

**From:** [Director Discretionary Decision](#)  
**To:** [Rosato, Michael](#); [Director Discretionary Decision](#)  
**Cc:** [McCammon, Luke](#); [Magdun, Melanie](#); [Howarth, Kyle](#); [Daley, Kathleen](#); [Berlenbach, Anthony](#); [Zhang, Xirui](#); [Mathew, Jency](#); [ClearCorrect IPR Attorneys](#); [Argenti, Matthew](#); [Medley, Patrick](#)  
**Subject:** RE: Request for authorization to file reply in IPR2025-00814, -00815, -00816, -00817, -00818, -00819, -00820, and -00821  
**Date:** Monday, August 18, 2025 2:34:53 PM

---

Patent Owner is authorized to file a 3-page reply in IPR2025-00814 through -00821, due no later than Wednesday, August 20, 2025, limited to addressing the arguments raised below. Patent is further granted authorization to file the documents listed below.

---

**From:** Rosato, Michael <mrosato@wsgr.com>  
**Sent:** Friday, August 15, 2025 3:05 PM  
**To:** Director\_Discretionary\_Decision <Director\_Discretionary\_Decision@uspto.gov>  
**Cc:** McCammon, Luke <luke.mccammon@finnegan.com>; Magdun, Melanie <melanie.magdun@finnegan.com>; Howarth, Kyle <kyle.howarth@finnegan.com>; Daley, Kathleen <kathleen.daley@finnegan.com>; Berlenbach, Anthony <anthony.berlenbach@finnegan.com>; Zhang, Xirui <xirui.zhang@finnegan.com>; Mathew, Jency <jency.mathew@finnegan.com>; ClearCorrect IPR Attorneys <clearcorrect-ipr-attorneys@finnegan.com>; Argenti, Matthew <margenti@wsgr.com>; Medley, Patrick <pmedley@wsgr.com>  
**Subject:** Request for authorization to file reply in IPR2025-00814, -00815, -00816, -00817, -00818, -00819, -00820, and -00821

**CAUTION:** This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Honorable Director,

On August 8, 2025, Petitioner (ClearCorrect) filed its opposition briefs in response to Patent Owner's (Align) briefs requesting discretionary denial in IPR2025-00814, -00815, -00816, -00817, -00818, -00819, -00820, and -00821. Those opposition briefs contain new argument citing a voluminous list of new exhibits (up to 27 new exhibits). Patent Owner requests authorization to file a reply to briefly address the following topics:

- **Excessive argument directed to the merits:** The Oppositions' extensive focus on the alleged merits of the petitions is not commensurate with the specific issues raised in Patent Owner's briefs. For example, the brief in IPR2025-00817 (Paper 7 at 19) presents one sentence addressing merits relating to 325(d)—whereas Petitioner's Opposition dedicates 16 pages arguing the alleged merits of its petition. Such argument is prejudicial as attempting to improperly cast discretionary denial as a prior art-intensive inquiry.
- **Attorney speculation about trial re-scheduling:** The trial date agreed-upon by the parties and scheduled by the Court would precede any FWDs by the Board by about 6 months. New

argument regarding potential re-scheduling is speculative at best.

- New argument regarding overlap with invalidity challenges at District Court:
  - Petitioner's briefs argue "it is common...to narrow the grounds submitted in initial invalidity contentions." See, e.g., IPR2025-00818, Opp. at 35. On Aug. 4, 2025, Petitioner submitted its "Prior Art Narrowing Disclosure" at District Court but that document was not submitted here. Said document cites, inter alia, the same prior art relied upon in the IPR petitions.
  - Petitioner argues that pre-trial narrowing of infringement assertions for the '217, '879, and '456 patents (-00814, -00815, -00816 IPRs) renders *Fintiv* "inapplicable" for those patents. But Petitioner's declaratory judgment action challenging these same patents remains pending in the district court case. See IPR2025-00818, EX2008, at 188-90, 191-93, 195-97 (counts 24, 26, 28). Petitioner reaffirmed its commitment to the declaratory judgment action with its Aug. 4, 2025, filing that continued to assert the '217, '879, and '456 patents are invalid.

As such, Patent Owner seeks authorization to file a 3-page reply in each IPR. Patent Owner also requests authorization to submit (1) Petitioner's "Prior Art Narrowing Disclosure," as noted above, in each case; and (2) Petitioner's District Court Answer and Counterclaims (noted above as EX2008 in IPR2025-00818) in cases IPR2025-00814, -00815, and -00816.

The parties have conferred, and Petitioner's written statement is provided below:

Petitioner opposes Patent Owner's request for a reply. Patent Owner contends it "presents one sentence addressing merits." In reality, it repeatedly addressed the merits throughout its briefs. See, e.g., IPR2025-00817, Paper 7 at 1, 9, and 18-25 (addressing merits); IPR2025-00816, Paper 7 at 1-3, 6-7, 10, 18-24, and 24-34 (same); IPR2025-00820, Paper 7 at 1-2, 3-4, 10, 19-25, and 25-34 (same). Petitioner's responses to those arguments, including regarding the Office's material errors, warrant no reply.

Patent Owner's briefing likewise put trial timing at issue, including citing time-to-trial statistics. Petitioner simply provided up-to-date statistics and pointed out that trial was already pushed back once, again not warranting any reply.

Finally, Patent Owner's argument regarding Petitioner's district court invalidity contentions and counterclaims ignores that (1) Petitioner's *Sotera* stipulation is effective only upon institution and (2) Petitioner has already informed Patent Owner that Petitioner would agree to a stipulation of dismissal without prejudice of the invalidity counterclaims for the '217, '879, and '456 patents given Patent Owner's dismissal without prejudice of its infringement claims relating to those patents.

Regarding Petitioner's new argument here regarding its potential agreement to dismiss its invalidity counterclaims, this idea was first floated only after Patent Owner contacted Petitioner regarding this reply request. Nothing has been filed.

Respectfully,

Michael T Rosato (Counsel for Patent Owner)  
Wilson Sonsini Goodrich & Rosati  
[o] 206.883.2529 | [f] 206.883.2699  
[mrosato@wsgr.com](mailto:mrosato@wsgr.com)

This email and any attachments thereto may contain private, confidential, and privileged material for the sole use of the intended recipient. Any review, copying, or distribution of this email (or any attachments thereto) by others is strictly prohibited. If you are not the intended recipient, please contact the sender immediately and permanently delete the original and any copies of this email and any attachments thereto.