

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CLEARCORRECT OPERATING, LLC,  
Petitioner,

v.

ALIGN TECHNOLOGY, INC.,  
Patent Owner.

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Case No. IPR2025-00814  
Patent No. 10,456,217

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**PATENT OWNER'S BRIEF IN SUPPORT OF  
DISCRETIONARY DENIAL**

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## I. INTRODUCTION

Patent Owner Align Technology, Inc. (“PO” or Align) requests the Director to exercise discretion to deny institution of *inter partes* review of U.S. Patent No. 10,456,217 (“the ’217 patent”), pursuant to Memorandum, *Interim Processes for PTAB Workload Management* (USPTO Dir. Mar. 26, 2025) (“Workload Memo”).

The present case, like all the related IPR petitions (IPR2025-00814 – IPR2025-00821), is a textbook instance that warrants exercising discretion to deny the challenge. Due to Petitioner’s delay, the Board’s final written decision wouldn’t be expected until 6 months after trial in the Western District of Texas. Petitioner’s lack of diligence is inexcusable and the resulting waste of judicial resources self-inflicted. Despite challenging a patent that issued more than 5 years ago, litigation between the parties since 2011, and dozens of failed patent challenges initiated more than a decade ago, Petitioner went dormant for years and waited to file IPRs until just days before the end of the statutory period. Worse yet, Petitioner’s delayed challenge merely asks the Board to revisit the same prior art references Petitioner already advanced and the Board rejected years ago in an IPR of a patent to which the ’217 patent claims priority (IPR2017-01829). Petitioner belatedly attempts to now plug the holes in its prior challenge but misses the mark and fails to address, much less overcome, the Office’s prior findings supporting nonobviousness.

First, the *Fintiv* framework favors discretionary denial, as Petitioner is currently pursuing the same invalidity arguments raised in the petition in a parallel district court proceeding. Petitioner has long known of this patent and the patents in the '217 patent's family but waited to file this IPR until nearly the statutory bar date.<sup>1</sup> As a result, the district court case is now at an advanced stage and Petitioner's arguments will be addressed by the district court months before a final written decision in this proceeding. Petitioner's promise of a *Sotera* stipulation subsequent to institution does not mitigate the waste of judicial resources arising from overlapping issues, given the late stage of the case by the time of an expected institution decision, and given Petitioner's failure to challenge (or direct its stipulation to) all of the patents asserted in the parallel litigation. Petitioner's

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<sup>1</sup> Petitioner has now belatedly filed IPR challenges against four related multilayer dental appliance patents (IPR2025-00818, -00819, -00820, & -00821), three related dental treatment planning patents (IPR2025-00814, -00815, & -00816), and a dental model imaging patent (IPR2025-00817). All eight challenged patents (plus another related patent unchallenged in IPR) are asserted in the same copending district court litigation.

lengthy acquiescence to the validity of Align's patents further supports denial of institution based on the parties' settled expectations.

Second, the petition offers nothing new but instead recycles art and arguments the Office previously considered, making denial appropriate under §325(d). The petition relies primarily on previously considered art (i.e., the two grounds references Petitioner previously advanced and the Board rejected in an IPR against a family member of the '217 patent). The attempts to paper over this rehash with "new" secondary references plainly cumulative to art the Office previously considered, including a reference selected using the Board's prior decision as a roadmap, still fail to address the deficiencies the Board found in Petitioner's previous challenge. Indeed, the Board expressly found the same prior art Petitioner relies on now actually *taught away* from the modification Petitioner proposes, yet Petitioner does not even acknowledge, much less rebut, this finding.

Accordingly, the present petition is a poor use of the Board's limited time and resources. PO respectfully requests the Director exercise discretion to *deny institution*.

## **II. BACKGROUND**

Align Technology, Inc. designs, develops, manufactures and markets high-technology, custom-manufactured orthodontic devices, as well as providing related products and services including dental scanning and treatment planning.

Petitioner ClearCorrect, a competing dental-aligner manufacturer, has been aware of Align's patent portfolio since at least 2011, when Align first sued Petitioner for patent infringement in *Align Technology, Inc. v. ClearCorrect Inc.*, No. 4:11-cv-00695 (S.D. Tex. Feb. 28, 2011). Align also filed two ITC actions against Petitioner in 2012: *In the Matter of Certain Incremental Dental Position Adjustment Appliances and Methods of Producing Same*, Inv. No. 337-TA-562; and *In the Matter of Certain Digital Models, Digital Data, and Treatment Plans for Use in Making Incremental Dental Positioning Adjustment Appliances, the Appliances Made Therefrom, and Methods of Making the Same*, Inv. No. 337-TA-833.

Beginning in 2015, Petitioner launched a multi-year campaign challenging Align's patent portfolio. From 2015 to 2017, Petitioner filed a total of 26 reexamination requests challenging Align's patents: Reexamination Control Nos.

90/013,581;

90/013,947;

90/013,457;

90/013,904;

90/013,905;

90/013,917;

90/013,606;

90/013,946;  
90/013,775;  
90/020,116;  
90/013,506;  
90/013,788;  
90/014,090;  
90/013,491;  
90/013,911;  
90/013,912;  
90/013,918;  
90/013,607;  
90/013,777;  
90/014,049;  
90/013,579;  
90/013,981;  
90/013,505;  
90/013,928;  
90/013,929; and  
90/013,931.

These challenges failed almost entirely: only one patent claim was canceled (*see* Reexamination Control No. 90/013,788) and only a single patent claim was amended (*see* Reexamination Control No. 90/013,607), while all other challenged claims were upheld as patentable.

Petitioner also filed two IPRs challenging Align's patents, neither of which resulted in any canceled claims. *See ClearCorrect Operating LLC v. Align Technology, Inc.*, IPR2016-00270, Paper 55 (Apr. 9, 2019) (terminating case after remand from Federal Circuit); *ClearCorrect Operating LLC v. Align Technology, Inc.*, IPR2017-01829, Paper 10 (Feb. 5, 2018) (denying institution). The second of these cases challenged U.S. Patent No. 8,038,444 (the '444 patent), which had never been asserted against Petitioner, but which is now asserted in the parallel litigation. The '217 patent claims priority to the '444 patent, and the '444 patent's IPR record was considered during prosecution. EX1002, 57, 200, 210-27.

After its unsuccessful challenges to Align's patent portfolio and its proven infringement in both the ITC and in district court, Petitioner settled with Align. EX2008, ¶2. Petitioner gave up on its strategy of challenging Align's patent portfolio before the Office, and as of 2017, ceased filing new challenges against Align's patents. Petitioner maintained this state of acquiescence until the filing of these IPR petitions in April of 2025.

In 2024, Align filed a new lawsuit (the “parallel litigation”) to remedy Petitioner’s continuing infringement of nine of Align’s patents. EX1023. The asserted patents include the ’444 patent and three related patents, one of which is the ’217 patent. *Id.*, ¶42. The patents also include U.S. Patent No. 10,791,936, as well as four patents infringed by aligners made using materials manufactured by Bay Materials, LLC, which like ClearCorrect is a member of the Straumann Group. *Id.* The parallel litigation is currently pending in the Western District of Texas before Judge Albright, with jury trial scheduled on May 11, 2026.

Petitioner waited a year after being served with the complaint alleging infringement of these patents; then, with just ten months remaining before the court had scheduled trial, Petitioner filed IPR petitions challenging eight of the nine asserted patents, including the instant petition challenging the ’217 patent. *See* EX2002 (setting Feb. 16, 2026, trial date); EX2003 (updating trial date to May 11, 2026). The ninth patent is the ’444 patent that Petitioner previously challenged unsuccessfully in IPR2017-01829. Petitioner is now time barred on the ’444 patent, making it impossible for Petitioner’s IPR petitions to resolve the parallel litigation; indeed, Petitioner asks the Board to resolve many of the same issues in the present IPR as the court will be required to resolve at least for the ’444 patent. As explained below, the Director should exercise discretion to deny institution of the instant petition.

### **III. THE DIRECTOR SHOULD EXERCISE DISCRETION TO DENY THE PETITION**

The Director should exercise discretion to deny institution for multiple reasons. First, the *Fintiv* framework under §314(a) weighs strongly in favor of discretionary denial due to overlap with the parallel litigation in the Western District of Texas, which will come to trial before a final written decision is due in this proceeding. Denying institution would avoid wasting judicial resources, as well as uphold the settled expectations demonstrated by Petitioner's longstanding acquiescence to the validity of Align's patents. Second, the *Advanced Bionics* framework under §325(d) weighs in favor of discretionary denial because the petition advances art and arguments previously considered by the Office and fails to show material error.

Accordingly, for the reasons detailed below, the Director should exercise discretion to deny institution of the petition.

#### **A. *Fintiv* Weighs in Favor of Discretionary Denial under §314(a)**

The Director should exercise discretion under 35 U.S.C. §314(a) to not institute this proceeding. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (March 20, 2020) (precedential). As Petitioner admits, a parallel District Court litigation is ongoing between the parties before Judge Albright in the Western District of Texas. *See Pet.*, 74; *supra*, §II. This parallel litigation is already in its late stages and will finish long before a final written decision would issue in these

proceedings. There is significant overlap of issues between this proceeding and the parallel litigation, and additional factors including settled expectations of the parties and the proven weakness of the recycled petition grounds further favor discretionary denial.

**1. Factor 1: The District Court Litigation Has Not Been Stayed And Is Unlikely To Be Stayed Even If This Petition Were Instituted**

This factor weighs against institution because a stay of the parallel litigation is highly unlikely. Petitioner has not sought a stay, and the Board's institution decision is expected by November 8, 2025. Because the parallel litigation will be in its late stages by the expected time of the institution decision, it is unlikely that Judge Albright would grant a stay even if the Petition were instituted. *E.g., Sonrai Memory Ltd. v. Micron Tech., Inc.*, No. 1:23-CV-01407-ADA, 2024 U.S. Dist. LEXIS 231280, at \*2, \*7 (W.D. Tex. May 29, 2024) (Albright, J.) (denying stay when *Markman* hearing was held and fact discovery opened two weeks before institution).

In particular, by mid-November—just six months before the trial is to begin—infringement and invalidity contentions will be finalized, document production will be complete, fact discovery will be closed, and expert reports will be imminently due. *See* EX2003. The *Markman* hearing was completed in the parallel litigation three months before the instant petition was even filed, and a

final claim construction order has already issued. *Supra* §II. Given the advanced stage of the parallel litigation, the district court will have “expended significant resources” by the time of an institution decision and would be unlikely to grant a stay. *See Sonrai*, 2024 U.S. Dist. LEXIS 231280, at \*2, \*7.

Furthermore, although Align asserted nine patents against Petitioner in the parallel litigation, Petitioner only filed IPR challenges against eight of these patents. In 2017, Petitioner filed an IPR challenge against the remaining patent, U.S. Patent No. 8,038,444, but institution was denied on the merits. *See ClearCorrect Operating LLC v. Align Technology, Inc.*, IPR2017-01829, Paper 10 at 17 (Feb. 5, 2018). Petitioner is time barred from challenging the ’444 patent in an *inter partes* review, so even granting all pending IPR petitions would not eliminate all patents from the parallel litigation. These circumstances further diminish any chance of a stay. *See, e.g., Smart Mobile Techs. LLC v. Apple Inc.*, No. 6:21-cv-00603-ADA, 2023 U.S. Dist. LEXIS 137593, at \*18-19 (W.D. Tex. Aug. 8, 2023) (Albright, J.) (denying stay where institution was granted for some but not all asserted patents).

Accordingly, Factor 1 favors denying institution.

**2. Factor 2: A Final Written Decision Would Likely Issue Six Months After Trial**

This factor weighs against institution because trial is scheduled to begin six months before the projected final written decision is due. “If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution....” *Fintiv*, Paper 11 at 9.

Over a year into the litigation, the parties in the parallel litigation jointly requested trial in May 2026, and the court has issued a revised scheduling order setting trial for May 11, 2026. EX2003; EX2006.<sup>2</sup> Were the Director to not discretionarily deny institution, the Board’s institution decision would be expected by November 8, 2025. Accordingly, the projected statutory deadline for a final

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<sup>2</sup> While the parties and the Court have all agreed on a May 2026 trial date, Petitioner (ClearCorrect) advocated for an even more accelerated pre-trial calendar. For example, Petitioner requested earlier pre-trial dates for the service of final infringement and invalidity contentions and the close of fact and expert discovery than was ordered by the Court. *See* EX2006; EX2003. Thus, while Petitioner was exercising a lack of diligence in bringing its IPR challenges, it was advocating for an accelerated pre-trial calendar.

written decision would be November 8, 2026, *six months after the trial date* of May 11, 2026. Judge Albright is unlikely to grant any further adjustment to the trial date, as he has a practice of “not mov[ing] the trial date except in extreme situations.” EX2005. The scheduling of the district court’s trial date six months before the expected date of final written decision weighs strongly in favor of denying institution. *See, e.g., Samsung Elecs. Co. v. TrueSight Commc’ns LLC*, IPR2025-00123, Paper 12 at 7, 10-11 (Apr. 22, 2025) (instituting trial over *Sotera* stipulation where district court trial had been scheduled “at least six months before the projected statutory deadline for a final written decision,” finding this factor “favors discretionary denial”); *Nokia of Am. Corp. v. Cellco P’ship*, IPR2025-00037, Paper 14 at 10, 15-16 (Apr. 25, 2025) (same).

The court’s recent adoption of a trial date agreed to by both parties gives confidence that it is no mere preliminary estimate, but even if the Director considers median time-to-trial statistics instead of the scheduled trial date, the trial would still precede the expected final written decision. The median time-to-trial for the Western District of Texas as a whole is 25 months, with Judge Albright having the same median time-to-trial. EX2004. As the complaint was filed and served in the parallel litigation in April 2024, a 25-month time-to-trial would predict a trial date of May 2026, six months before a predicted final written decision date in this case. The median time-to-trial statistics thus dictate the same conclusion as the

scheduled trial date: that trial will occur long before a final written decision would be expected.

Accordingly, Factor 2 strongly favors denying institution.

**3. Factor 3: The Court And Parties Have Invested Heavily In The Parallel Litigation**

This factor weighs against institution because the parties and the court have already invested and will continue to invest significant resources in the parallel litigation. The Board weighs “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, Paper 11 at 9. The Board has also explained that if, at the time of an institution decision, the district court will have issued substantive orders related to the challenged patent, such as a claim construction order, this fact weighs in favor of denial. *See Fintiv*, Paper 11 at 9-10. Here, the *Markman* hearing took place before the petition was even filed and the district court has already issued its final claim construction order. Accordingly, the parties and the court have invested heavily, given the advanced stage of the litigation.

Moreover, the Board has explained it considers the Petitioner’s diligence in filing the Petition in weighing this factor. *Id.*, 11 (considering whether “the petitioner filed the petition expeditiously, such as promptly after becoming aware

of the claims being asserted...”). The Petitioner here has been anything but diligent.

The complaint in this case was served on April 15, 2024, and Petitioner waited until nearly the last day before its statutory bar date to file the instant petition. Consequently, the parties and the district court had already completed a substantial amount of work before the petition was even filed. Fact discovery began and preliminary infringement contentions were served in July 2024, and invalidity contentions were served in September 2024, seven months before the instant petition was filed. *See* EX2002. The district court held a *Markman* hearing and issued preliminary constructions in January 2025, three months before the petition was filed. *See* EX2002; EX2007. The district court subsequently issued a final claim construction order adopting substantially identical constructions. *See* EX2001.

On or about the time the Board decides whether to institute this IPR in November 2025, still more resources will have been expended. Document production will have long been substantially completed (July 18, 2025); final infringement and invalidity contentions will be served (August 22, 2025); fact discovery, including all depositions of fact witnesses, will have closed (October 17, 2025); and expert discovery will be well underway with expert reports due contemporaneously (Nov. 14, 2025). EX2003. In sum, the parallel district court

litigation will be in its late stages with a substantial amount of work already completed.

As the Director has noted, “factor 3 strongly favors discretionary denial” when around the time of institution, “the parties had served extensive infringement and invalidity contentions, served opening and rebuttal expert reports, filed claim construction briefs, and conducted several depositions” and the court “also had held a claim construction hearing and construed the disputed claim terms.”

*Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3 (Mar. 18, 2025) (Order Granting Director Review, Vacating the Decision Granting Institution, and Denying Institution of *Inter Partes* Review). Here, the similarly late posture and degree of expended resources confirm that factor 3 strongly favors denying institution.

**4. Factor 4: There Is Significant Overlap Between Issues Raised In The Petition And In The Parallel Litigation**

This factor weighs against institution given the significant overlap between the petition and the parallel litigation. The parallel litigation involves the '217 patent challenged in the instant proceeding as well as eight other patents, seven of which are subject to IPR challenges by Petitioner.

In its invalidity contentions, Petitioner has identified the same art advanced in the instant petition, along with other art it reasonably could have raised earlier.

*See* EX2009, 51-60 (identifying references including Chishti-511, Chishti-876, Sachdeva, and Becker, matching art asserted in instant IPR). Furthermore, Petitioner has identified other alleged prior art, including system and device art, as available in obviousness combinations with the same art relied on in the petition grounds. EX2009, 41-51 (alleging device and system art), 34-40 (identifying references as teaching knowledge in art), 179-80 (identifying various combinations including references cited in instant IPR); *see also id.*, 289 n.29 (“Chishti-’876’s disclosure is identical to Chishti-’400 (U.S. published patent application 2004/0137400).”).

While Petitioner has offered a *Sotera* stipulation not to pursue for this patent “any ground raised or that could have been reasonably raised in this petition” (Pet., 76-77),<sup>3</sup> the Director has confirmed that such a stipulation does not eliminate the overlap of issues considered in factor 4, as such a stipulation is not sufficient to ensure that IPR proceedings are a “true alternative” to district court proceedings.

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<sup>3</sup> Petitioner states that all defendants in the parallel litigation have agreed to be bound by the stipulation. To avoid confusion or misleading argument from Petitioner, the defendants named in the parallel litigation are member entities of the same Straumann Group.

*Motorola*, Paper 19 at 3-4; see also Chief Admin. Pat. J., *Guidance on USPTO’s Recission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation”* 2-3 (March 24, 2025) (*Sotera* stipulation not dispositive of *Fintiv* analysis). The stipulation offered here does little to mitigate overlap of issues and waste judicial resources for several reasons.

First, Petitioner at district court has entangled the same prior art references asserted here together with non-IPR eligible art and arguments in a way that minimizes the impact of its stipulation. Here, as in *Motorola*, Petitioner’s district court invalidity contentions “include combinations of the prior art asserted in these proceedings with unpublished system prior art,” which Petitioner’s stipulation does not moot. *Motorola*, Paper 19 at 4; cf. *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, slip op. at 15-16 (Fed. Cir. May 7, 2025) (any ground including art “known or used by others, on sale, or in public use” is a ground that “could not have been raised during the IPR”).

Second, the belated filing of the petition and advance stage of the litigation ensures that significant amounts of overlapping efforts will be completed that are not undone by stipulation. Specifically, the late timing of the institution decision, scheduled after all fact discovery is complete and at about the same time expert reports are due, means that most of the overlapping efforts in the district court

proceeding will already have occurred before Petitioner's stipulation could go into effect.

Third, Petitioner has offered no stipulation regarding the '444 patent, which is not subject to an IPR challenge, so the district court will still be required to consider a full panoply of art combinations during trial for at least that patent. Given the overlap between the '217 patent and its family member, the '444 patent, the district court will be required to resolve essentially the same factual issues arising in the present proceeding. This further diminishes any potential effect Petitioner's stipulation might otherwise have had regarding judicial efficiency.

Accordingly, Petitioner's *Sotera* stipulation at best mitigates only some concerns of duplication, and this factor still favors denial.

**5. Factor 5: The Parties Are The Same In Both Proceedings**

Petitioner is a defendant in the parallel litigation, as is each real party-in-interest, so "this factor weighs in favor of discretionary denial." *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 15 (May 13, 2020) (informative).

**6. Factor 6: Other Circumstances Weigh Against Institution**

Consistent with the Director's memorandum providing for interim processes for PTAB workload management, additional factors favor discretionary denial. *See* Workload Memo, 2 ("all relevant considerations" to be evaluated in determining whether to exercise discretionary denial).

To begin with, the merits of the petition are weakly based on recycled references and an obviousness analysis that is incurably deficient for not properly addressing known findings supporting nonobviousness. As confirmed in the petition, the two primary grounds references (Chishti-511 and Chishti-876) have now been considered many times by the Office—both in the context of this patent and related family members. These primary grounds references were considered not only during prosecution, but also in the IPR of the related '444 patent filed by the same petitioner (IPR2017-01829). During *ex parte* prosecution, the Examiner confirmed she considered both these references, including in the full context of the prior IPR based on these references. EX1002, 247. In that prior IPR the same petitioner as here challenged similar claims based on the same Chishti-511 and Chishti-876 references now advanced here. The Board denied institution, finding not only that Chishti-511 and Chishti-876 failed to render obvious claims reciting “round-tripping,” but also that Chishti-876 expressly taught away from including such round-tripping in treatment planning software like that taught by Chishti-876 and Chishti-511. EX1008, 11 (“We are persuaded that Patent Owner’s position is correct because Chishti ’876 uses the terms ‘while avoiding’ and ‘highly undesirable’ in connection with the use of ‘round tripping,’ so that Chishti ’876 sufficiently discourages the practice of ‘round tripping’ enough to teach away from that practice.”); EX1005, 14:46-51 (“The path scheduling algorithm determines the

treatment path while avoiding ‘round-tripping,’ i.e., while avoiding moving a tooth along a distance greater than absolutely necessary to straighten the teeth. Such motion is highly undesirable, and has potential negative effects on the patient.”).

In the present IPR, the petition materials omit this content and the Board’s previous findings from its obviousness analysis. Where the Office has credited evidence of nonobviousness supporting the claims’ patentability, such evidence must be factored into an obviousness analysis *in the petition* in order to show a reasonable likelihood to prevail. Conversely, failure to address and rebut that evidence in the petition means that the Petitioner did meet its burden at the petition stage. *Cf., e.g., Gilead Sciences, Inc. v. United States*, IPR2019-01456, Paper 17 at 52-53 (Feb. 5, 2020) (holding petitioner’s failure to persuasively address known evidence of nonobviousness “in its Petition means Petitioner falls short of its burden to establish a reasonable likelihood of success in prevailing on its challenge.”); *Santarus, Inc. v. Par Pharm., Inc.*, 694 F.3d 1344, 1364 (Fed. Cir. 2012) (describing a “classical example of ‘teaching away’”: “Proceeding contrary to the accepted scientific knowledge is ‘strong evidence of nonobviousness.’” (quoting *Ricoh Co., Ltd. v. Quanta Computer Inc.*, 550 F.3d 1325, 1332 (Fed. Cir. 2008) and *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1552 (Fed. Cir. 1983))). Here, Petitioner disregards Chishti-876’s teaching away as previously identified by the Board, curiously arguing instead that only Chishti-511

fails to teach away from round-tripping. *See* Pet., 29. This makes no sense as even the silence of one reference would not negate teaching away found elsewhere in the prior art. Regardless, the Board previously considered both Chishti-876 and Chishti-511, finding that Chishti-511’s discussion of round-tripping refers to an entirely different operation from what is recited in the claims and that Chishti-876 specifically taught away from round-tripping as claimed. EX1008, 11-12, 14-15 & n.4. Petitioner disputes none of this.

The Office’s prior expenditure of resources in response to challenges raised by ClearCorrect against Align patents, and the resulting settled expectations of the parties, further favor discretionary denial. Workload Memo, 2. For example, the Director has held that a petitioner’s awareness of a patent owner’s applications related to a challenged patent “and failure to seek early review of the patents favors denial,” holistically outweighing even multiple *Fintiv* factors that may otherwise weigh against denial. *E.g., iRhythm Techs. Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 3 (Jun. 6, 2025) (petitioner’s knowledge of one of patent owner’s applications and decision to leave it unchallenged for years after it issued strongly favored discretionary denial for the same and related patents). As discussed above in Section II, Petitioner raised multiple challenges against Align’s patent portfolio dating back a decade. These failed challenges have already resulted in the expenditure of substantial Office resources to no significant effect.

For example, between 2015 and 2017, Petitioner filed 26 reexamination requests challenging patents assigned to Align, resulting in only one canceled claim and one amended claim. *Supra* §II.

Petitioner has also raised unsuccessful IPR challenges against Align's patents in the past, including the petition against the '444 patent which is in the same family as the '217 patent. *See ClearCorrect Operating LLC v. Align Technology, Inc.*, IPR2017-01829, Paper 10 at 2 (Feb. 5, 2018) (challenging U.S. Patent No. 8,038,444, of which the patents challenged in IPR2025-00814, IPR2025-00815, and IPR2025-00816 are continuations). The Board denied institution, finding no reasonable likelihood that any claim was unpatentable. *Id.*, 17. Despite knowing of this patent family since 2017, Petitioner then sat on its hands for years. Petitioner has raised no further challenge to any family member, or any other Align patent, until 2025.

Petitioner's late-coming challenge to the '217 patent and its family members also raises the type of "roadmapping" concerns that the Board has repeatedly warned against. *See Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 17 & n.14 (Sep. 6, 2017) (precedential §II.B.4.i) (collecting cases and noting that "shifts in the prior art asserted and the related arguments in follow-on petitions" raises concerns of "efficiency and potential prejudice induced by multiple petitions in multiple cases"). Here, Petitioner received feedback from

the Board regarding the specific deficiencies in its prior art challenges to the '444 patent. Yet despite knowledge of the '444 patent's family and of the deficiencies regarding the same limitation found in the '217 patent, Petitioner sat on its hands for years and raised no challenge to the '217 patent or any family member. Only eight years later, after being sued for infringement and then waiting until the last few days before the statutory bar, does Petitioner come forward and present a challenge relying on the same prior art that failed in its challenge to the '444 patent, while using the Board's prior decision as a roadmap to attempt (unsuccessfully) to address the deficiencies of its earlier case. Petitioner's about-face years after abandoning its challenges to the '217 patent's family runs counter to the parties' settled expectations and should be rejected. *See iRhythm*, Paper 10 at 3.

In total, Petitioner has now advanced 26 reexamination requests and 10 IPR petitions against Align's patents, with essentially no success to date. *See supra* §II. These unsuccessful challenges against Align's patent portfolio stretching back a full decade not only show a waste of Office resources, but also show that Petitioner abandoned its challenges against Align's patent portfolio and maintained this abandonment for many years. Petitioner's longstanding acquiescence to the validity of Align's patents, including specifically to the members of the '217

patent's family, confirms the parties' settled expectations of validity for Align's patents, including the patent subject to the instant petition.

Thus, in view of the settled expectation of the parties, Petitioner's waste of Office resources, and the overall weakness of the petition, the factor 6 considerations weigh in favor of discretionary denial.

Accordingly, given the totality of the circumstances present in this case, discretionary denial is justified.

**B. Advanced Bionics Weighs in Favor of Discretionary Denial under §325(d)**

The Director should exercise discretion to not institute this challenge under 35 U.S.C. §325(d) because (1) the same or substantially the same art or arguments were previously presented to the Office; and (2) Petitioner fails to demonstrate that the Office erred in a material manner. *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GMBH*, IPR2019-01469, Paper 6 at 8-9 (Feb. 13, 2020) (precedential). As detailed more below, the petition relies on art and arguments explicitly considered by the Office, and Petitioner fails to show that the Office erred in a material manner in its prior evaluations. As the petition's obviousness challenges merely rehash issues already resolved by the Office, the petition should be denied under §325(d).

## 1. Advanced Bionics Step 1

The petition advances grounds based on art and arguments identical to or substantially similar to those already considered and rejected by the Office. *See Advanced Bionics*, Paper 6 at 9-10 & n.10 (listing *Becton, Dickenson* factors).

The petition asserts a single ground against the claims of the '217 patent claims, applying a combination of four references: Chishti-511, Chishti-876, Sachdeva, and Becker. *See Pet.*, 3. As Petitioner acknowledges, it previously proposed a combination of Chishti-511 and Chishti-876 in an IPR petition challenging the '444 patent (of which the '217 patent is a continuation), and the Office rejected Petitioner's argument that the claims of the '444 patent would have been obvious in view of these references, concluding that, among other things, the "round-tripping" recited in the claims would not have been obvious. *Pet.*, 6; EX1008. Petitioner does not dispute that this limitation is also found in the claims of the '217 patent, and that the Examiner expressly considered the IPR materials and decision of the '444 patent during prosecution of the '217 patent. *Pet.*, 6-7. Indeed, the Examiner allowed the claims upon specifically finding that the "round-tripping" steps would not have been obvious in view of prior art including Chishti-511 and Chishti-876. *Id.*; EX1002, 247, 303-04; *see also id.*, 200, 209-26, 333-34.

Petitioner now adds to the same prior art two additional references—Sachdeva and Becker—that it argues were not expressly evaluated during

prosecution. These references, however, add nothing new to the art and argument previously considered by the Office and are at best cumulative. For example, Petitioner here relies on Sachdeva to teach collision detection and avoidance (not “round-tripping”). *See* Pet., 12, 21. However, Petitioner itself repeatedly argued in the IPR of the ’444 patent that this function was already taught by other art previously considered by the Office—namely, Chishti-876. *See, e.g.*, EX1028, (“Chishti ’876 describes the host computer determining a treatment plan for each tooth that avoids collisions or obstructions...using a collision detection algorithm....” (citing Chishti-876 (EX1005), 13:38-45, 12:52-60, Fig. 5)). Likewise, Petitioner argued in the same proceeding that Chishti-511 teaches collision avoidance. *See, e.g.*, EX1028, 49 (“Chishti ’511 describes the host computer determining a treatment plan for each tooth that avoids collisions on their respective routes from their initial position to their final position....” (citing Chishti-511 (EX1004, 4:7-22))). Thus, by Petitioner’s own argument, the material for which Petitioner now cites Sachdeva is at best cumulative to art and argument previously considered by the Office.

Moreover, the Sachdeva reference itself is hardly new to the Office. For example, the Examiner expressly considered multiple references to Sachdeva including U.S. Patent No. 6,350,120 to Sachdeva et al., filed on the same day as Sachdeva, and which incorporates Sachdeva by reference to be used for treatment

planning operations like the ones Petitioner relies on here. *See* EX2010, 7:21-35 (“For a detailed discussion of determining whether the teeth move along the three-dimensional path refer to co-pending patent application having Ser. No. 09/451,609, entitled METHOD AND APPARATUS FOR SIMULATING TOOTH MOVEMENT FOR AN ORTHODONTIC PATIENT, now U.S. Pat. No. 6,250,918, having a filing date the same as the present patent application, and is assigned to the same assignee as the present patent application.”); EX1002, 333 (examiner confirming review of U.S. Patent No. 6,350,120 to Sachdeva et al., as well as another co-filed patent to Sachdeva et al.). Petitioner’s reliance on Sachdeva to teach these same functions is thus entirely cumulative to what was already considered by the Office.

Likewise, Petitioner’s reliance on Becker is cumulative to the art and arguments that have already been considered by the Office. While Petitioner’s challenge is based on primary references (Chishti-876 and Chishti-511) directed to orthodontic dental aligners, Petitioner relies on Becker as disclosing that “round-tripping” was a technique employed in a different orthodontic treatment modality—i.e., wire-and-bracket orthodontics. *See* Pet., 13-16. Petitioner does not point to any teaching in Becker applying round-tripping to aligner-based treatment plans like those Petitioner relies on in Chishti-876 and Chishti-511, as Becker never addresses such treatment methods. *See generally* EX1006.

Indeed, these teachings of Becker are cumulative to what was already before the Office. In the IPR of the '444 patent, of which the examiner of the '217 patent was acutely aware, Petitioner expressly asserted that “round-tripping is a well-known technique that may be necessary in an orthodontic treatment.” EX1028, 17; *see* EX1002, 200 (pointing examiner to “the contents of IPR2017-01829 of U.S. Pat. 8,038,444”), 247 (expressly noting consideration of “the prior art discussed in the Inter-Parties Review (IPR2017-01829 of U.S. Pat 803844)”). Petitioner cited to expert testimony asserting the “round-tripping” was a technique used in prior wire-and-bracket orthodontics. *See* EX1028, 17 (citing “Ex. 1003 ¶¶ 81-85”). This testimony described it as “desirable and necessary to perform round-tripping in an orthodontic treatment,” including situations where it was “necessary to move a tooth out of the way in order to reposition another tooth,” and cited to articles discussing both intentional and unintentional round-tripping. *ClearCorrect*, IPR2017-01829, Ex. 1003, ¶¶ 82-85. Moreover, the Board recognized in its institution decision that while Chishti-876 did discuss round-tripping, it taught away from including such a step in aligner orthodontics. EX1008, 11-12; EX1005, 14:46-51. Patent Owner fails to address the Board’s prior finding regarding

Chishti-876,<sup>4</sup> which was before the Examiner. While Patent Owner discusses teaching away in relation to Chishti-511's disclosure, this argument fails, as discussed below in §III.B.2. Accordingly, like Sachdeva, Petitioner's reliance on Becker is merely cumulative of what was already considered by the Office.

In sum, the petition presents grounds relying on art and arguments already considered by the Office. As a result, step 1 of *Advanced Bionics* weighs in favor of discretionary denial and the Director should exercise discretion not to institute the petition under §325(d).

## **2. Advanced Bionics Step 2**

Discretionary denial is further warranted under the second step of the *Advanced Bionics* framework because the petition has failed to sufficiently point out how the Office erred in its evaluation of the asserted prior art and the eligibility of the challenged claims. *See Advanced Bionics*, Paper 6 at 10-11. The petition does not argue that either of the Board erred during the prior failed IPR or the Examiner erred during prosecution, and while the petition states that the "Office never considered Becker" (Pet., 7), as discussed above in §III.B.1, the petition does

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<sup>4</sup> Indeed, Petitioner never challenged this finding even in its unsuccessful rehearing request. *See* IPR2017-01829, Papers 11, 13.

not address that Becker is merely cumulative of art already expressly considered by the Office, as is Sachdeva.

As also noted above in §III.B.1, in the IPR of the '444 patent, the Board previously rejected Petitioner's arguments that round-tripping would have been obvious in view of Chishti-876 and Chishti-511, and it also found that Chishti-876 teaches away from the round-tripping recited in the claims. *See* EX1008, 11, 14-17. Petitioner does not address the Board's finding regarding Chishti-876's teaching away; instead, Petitioner provides only limited argument about whether **Chishti-511** teaches away from the recited round-tripping. Petitioner's argument is reproduced below:

If it is argued that the prior art teaches away from utilizing Becker because Chishti-511 says teeth should be moved “with the least amount of round-tripping,” (Ex-1004, 4:9-11), this argument fails because the prior art discloses at least as much as the '217 patent. Chishti-511 teaches that “[r]ound tripping is sometimes necessary to allow teeth to move past each other” *Id.*, 4:13-15. This is fundamentally the same as the teaching of the '217 patent, which refers to using round-tripping as a “last resort.” Ex-1001, 13:7-21; *see also* Ex-1003, ¶84.

Pet., 29. Not only does this fail to address Chishti-876's teaching away previously identified by the Board, it also relies on the same sleight-of-hand for which the Board denied institution in the IPR of the '444 patent. As the Board correctly held in the prior IPR, Chishti-511's use of the term “round-tripping” refers to an

**entirely different operation** from what the term means in the '444 patent (and its continuation, the '217 patent). EX1008, 14-15. Indeed, Petitioner's entire justification to return to the Board for another bite at the apple is premised on the Board's finding that Chishti-511 is directed to a different type of "round-tripping" operation. *See* Pet., 6-7. Thus, regardless of what Chishti-511 may or may not teach regarding its "round-tripping," this does not speak to the round-tripping disclosed and claimed by the '217 patent. The Office cannot have erred by failing to apply an inapposite teaching.

Nor can it justify ignoring the Board's prior finding that Chishti-876 teaches away from the use in aligner treatment of round-tripping of the type recited in the instant claims. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007) ("[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious." (citing *United States v. Adams*, 383 U.S. 39, 51-52 (1966))). As the Board found in the '444 patent's IPR, Chishti-876 discourages round-tripping, stating that "moving a tooth along a distance greater than absolutely necessary to straighten the teeth ... is highly undesirable, and has potential negative effects on the patient." EX1005, 14:46-51; *see* EX1008, 11-12. Petitioner never disputed this aspect of the Board's findings following its failed challenge. The petition provides no discussion of this disclosure or of the Board's holding that a POSITA would

have avoided incorporating round tripping in treatment planning software based on Chishti-876's teachings. Having so acquiesced in the Board's holding, Petitioner cannot now sustain an argument that the Office materially erred.

In sum, Petitioner advances its grounds of unpatentability using the substantially the same art and argument already considered and rejected by the Office, and it fails to rebut the Office's findings that the prior art failed to render the round-tripping recited in the claims obvious and in fact taught away from such round-tripping. Accordingly, *Advanced Bionics* weighs in favor of discretionary denial and the Director should exercise discretion not to institute the petition under §325(d).

#### **IV. CONCLUSION**

For at least the reasons above, Patent Owner respectfully requests that the Director exercise discretion to deny institution of the petition.

Respectfully submitted,

Date: July 8, 2025

/ Michael T. Rosato /  
Michael T. Rosato, Lead Counsel  
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**CERTIFICATE OF COMPLIANCE**

Pursuant to §42.24(d) and the Director's Memorandum on Interim Processes for PTAB Workload Management, the undersigned certifies that this paper contains no more than 14,000 words, not including the portions of the paper exempted by §42.24(b). According to the word-processing system used to prepare this paper, the paper contains 6644 words.

Respectfully submitted,

Date: July 8, 2025

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V. APPENDIX

Exhibit No.	Description
2001	Claim Construction Order, <i>Align Technology Inc. v. ClearCorrect Operating LLC</i> , et al., No. 24-cv-00187-ADA-DTG (W.D. Tex. Jun. 5, 2025)
2002	Scheduling Order, <i>Align Technology Inc. v. ClearCorrect Operating LLC</i> , et al., No. 24-cv-00187-ADA-DTG (W.D. Tex. Aug. 5, 2024)
2003	Fourth Scheduling Order, <i>Align Technology Inc. v. ClearCorrect Operating LLC</i> , et al., No. 24-cv-00187-ADA-DTG (W.D. Tex. Jun. 12, 2025)
2004	DocketNavigator Median Time-to-Trial Statistics for Judge Alan D. Albright and for W.D. Tex. Overall, July 1, 2020 – July 1, 2025
2005	Judge Albright Patent FAQ, <a href="https://www.txwd.uscourts.gov/for-attorneys/judge-albright-courtroom-faq/">https://www.txwd.uscourts.gov/for-attorneys/judge-albright-courtroom-faq/</a> (accessed July 3, 2025)
2006	Joint Request to Amend the Claim Schedule, <i>Align Technology Inc. v. ClearCorrect Operating LLC</i> , et al., No. 24-cv-00187-ADA-DTG (W.D. Tex. Jun. 6, 2025) (ECF No. 187)
2007	Preliminary Claim Constructions, <i>Align Technology Inc. v. ClearCorrect Operating LLC</i> , et al., No. 24-cv-00187-ADA-DTG (W.D. Tex. Jan. 21, 2025)
2008	Complaint for Damages and Injunctive Relief, <i>Align Technology, Inc. v. ClearCorrect Operating, LLC</i> , Case No. 6:24-cv-00187 (W.D. Tex. Apr. 11, 2024) (ECF No. 1)
2009	ClearCorrect’s Preliminary Invalidity Contentions, <i>Align Technology, Inc. v. ClearCorrect Operating LLC</i> , Case No. 6:24-CV-00187 (W.D. Tex. Sept. 26, 2024)
2010	U.S. Patent No. 6,350,120 to Sachdeva et al.

## **CERTIFICATE OF SERVICE**

The undersigned certifies that the foregoing Patent Owner's Brief In Support of Discretionary Denial and accompanying Exhibits 2001-2010 were served on July 8, 2025, on the Petitioner at the electronic correspondence address of the Petitioner as follows:

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