

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

CLEARCORRECT OPERATING, LLC,
Petitioner,

v.

ALIGN TECHNOLOGY, INC.,
Patent Owner.

IPR2025-00814 (Patent 10,456,217 B2)
IPR2025-00815 (Patent 10,524,879 B2)
IPR2025-00816 (Patent 11,369,456 B2)
IPR2025-00817 (Patent 10,791,936 B2)
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)

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

DECISION
Referring the Petitions to the Board

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Align Technology, Inc. (“Patent Owner”) filed a request for discretionary denial (Paper 7, “DD Req.”) in the above-captioned cases, and ClearCorrect Operating LLC (“Petitioner”) filed an opposition (Paper 10, “DD Opp.”).¹ With authorization, Patent Owner filed a reply to Petitioner’s opposition. Paper 12.

After considering the parties’ arguments and the record, and in view of all relevant considerations, discretionary denial of institution is not appropriate in these proceedings. This determination is based on the totality of the evidence and arguments the parties have presented.

Although the parties are engaged in a parallel proceeding involving some of the challenged patents,² it is unclear whether a final written decision in this proceeding will issue after the district court trial occurs. In particular, the projected final written decision due date in the Board proceedings is November 8, 2026. DD Req. 11. The district court’s scheduled trial date is May 11, 2026, but the time-to-trial statistics suggest that the trial will not begin until November 2027. DD Opp. 22. As such, these considerations neither favor nor counsel against discretionary denial.

¹ Except as otherwise noted, citations are to papers in IPR2025-00818. The parties filed similar papers in IPR2025-00814, IPR2025-00815, IPR2025-00816, IPR2025-00817, IPR2025-00819, IPR2025-00820, and IPR2025-00821.

² The patents at issue in IPR2025-00814, IPR2025-00815, and IPR2025-00816 have been dismissed from the parallel proceeding.

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Some considerations, however, counsel against discretionary denial. In particular, for each of the challenged patents, there is evidence in the record indicating that the Office erred in a manner material to patentability such that discretionary denial under 35 U.S.C. § 325(d) is not appropriate. For example, in IPR2025-00817, Petitioner persuasively demonstrates that the Office erred by allowing the claims after the Board determined that substantially similar claims are unpatentable. IPR2025-00817, Paper 8, 16–17. In particular, the patent examiner determined that the claims were allowable because the closest prior art did not provide for updating a scan of a patient’s teeth after modifications to the intra-oral cavity were made (e.g., tooth movement). *Id.* at 9; IPR2025-00817, Ex. 1002, 374–75. However, the Board had previously conducted an *inter partes* review involving an ancestral patent and issued a final written decision finding a substantially similar scan-after-modification claim unpatentable. IPR2025-00817, Ex. 1026, 32. The patent examiner appears to have been aware of the *inter partes* review prior to allowing the challenged claims because it was cited on an information disclosure statement. *See* IPR2025-00817, Ex. 1002, 368 (IDS providing the final written decision in IPR2019-00134), 376 (patent examiner acknowledging the IDS). The patent examiner, however, did not discuss why the challenged claims were patentably distinct from those the Board found unpatentable, despite the strong similarity between the claims.

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As another example, in IPR2025-00818 and IPR2025-00819, Petitioner also persuasively demonstrates that the Office erred. In the patents at issue in these proceedings, the patent examiner allowed broad limitations directed to various polymer layers, finding that the prior art did not teach them. Ex. 1011, 846–847. Subsequently, substantially similar limitations in child applications were rejected over prior art. *See, e.g.*, Ex. 1017, 192–195, 277.

The proceedings discussed above are exemplary and the proceedings not discussed above present different considerations. As noted above, however, there is evidence in the record indicating that the Office erred in a manner material to patentability for the remaining proceedings, such that discretionary denial under 35 U.S.C. § 325(d) is not appropriate.

Although certain arguments are highlighted above, the determination not to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petitions are referred to the Board to handle the cases in the normal course, including by issuing a decision on institution addressing the merits and other non-discretionary considerations, as appropriate.

In consideration of the foregoing, it is:

ORDERED that Patent Owner’s request for discretionary denial is *denied*;

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FURTHER ORDERED that the Petitions are referred to the Board;
and

FURTHER ORDERED that neither party shall file a request for rehearing or Director Review of this decision until the Board issues a decision on institution.

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