

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 REPLY TO PETITIONER'S OPPOSITION TO THE  
REQUEST FOR DISCRETIONARY DENIAL**

On July 8, 2025, Patent Owner Align filed its Discretionary Denial request. Paper 8 (“DD Brief”). August 8, 2025, Petitioner filed its opposition. Paper 9 (“Opp”). The Director authorized this reply. EX3101. While Align disagrees with the entirety of the Opp, this reply addresses certain flaws as authorized.

First, despite the Opp’s 22+ page rehash of the alleged merits of the petition it still dodges critical 325(d) issues—(1) the same recycled (and previously failed) Chishti-511 and Chisti-876 combination forms the backbone of this IPR challenge; and (2) Petitioner still fails to meaningfully address the undisputed fact Chishti-876 *teaches away* from the claimed “round tripping.” Remarkably, the petition proposes employing the movement patterns of Chisti-876 specifically (Pet. 30), whereas the same reference disparages the very tooth movement patterns now claimed. The Opp avoids this fact assiduously—just like the petition did. *See, e.g.*, Opp 33-34 (ignoring Chishti-876 to argue “[n]othing in Chishti-511 or Becker teaches away...”). There is no dispute the Board in the ’444 patent IPR correctly found Chishti-876 teaches away from the claimed “round tripping.” DD Brief, 19-21, 28-32; IPR2017-01829, Paper 10 at 11-12. Referring to Chishti-511 generically as “the Chishti prior art,” the Opp makes the misplaced argument Chishti-511 (not Chishti-876) refers to “round-tripping” more generally. But the Opp confirms that the definition of “round tripping” is the same in the ’444 patent and the current

'217 patent. *Compare* Opp, 6-7, with Pet. 9. This “round-tripping” as claimed is where the Board found prior art teaching away.

The Opp essentially reduces to the non-dispositive point that the Becker reference, specifically, was not before the Examiner. *See* Opp 2, 4, 5-11, 17, 20, 26, 31, 33-34. But there is no dispute evidence was before the Office that “round-tripping” was known in prior wire-and-bracket orthodontics. DD Brief, 28. Of course it was known—Chishti-876 teaches against it for aligner-based movements. As to Sachdeva, there is no dispute this reference is cumulative at least because the petition itself presents it as such. *See, e.g.*, Pet. 39 (“Chishti-511 discloses this limitation and renders it obvious both alone and in view of Sachdeva”), 41 (same). But neither Becker nor Sachdeva adds anything not previously considered by the Office, and Petitioner does not, as it cannot, demonstrate material error when it fails to grapple with known prior art teaching away.

Second, 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. Opp. 2, 23-25. Not so. Petitioner’s invalidity challenges at district court guarantee that the district court will address the same art and issues raised in this IPR. On Aug. 4, 2025, Petitioner submitted its “Prior Art Narrowing Disclosure” at District Court. EX2011. That document was not included with Petitioner’s Opp but is submitted here as authorized by the Director.

EX3101. This document cites, *inter alia*, the same prior art relied upon in this IPR petition. EX2011, 4 (Chishti-511 and Chishti-876), 5 (Sachdeva and Becker). In addition, Petitioner's declaratory judgment action challenging these same patents—including the '217 patent—remains pending in the district court case. *See* EX2012, 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, which continued to assert the '217, '879, and '456 patents are invalid.

Moreover, as discussed in Align's brief, Petitioner's offer of a *Sotera* stipulation does little to mitigate the waste of judicial resources here. DD Brief 15-18. Indeed, Petitioner challenges the '444 patent validity at district court citing the same references asserted here. The '444 patent includes claims paralleling the '217, '879, and '456 patents, and Petitioner's invalidity challenge to the '444 patent remains asserted, as does Align's infringement claim, so the same questions of invalidity remain pending before the district court. *See* DD Brief, 7; EX2011, 2. Petitioner has not offered any stipulation covering the '444 patent, guaranteeing the district court will address the same invalidity issues raised here long before the Board would reach them at FWD. The Opp offers no rebuttal in this regard.

Accordingly, Align respectfully requests that the Director exercise discretion to deny institution of the petition.

Respectfully submitted,

Date: August 20, 2025

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

I certify that the foregoing Patent Owner’s Reply to Petitioner’s Opposition to the Request for Discretionary Denial (and accompanying Exhibits 2011-2012) was served on this 20th day of August, 2025, on Petitioner at the following electronic service addresses:

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Respectfully submitted,

Date: August 20, 2025

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