-EX2039 to "rebut" an allegedly "new" argument in ClearCorrect's Replies. Paper 62, 4. But no such new argument exists in the Replies. Moreover, Align uses the exhibits to advance a Sur-Reply argument that is not only new, but also contradicts its POR arguments. Align's

request thus contravenes Rule 42.23(b)'s prohibition on new Sur-Reply evidence and the TPG's caution against new Sur-Reply theories. TPG, 73-74.

Align's PORs disputed the Petition's reliance on *Tadros*'s polycarbonate-PCCD mixture as the claimed "hard polymer layer comprising a co-polyester." Pet., 30. In particular, Align advanced Dr. Kimmel's "monomer" theory—i.e., that PCCD is made from a "*single monomer*, meaning that PCCD is a *homopolymer*," rather than a copolyester. POR, 16 (emphasis added). ClearCorrect and its expert debunked that theory, as PCCD is made from multiple monomers. *E.g.*, EX1148, ¶¶13-16 (Dr. Osswald identifying the *multiple monomers* that produce PCCD).

Unable to defend its "monomer" theory, Align pivoted, now arguing that it is "irrelevant" that PCCD is made from multiple monomers because PCCD is made from a "single type of recurring polyester unit," making it a "homopolyester." Sur-Reply, 5-6. This improper new argument was based entirely on EX2037-EX2039. Sur-Reply, 8 (citing this "[a]dditional literature" regarding "homopolyesters").

Align's argument that it should be permitted to file EX2037-EX2039 to address an allegedly "new" and unanticipated Reply argument thus lacks credibility. Paper 62, 4. The Petitions assert that PCCD is a copolyester and the Replies defend that assertion, showing the error in Align's "monomer" theory. Align's new "homopolyester" argument cannot "rebut" ClearCorrect's Reply arguments because those arguments responded to a theory that Align is now abandoning and that is

inconsistent with its new "homopolyester" argument. Align thus attempts to use EX2037-EX0239 *not* to rebut ClearCorrect's argument, but instead to pivot to a new Sur-Reply argument. Align's motion represents an improper end run around the prohibition of new Sur-Reply evidence in Rule 42.23(b).

Align's reliance on *SmartMatic* and *Sony Interactive* are inapposite. Paper 62, 2. ClearCorrect did not cite a new statute in its Replies to support its original positions, as occurred in *SmartMatic USA Corp. v. Election Sys. & Software, LLC*, IPR2019-00531, Paper 32, 4-5 (PTAB Mar. 13, 2020). Nor did ClearCorrect submit a new reference in its Replies that was implicitly implicated in the Petitions but not expressly discussed, as occurred in *Sony Interactive Entertainment LLC v. Intellectual Pixels Ltd.*, IPR2020-01248, Paper 28, 5 (PTAB Aug. 18, 2021); *see* Pet., 30 (expressly relying on *Tadros*'s disclosed PCCD copolyester). Instead, ClearCorrect merely debunked Align's and Dr. Kimmel's "monomer" theory as unsupported and scientifically incorrect.

Align's gamesmanship with its impermissible new Sur-Reply arguments fails to establish that the interests of justice support submitting 8+ year old literature that was undisputedly previously available to Align. 37 C.F.R. § 42.123(b).

IV. CONCLUSION

ClearCorrect respectfully requests that the Board deny Align's motion.

Respectfully submitted,

Dated: August 28, 2026

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

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing **PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION FOR LATE SUBMISSION OF SUPPLEMENTAL INFORMATION** was served on August 28, 2026, via email directed to counsel of record for 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
Email: wsgr_ptab@wsgr.com

Matthew A. Argenti
Wilson Sonsini Goodrich & Rosati
650 Page Mill Road
Palo Alto, CA 94304
Email: margenti@wsgr.com

Jessica Kaiser
Ashurst Perkins Coie US LLP
1900 Sixteenth Street, Suite 1400
Denver, CO 80202-5255
Email: kaiser-ptab@perkinscoie.com

Christopher Marando
Ashurst Perkins Coie US LLP
700 Thirteenth Street N.W., Suite 800
Washington, DC 20005-3960
Email: marando-ptab@perkinscoie.com

Dated: August 28, 2026

By: / William Esper /

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