

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

Brook + Whittle LTD,

Plaintiff,

v.

Nestlé USA, Inc., Fuji Seal International, Inc.,

Defendants.

CASE NO. 2:24-CV-00735-JRG-RSP

BROOK + WHITTLE LTD'S OPENING CLAIM CONSTRUCTION BRIEF

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Exhibit 4	Declaration of Dr. Erin Askounis, Ph.D.
Exhibit 5	Declaration of Dr. Robson F. Storey, Ph.D.
Exhibit 6	September 16, 2025 Deposition of Dr. Robson F. Storey Demonstrative Ex. 3.
Exhibit 7	Handbook of Plastics, Elastomers, and Composites by Charles A. Harper

I. INTRODUCTION

Plaintiff Brook + Whittle LTD (“B+W”) submits this Opening Claim Construction Brief in support of its proposed constructions of the five disputed claim terms in U.S. Patent No. 11,961,422 (the “’422 Patent”). *See* Ex. 1 (’422 Patent). B+W interprets the disputed terms in accordance with their plain and ordinary meanings as understood by a person of ordinary skill in the art (“POSITA”), and only proposes constructions where the patentee, “acting as his or her own lexicographer, has clearly set forth an explicit definition of the term different from its ordinary meaning.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1319 (Fed. Cir. 2005). By contrast, Nestlé USA, Inc. (“Nestlé”) and Fuji Seal International, Inc. (“Fuji”) (collectively, “Defendants”) violate black letter law with each claim term. The impropriety of Defendants’ constructions is all the more glaring given Defendants’ conflicting proposals in this litigation and in Fuji’s petition for *inter partes* review (“IPR”) of the ’422 Patent: despite relying on the same expert, Defendants propose completely different terms for construction in both proceedings.

The only term needing construction is “recyclable.” B+W’s construction comes directly from the patentee’s express definition provided during prosecution: “capable of being recycled . . . [without] removing the label [from a container] before or during the recycling process.” *See* Ex. 2 (’422 File History) at October 16, 2023 Applicant Amendment and Response. By contrast, Defendants’ construction—“capable of being processed and recovered in a PET recycling stream”—introduces concepts made of whole cloth that exclude disclosed embodiments.

The remaining terms at issue should be construed according to their plain and ordinary meanings. **First**, Defendants inexplicably propose a construction for the phrase “wherein the recyclable shrink label is recyclable with a PET container,” improperly reading in limitations from particular embodiment(s) of the specification (or made from whole cloth).

Second, Defendants propose a construction for the term “polyethylene terephthalate

(PET)” despite acknowledging the term is, on its face, clear and readily understandable to a POSITA. Defendants’ construction— “[a] polymer prepared from terephthalic acid (or dimethyl terephthalate) and ethylene glycol, and not any other monomers”—again improperly excludes express embodiments (*i.e.*, PET made from other monomers), and improperly converts the apparatus claims of the ’422 Patent into method claims for manufacturing PET.

Third, Defendants’ proposed construction for “crystallizable [PET]” should be rejected for violating the doctrine of claim differentiation. As Defendants’ expert Dr. Storey acknowledged, “Claim 1 and Claim 18 are the same” under Defendants’ proposal.

Last, Defendants argue “comprising [PET]” is either indefinite or should be construed as “the majority of which is polyethylene terephthalate (PET) (as construed).” Both should be rejected. First, the record demonstrates a POSITA would have had no difficulty understanding the scope of the invention. Second, Defendants provide no support for their alternative construction other than Dr. Storey’s supposed “logical reasoning.”

For these reasons, B+W respectfully requests that this Court reject Defendants’ attempts to impermissibly narrow the ’422 Patent and instead adopt the plain and ordinary meanings proposed by B+W and construe “recyclable” as expressly defined during prosecution.

II. OVERVIEW OF THE PATENT

The ’422 Patent issued on April 16, 2024, from Application No. 18/103,234 filed on January 30, 2023, and is entitled to a priority date of at least May 14, 2021. As its title indicates, the ’422 Patent focuses on a novel “Recyclable Heat Shrink Film for Recyclable Container.”

The ’422 Patent recognizes that at the time of the invention, “there remains a need for recyclable, light protective packaging options for many markets, including the food and nutraceutical markets.” Ex. 1 (’422 Patent), 1:26–28. It explains that “[t]he consumer packaged-goods markets globally aspire to utilize recyclable packaging for most products,” (*id.*, 1:14–15),

and at the same time, “[t]he dairy, food, nutraceutical, and other markets also require light protective packaging to block ingredient harmful light waves from impacting the shelf life and performance of those products.” *Id.*, 1:16–20. While “[c]lear PET packaging provides a cost effective recyclable option,” “color impregnated bottles or containers” are not readily recyclable. *Id.*, 1:15–16, 1:20–21. Therefore, the ’422 Patent teaches “[a] recyclable shrink label” with “a light blocking layer” “to block at least 80% of incident light having wavelengths in a range of 200 nm and 900 nm” in which the label is recyclable with a container. *See* Ex. 1 (’422 Patent), Abstract.

The ’422 Patent discloses exemplary embodiments of a recyclable, light blocking, heat shrink label that can be embellished with various layers. For example, it proposes a high opacity layer to block light from interacting with the contents of the container (*id.*, 1:36–3:3, 5:4–43, 13:48–63, Figs. 1A–2) and an indicia layer to convey a message (*e.g.*, the characteristics or quantity of a product). *Id.*, 1:46–47, 15:54–59, 16:49–53. The ’422 Patent explains that the claimed labels are applied to an article such as a bottle or other container, as illustrated in Figures 1A–1E of the ’422 Patent. The layers of the heat shrink label may be employed in various configurations depending on the desired characteristics. *Id.*, 17:24–42, Fig. 1A–1E.

The ’422 Patent also describes various materials that may form the layers comprising a heat shrink, light blocking label:

The layer or layers of the shrink film may be formed from a polymer chosen from numerous types of polymers, including for example polyesters and polyolefins. Illustrative specific polymers or polymer types that can be utilized to form shrink films can include, for example, polyethylene terephthalate (PET), polyethylene terephthalate glycol-modified (PETG or PET-G) polyvinyl chloride (PVC), polystyrene or oriented polystyrene (OPS), polylactic acid (PLA), copolymers, nonpetroleum based biopolymers, and copolymers and blends thereof.

Ex. 1 (’422 Patent), 8:64–9:19; *see also id.*, 1:52–65.

As one example, the ’422 Patent describes Embodiment 6, which “is the recyclable shrink label according to any of [the preceding embodiments of the invention], wherein the heat shrink

film comprises polyethylene terephthalate (PET), polyethylene terephthalate glycol-modified (PETG or PET-G), polyvinyl chloride (PVC), polystyrene or oriented polystyrene (OPS), polylactic acid (PLA), polypropylene (PP), polyethylene (PE), or a combination thereof.” *Id.*, 20:52–58. By contrast, the Patent provides a specific example where “[t]he heat shrink film may consist of polyethylene terephthalate (PET)” and no other components. *Id.*, 21:1–2.

The ’422 Patent also states that “there remains a need for **recyclable**, light protective packaging options” (*id.*, 1:26–28), and therefore the claimed labels are “recyclable with the container or bottle.” *See id.*, 11:29–53. In some embodiments, for example, “[t]he article or container may be made of the same or similar polymer as the label e.g., PET.” *Id.*, 18:25–30. The ’422 Patent also discusses recycling taking place across different recycling streams:

In some cases, the article and label include or are made of PET and can be recognized as PET and be directed into a PET recycling stream. ***In other cases, the article and label may include or be made of another resin and be directed to a corresponding recycling stream.***

Ex. 1 (’422 Patent), 20:1–11; *see also id.*, 1:52–65 (providing examples of other plastic polymers and resins), 8:66–9:18 (same), Abstract.

III. LEGAL STANDARDS

Claim construction is a question of law that relies primarily on intrinsic evidence, including the claim language, the specification, and the prosecution history, to determine the scope of disputed claims. *See Phillips*, 415 F.3d at 1321. Claim construction is not an invitation to rewrite the claims. Claim terms should be construed consistent with their “ordinary and customary meaning,” which is “the meaning that the term[s] would have [had] to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Id.* at 1312–13. Only in rare instances is a departure from this rule warranted: (1) where a patentee clearly redefines a term or (2) expressly disavows scope. *Thorner v. Sony*

Comput. Ent. Am. LLC, 669 F.3d 1362, 1365 (Fed. Cir. 2012); *see also Straight Path IP Grp., Inc. v. Sipnet EU S.R.O.*, 806 F.3d 1356, 1361 (Fed. Cir. 2015). Further, “it is improper to read limitations from a preferred embodiment described in the specification [...] into the claims absent a clear indication in the intrinsic record that the patentee intended the claims to be so limited.” *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 913 (Fed. Cir. 2004).

35 U.S.C. § 112 requires a patent’s claims to “inform those skilled in the art about the scope of the invention with reasonable certainty.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 910 (2014). “Indefiniteness does not require absolute certainty, but only reasonable certainty around the boundaries of the term.” *Nanoco Techs. Ltd. v. Samsung Elecs. Co.*, No. 2:20-cv-00038, 2021 WL 1890453, at *8 (E.D. Tex. May 10, 2021).

IV. DISPUTED TERMS

A. “Recyclable”

Claim Term (Where Term Appears)	Plaintiff B+W’s Proposed Construction	Defendants’ Proposed Construction
“recyclable” (Claims 1–14, 16–19)	“capable of being recycled without removing the label from a container before or during the recycling process”	“capable of being processed and recovered in a PET recycling stream”

Both parties agree the term “recyclable” is amenable to a construction. B+W’s construction comes directly from the patentee’s explicit definition of “recyclable” provided during prosecution, as acknowledged by the Patent Office. By contrast, Defendants’ construction impermissibly imports limitations into the term based on specific embodiments or, worse, made out of whole cloth. *See Blazer v. Best Bee Bros. LLC*, No. 2022-1033, 2022 WL 16954848 at *4 (Fed. Cir. 2022). In so doing, Defendants’ construction also improperly excludes recited embodiments. *See*

GE Lighting Sols., LLC v. AgiLight, Inc., 750 F.3d 1304, 1311 (Fed. Cir. 2014). For these reasons, B+W’s proposed construction should be adopted.

1. B+W’s Proposed Construction Is Supported by the Intrinsic and Extrinsic Record and Comes Directly from the Patentee’s Express Definition Provided During Prosecution

Construction is appropriate where, as here, the patentee acting as its own lexicographer “has clearly set forth an explicit definition of the term different from its ordinary meaning.” *See Phillips*, 415 F.3d at 1319. B+W’s construction is supported by the claims, specification, and Defendants’ expert’s testimony. For example, Claim 1 recites a shrink label that “is recyclable with a PET container,” illustrating one of the inventive aspects of the ’422 Patent. Ex. 1 (’422 Patent), Cl. 1. The specification then explains a measure by which the shrink label may be deemed to be “recyclable with a PET container”:

According to an embodiment, the labels of the present disclosure can meet certain industry standards, including for example the Association for Plastic Recyclers (APR) Critical Guidance Protocol for Clear PET Articles with Labels and Closures (PET-CG-02), ***which can be considered as certifying that the film is fully recyclable with the container or bottle.***

Id., 11:29–45; *see also id.*, 11:49–53.

The prosecution history further clarifies that, in order for the claimed film to be compliant with “certain industry standards” with regard to its recyclability, the patentee expressly defined “recyclable” to be: “capable of being recycled . . . [without] removing the label [from a container] before or during the recycling process.” Ex. 2 (’422 File History) at October 16, 2023 Applicant Amendment and Response. As the patentee explained, there are several methods by which a container may be recycled when it includes a label: (1) removal of the label before or during the recycling process and (2) making the label itself recyclable with the container. *Id.* In making its amendments to overcome the Examiner’s rejections, the patentee explained that “the term ‘recyclable’ does further limit the claim in that the claimed label must be ***capable of being***

recycled” and “*removing the label before or during the recycling process is not evidence of the recyclability of the label.*” *Id.* It is this precise language that B+W proposes for its construction: “capable of being recycled without removing the label from a container before or during the recycling process.” *Phillips*, 415 F.3d at 1317; *Team Worldwide Corp. v. Acad., Ltd.*, No. 2:19-CV-00092, 2020 WL 7041828, *4–7 (E.D. Tex. Dec. 1, 2020) (adopting construction of term “as expressly defined by the applicant during prosecution”).

Testimony of Defendants’ expert, Dr. Storey, further supports B+W’s construction. Dr. Storey agreed at his deposition “that the applicant of the ’422 patent disclaimed any label that is meant to merely separate from PET [...],” further emphasizing the critical distinction the patentee made during prosecution—and that B+W’s construction highlights—between labels that are recyclable with the container and those that are removed from the container. Ex. 3 (Storey Dep. Tr.) at 191:11–18. Dr. Storey also opined that whether a label is “recyclable” with a PET container is not an abstract concept but rather is informed by established industry practices and guidelines such as by the Association of Plastic Recyclers in North America. *Id.* at 74:15–76:23.

Indeed, Defendants’ construction of the term “wherein the recyclable shrink label is recyclable with a PET container” discussed below in Section IV.B also supports B+W’s construction as it highlights the distinction between removing the label and recyclability without removing the label: “wherein the claimed heat shrink label is capable of being processed and recovered in its entirety, together with a PET container in the same PET recycling stream, *without being separated from the PET container.*” This clarification, however, should be provided in the construction of the term “recyclability.”

Given the ’422 Patent’s claims and specification, the patentee’s explicit definition provided during prosecution, and Dr. Storey’s testimony, the Court need look no further than the explicit

lexicographic meaning given to “recyclable” in the prosecution history: “capable of being recycled without removing the label from a container before or during the recycling process.”

2. Defendants’ Proposed Construction Is Contrary to the Intrinsic and Extrinsic Record

By contrast, Defendants’ construction runs contrary to Federal Circuit law by reading limitations into the term “recyclable” that are either made whole cloth or from non-limiting embodiments and would “incorrect[ly] construe the claims to exclude [] embodiment[s].” *See GE Lighting Sols.*, 750 F.3d at 1311; *Oatey Co. v. IPS Corp.*, 514 F.3d 1271, 1277 (Fed. Cir. 2008); *Estech Sys. IP, LLC v. Mitel Networks, Inc.*, No. 2:21-cv-00473, 2023 WL 2695093, at *6 (E.D. Tex. Mar. 28, 2023). Thus, Defendants’ construction is incorrect.

Defendants’ construction—“capable of being processed and recovered in a PET recycling stream”—improperly imports limitations into the term “recyclable” without any support. **First**, Defendants’ proposed phrase “capable of being processed and recovered” appears to be made of whole cloth, as this language does not appear anywhere in the ’422 Patent or its prosecution history. Indeed, the words “processed” and “recovered” only appear twice in the ’422 Patent and, even then, only when describing specific embodiments wherein inks and coatings layers have separated from “pure PET” or “pure resin.” *See* Ex. 1 (’422 Patent), 2:60–61 (“**According to an embodiment**, during the recycling process, the inks and coating layers cleanly separate from the PET heat shrink film, allowing pure PET to be **recovered and processed** into reusable resin.”), 20:16–20 (similar). But there is no indication that Claim 1 (or any claim) should be limited to these specific embodiments involving “pure” PET or resin. *Thorner*, 669 F.3d at 1365. Accordingly, there is no support for Defendants’ attempt to rewrite the claim term and introduce the concepts “processed and recovered,” let alone any express definition or clear disclaimer to this effect.

Second, Defendants also seek to introduce the phrase “in a PET recycling stream” into the

term “recyclable.” This is improper because doing so excludes other embodiments in the specification—and there is no indication that the patentee sought “recyclable” to mean recyclable only “in a PET stream.” In fact, doing so conflicts with clear teachings of the ’422 Patent, which describes a shrink label that includes PET *with other materials*. Specifically, the ’422 Patent expressly teaches embodiments where the recycling of plastic bottles and labels are not limited to PET recycling streams because they may be made from different types of materials:

According to an embodiment, a method of recycling the article includes determining the type of material (e.g., type of plastic) that the container and recyclable shrink label are made of, directing the article *into a corresponding recycling stream*, and washing the article to remove inks and pigments from the recyclable shrink label. In some cases, the article and label include or are made of PET and can be recognized as PET and be directed into a PET recycling stream. *In other cases, the article and label may include or be made of another resin and be directed to a corresponding recycling stream.*

Ex. 1 (’422 Patent), 20:1–11; *see also id.*, 1:52–65 (providing examples of other plastic polymers and resins), 8:66–9:18 (same), Abstract.

The claim language of the ’422 Patent is consistent with this disclosure showing labels are not limited to PET recycling streams. Specifically, Claim 1 recites “a heat shrink film *comprising* polyethylene terephthalate (PET) [...] wherein the recyclable shrink label is recyclable with a PET container.” *Id.* (’422 Patent), Cl. 1. “Comprising” is a defined term in the ’422 Patent meaning “the inclusion of a stated step or element or group of steps or elements *but not the exclusion of any other step or element or group of steps or elements.*” *Id.* (’422 Patent), 3:15–20; *cf. id.*, Cl. 5 (using “consists of” to illustrate a different scenario where the film excludes everything but one type of plastic). Accordingly, both the claims and specification of the ’422 Patent cover situations where labels and bottles comprise PET and other plastics, and may be recycled in streams beyond a mere “PET recycling stream.” Defendants’ construction would incorrectly exclude those other embodiments. *See Lava Trading, Inc. v. Sonic Trading Mgmt., LLC*, 445 F.3d 1348, 1353–55

(Fed.Cir.2006); *Oatey Co.*, 514 F.3d at 1277; *Advanced Mktg. Sys., LLC v. CVS Pharmacy, Inc.*, No. 6:15-CV-134, 2016 WL 1741396, *17 (E.D. Tex. May 3, 2016).

Further, Dr. Storey confirmed that there are recycling streams other than PET recycling streams. For example, when discussing a prior-art reference (U.S. Patent No. 11,358,363 (“Schurr”)) that he cited in an IPR declaration (challenging the validity of the ’422 Patent), Dr. Storey acknowledged “co-mingled streams,” *i.e.*, streams with different types of materials. Ex. 3 (Storey Dep. Tr.) at 192:18–193:3. This further defeats Defendants’ narrow construction.

Third, in addition to the clear definition patentee provided during prosecution, the fact that patentee used the term “PET recycling stream” in the specification (*see, e.g.*, Ex. 1 (’422 Patent), 2:51–53, 18:36, 20:8), and not in the claims (*see id.*, Cls. 1–19) demonstrates a deliberate choice not to limit the claims in this way. Further, as discussed above, the use of the term “PET recycling streams” in some embodiments and not others, demonstrates the claim should not be limited to “PET recycling streams.” *See id.*, 20:1–11 (“In some cases, the article and label include or are made of PET [...] and be directed into a PET recycling stream. ***In other cases, the article and label may include or be made of another resin and be directed to a corresponding recycling stream.***”). Therefore, the term “recyclable” should not be limited to “PET recycling streams.”

Accordingly, as B+W’s construction comes directly from the patentee’s express definition and is supported by the record, and Defendants’ construction contradicts the plain language and disclosure in the specification, “recyclable” should be given B+W’s proposed construction.

B. “Wherein the recyclable shrink label is recyclable with a PET container”

Claim Term (Where Term Appears)	Plaintiff B+W’s Proposed Construction	Defendants’ Proposed Construction

“wherein the recyclable shrink label is recyclable with a PET container” (Claims 1, 19)	Plain and ordinary meaning (aside from the term “recyclable”)	“wherein the claimed heat shrink label is capable of being processed and recovered in its entirety, together with a PET container in the same PET recycling stream, without being separated from the PET container”
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Defendants propose an improper construction for “wherein the recyclable shrink label is recyclable with a PET container” that is not helpful to a POSITA in understanding the term for two primary reasons: their construction (1) runs afoul of the bedrock principle that a term’s plain and ordinary meaning should govern where a patentee does not redefine the term or clearly disavow claim scope (*Thorner*, 669 F.3d at 1365), and (2) is improperly restrictive. For these reasons, this term should be given its plain and ordinary meaning (aside from “recyclable”).

First, other than for the term “recyclable,” there is no justification for deviating from the term’s plain and ordinary meaning. Defendants cannot point to any lexicographic definition or clear disavowal of claim scope regarding this term. *See Thorner*, 669 F.3d at 1365.

Second, as with Defendants’ definition of “recyclable,” Defendants’ construction runs afoul of Federal Circuit law by improperly reading limitations from the specification (or made from whole cloth) into the term. *See Liebel-Flarsheim*, 358 F.3d at 913. For example, Defendants again introduce the language “capable of being processed and recovered” into their definition, language that does not appear anywhere in the ’422 Patent or its prosecution history. *See* § IV.A.2. In fact, Defendants go further here by stating the “shrink label is capable of being processed and recovered *in its entirety*”—language that is not supported by any intrinsic or extrinsic evidence, and improperly excludes embodiments around degrees of recovery. But, again, although the ’422 Patent discusses specific embodiments wherein inks and coatings layers have separated from “pure

PET” or “pure resin,” which would indicate processing and recovering *in its entirety*, (Ex. 1 (’422 Patent), 2:58–61, 20:16–20), there is no indication that Claim 1 (or any claim) should be limited to these embodiments involving “pure” PET or resin and recovery “in its entirety.” *See Thorner*, 669 F.3d at 1365. Accordingly, there is no support for Defendants’ attempt to rewrite the claim term, let alone any express lexicographic definition or clear disclaimer to this effect.

Similarly, Defendants also seek to introduce the phrase “in a PET recycling stream,” which is improper for the same reasons discussed above. *See* § IV.A.2. Defendants again go further here by requiring the “PET recycling stream” be “the same PET recycling stream” as for the “PET container.” But this language improperly introduces limitations without any clear disclaimer around recycling streams. *See Thorner*, 669 F.3d at 1365.

Therefore, Defendants’ construction should be rejected and, other than the term “recyclable,” this term should be given its plain and ordinary meaning.

C. “Polyethylene Terephthalate (PET)”

Claim Term (Where Term Appears)	Plaintiff B+W’s Proposed Construction	Defendants’ Proposed Construction
“polyethylene terephthalate (PET)” (Claims 1, 5, 14, 18, 19)	Plain and ordinary meaning	“A polymer prepared from terephthalic acid (or dimethyl terephthalate) and ethylene glycol, and not any other monomers”

1. No Departure from the Plain and Ordinary Meaning Is Necessary

At the time of the ’422 Patent, polyethylene terephthalate (or “PET”) was (and continues to be) a well-known term to a POSITA and does not warrant departure from its plain and ordinary meaning. The claims indicate that PET is a material from which a heat shrink film may be made, which would have been understandable to a POSITA. For instance, Claim 1 recites a shrink label

“comprising polyethylene terephthalate (PET).” Ex. 1 (’422 Patent) Cl. 1. Similarly, the specification provides numerous examples of how PET is used with recyclable, light blocking labels, demonstrating its readily understandable ordinary meaning. For example, the ’422 Patent indicates that PET is used in “recyclable packaging” (*id.*, 1:14–16), and discusses “determining that the container and recyclable shrink label comprise polyethylene terephthalate (PET)” and “directing the article into a polyethylene terephthalate (PET) recycling stream.” Ex. 1 (’422 Patent) 2:50–54. Notably, the ’422 Patent includes PET among a variety of polymers and plastic materials, including “polyethylene terephthalate (PET), polyethylene terephthalate glycol-modified (PETG or PET-G), polyvinyl chloride (PVC), polystyrene or oriented polystyrene (OPS), polylactic acid (PLA), polypropylene (PP), [and] polyethylene (PE).” *Id.*, 1:52–58, *see also id.*, 9:3–10, 20:52–58. Nowhere does the ’422 Patent recite or indicate a special definition of PET, because a POSITA would have been familiar with it.

Both parties’ experts agree that PET would have been readily understandable to a POSITA. As B+W’s expert Dr. Erin Askounis opined, PET “is a common and versatile polymer used in plastics, textiles, and other applications.” Ex. 4 (Askounis Decl.) ¶ 27. Citing the *Handbook of Plastics, Elastomers, and Composites* (Ex. 7), she further explained that PET “has become a dominant packaging material for both carbonated and noncarbonated beverages” and thus a POSITA would be familiar with the material as used in the ’422 Patent. *Id.* Defendants’ expert Dr. Storey agreed. Dr. Storey testified that “a POSITA’s general knowledge would have included the widespread use of PET” and “at the time of the ’422 Patent, and still today, PET is a dominant material for beverage and food containers.” Ex. 3 (Storey Dep. Tr.) 88:20–89:6.

Both experts also agree that the ’422 Patent uses the term PET in its ordinary and customary way. For example, Dr. Askounis opined that “[i]n my opinion, at the time of the invention of the

'422 Patent, a POSITA would have understood the term 'polyethylene terephthalate (PET)' to have its plain and ordinary meaning [...]." Ex. 4 (Askounis Decl.) ¶ 38. Similarly, when asked whether "a POSITA would [...] have a good familiarity with PET and a very good knowledge of PET?" Dr. Storey testified "I would say so. PET is the most important polyester. It is one of the most important packaging plastics." Ex. 3 (Storey Dep. Tr.) 69:2-21.

Additionally, Dr. Storey's testimony reveals that no construction is necessary as he confirmed he does not rely on "any express definition in the patent" or "any disclaimer [] in the prosecution history"—the two recognized justifications for deviating from a term's plain and ordinary meaning. Ex. 3 (Storey Dep. Tr.) 130:9–17; *Thorner*, 669 F.3d at 1365. Rather, Dr. Storey agreed that "[t]he only justification [he] presented in [his] declaration for why PET needs to be construed is [his] opinion that a layperson, such as a juror, may misunderstand what PET is[.]" *Id.* 131:5–9. Setting aside that this is mere speculation, the excuse of layperson confusion does not justify modifying the meaning of a term, especially given the bedrock principle under *Phillips* that claim construction should reflect the understanding of a "person of ordinary skill in the art"—as opposed to whether a "layperson" would have a clear understanding of the term. *See Phillips*, 415 F.3d at 1315; *see also Fitness Quest Inc. v. Monti*, No. 5:06-CV-02691, 2007 WL 2359821, *1 (N.D. Ohio Aug. 16, 2007) ("The goal of claim construction is not to 'dumb down' the language of the claim to make it entirely accessible to a lay person, but rather to ensure that the language of the claim is intelligible to one ordinarily skilled in the art at the time of the invention."). Further, as discussed in Section IV.C.2, rather than clarify the definition of PET, Defendants' construction confuses the term by improperly limiting its scope and excluding express embodiments. *See GE Lighting Sols.*, 750 F.3d at 1311.

2. Defendants' Proposed Construction Is Contrary to the Intrinsic and Extrinsic Evidence and Does Not Add Clarity

Defendants’ construction limiting PET to “[a] polymer prepared from terephthalic acid (or dimethyl terephthalate) and ethylene glycol, and not any other monomers” is further improper for two primary reasons: (1) it improperly excludes express embodiments and (2) it improperly converts the apparatus claims of the ’422 Patent into method claims for manufacturing PET.

First, Defendants’ construction improperly redefines the bounds of the claim and excludes express embodiment. It is improper to “incorrect[ly] construe the claims to exclude [] embodiment[s].” See *GE Lighting Sols.*, 750 F.3d at 1311; *Estech Sys. IP*, 2023 WL 2695093 at *6. Defendants’ definition—“terephthalic acid (or dimethyl terephthalate) and ethylene glycol, and not any other monomers”—inexplicably excludes monomers that could be used to prepare PET and were known as such by POSITAs. Defendants’ proposed construction lists three possible monomers as components of PET—(1) terephthalic acid, (2) dimethyl terephthalate, and (3) ethylene glycol—and expressly excludes “any other monomers.” Dr. Storey’s opinions and testimony, however, confirm that Defendants’ construction is inconsistent with a POSITA’s understanding, as its exclusion of “any other monomers” reads out other ways known to a POSITA for manufacturing PET. For example, in his declaration, Dr. Storey explained that dimethyl terephthalate (which is an ester) is not strictly required to make PET, but merely commonly used. Ex. 5 (Storey Decl.) ¶ 43. Dr. Storey confirmed that other esters (other than terephthalic acid) can be used to make PET, even beyond the specific ester (dimethyl terephthalate) listed in Defendants’ construction. *Id.*, ¶ 85 n.2 (“[M]any different esters of terephthalic acid could be used to produce PET.”). Dr. Storey agreed as much at his deposition:

Q: It is possible to create PET with esters of terephthalic acid other than what you’ve listed in your proposed definition; correct?

A: Correct.

Ex. 3 (Storey Dep. Tr.) 121:14-17. Dr. Storey further admitted that examples of such esters include diethyl terephthalate, dipropyl terephthalate, methyl ethyl terephthalate, and dipentyl terephthalate (and more)—all of which Dr. Storey admitted could be used to make PET and all of which would be excluded from Defendants’ narrow construction. Ex. 3 (Storey Dep. Tr.) 115:1–117:22.

To the extent that Defendants argue that the three monomers listed in their proposed construction are the most common or cost-effective monomers used to prepare PET for “commercial” applications, this argument is unavailing and contrary to black letter law. Absent an express disclaimer or definition, it is improper to limit a claim to a commercial embodiment. *Thorner*, 669 F.3d at 1365; *Ricoh Co., Ltd. v. Lite-On It Corp.*, 2005 WL 8161394, *15, *19 (E.D. Tex. June 29, 2005) (“the claims are not automatically limited to the preferred embodiment, ***much less limited to a commercial embodiment***”). Defendants’ argument is further unsupported by any evidence other than Dr. Storey’s say-so and Defendants have not cited anything suggesting limiting PET to these three monomers.

Second, and relatedly, Defendants’ proposed construction improperly converts the apparatus claims of the ’422 Patent into method claims for manufacturing PET. *Vanguard Prods. Corp. v. Parker Hannifin Corp.*, 234 F.3d 1370, 1372 (Fed. Cir. 2000) (“The method of manufacture, even when cited as advantageous, does not of itself convert product claims into claims limited to a particular process.”). As explained above, Defendants’ proposed construction limits PET to specific varieties made from three specific ingredients, and excludes PET made from other possible ingredients. But unless a claim limitation of a product claim recites a requirement that the element be made by a certain process, the method of manufacture should not be read into a product claim as a claim limitation. Here, Defendants offer no justification for doing so.

At bottom, Defendants’ construction is an improper attempt to redefine a claim term absent valid justification.

D. “Crystallizable Polyethylene Terephthalate (PET)”

Claim Term (Where Term Appears)	Plaintiff B+W’s Proposed Construction	Defendants’ Proposed Construction
“crystallizable polyethylene terephthalate (PET)” (Claim 18)	Plain and ordinary meaning	“polyethylene terephthalate (PET) (as construed) that is capable of crystallizing”

1. Dr. Storey’s Opinions Conflict with Defendants’ Own Proposed Construction

At the outset, Defendants’ proposed construction is in conflict with their actual understanding (and Dr. Storey’s understanding) of the term “crystallizable PET.” Defendants’ propose this term refers to PET “that is capable of crystallizing”—which implies the existence of PET that is *not* capable of crystallizing. The claims themselves support this: Claim 18, which depends on Claim 1, recites “[t]he recyclable shrink label according to claim 1, wherein the heat shrink film comprises *crystallizable polyethylene terephthalate (PET)*.” Ex. 1 (’422 Patent), Cl. 18. A POSITA would have understood that the PET recited by Claim 18 is crystallizable, while the PET in the film recited by Claim 1 may or may not be—*See id.*, Cl. 1; *see Clearstream Wastewater Systems, Inc. v. Hydro-Action, Inc.*, 206 F.3d 1440, 1446-1447 (Fed. Cir. 2000); *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1187 (Fed. Cir. 1998).

Dr. Storey’s opinion, however, indicates that he (and Defendants) believe that *all PET* is crystallizable, and that there is no PET incapable of crystallizing. Specifically, Dr. Storey opined that the ability to crystallize was an inherent property of all PET materials:

The ability to crystallize is an inherent and fundamental property of polyethylene terephthalate. PET, as synthesized from its standard two-monomer recipe, is by its very nature a semi-crystalline polymer. This means its long, linear, and uniform

molecular chains have a natural tendency to align themselves into organized, tightly packed regions called crystallites. Although processing conditions can affect the degree of crystallinity in a final product (for example, a rapidly cooled film may be largely amorphous), *the material itself always retains this innate capability to crystallize.*

Ex. 5 (Storey Decl.) ¶ 96. In fact, Dr. Storey opines that “the term ‘crystallizable’ is a simple modifier. It describes an inherent fundamental capability of [PET]. Put plainly, the ability to crystallize is a well-known characteristic of PET[.]” *Id.*, ¶ 89.

Dr. Storey confirmed this understanding (that all PET has the innate capability to crystallize) at his deposition. When asked whether he believed there to be “a difference between Claim 1 and Claim 18,” Dr. Storey confirmed his understanding that Claim 18 “doesn’t effectively add an additional limitation” to Claim 1 because the only limitation added by Claim 18 over Claim 1 is to specify that the PET of Claim 18 is “crystallizable.” Ex. 3 (Storey Dep. Tr.) 155:4–156:4. In fact, Dr. Storey agreed that “Claim 1 and Claim 18 are the same” under this proposal. *Id.*

Accordingly, the Court should reject Defendants’ proposed construction on the basis that Defendants themselves do not agree with it. Far from believing that “crystallizable PET” refers only to PET “that is capable of crystallization,” Defendants and Dr. Storey apparently believe that all PET is capable of crystallizing—raising the question of why the term merits construction in the first place. At the very least, Defendants’ proposed construction is needlessly confusing in light of Dr. Storey’s opinions and lacks support; therefore, it should be rejected. *Thorner*, 669 F.3d at 1366; *Home Diagnostics, Inc. v. LifeScan, Inc.*, 381 F.3d 1352, 1358 (Fed. Cir. 2004).

2. No Departure from the Plain and Ordinary Meaning Is Necessary

As discussed above in Section IV.C, at the time of the ’422 Patent, polyethylene terephthalate (or “PET”) was (and continues to be) a well-known term to a POSITA and does not warrant departure from its plain and ordinary meaning. Similarly, “crystallizable polyethylene terephthalate (PET)” was (and continues to be) a well-known term to a POSITA—specifically, a

POSITA would have understood the plain and ordinary meaning of the term to be PET that is capable of crystallizing, as opposed to PET that is not capable of crystallizing. Defendants can point to no reason to depart from this plain and ordinary meaning. *See Thorner*, 669 F.3d at 1365.

First, as explained above, the claims would have indicated to a POSITA that “crystallizable PET” is a possible condition or attribute of certain PET materials. That is, while Claim 1 recites “PET” generally, Claim 18 requires that the PET used in the heat shrink label be “crystallizable.” A POSITA would have therefore understood that Claim 1 encompasses all PET, regardless of ability to crystallize, whereas Claim 18 only encompasses PET that is crystallizable.

Second, contrary to Dr. Storey’s opinion (Ex. 5, Storey Decl. ¶ 91), the specification does not define “crystallizable PET” to suggest that all PET is crystallizable (which, as explained above, is inconsistent with Defendants’ proposed construction). The specification states “[g]enerally clear crystallizable heat shrink films (*e.g., PET shrink films*) are considered recyclable if no inks are retained on the film after a caustic wash cycle typically used in PET reclaiming processes.” Ex. 1 (’422 Patent), 6:61–65. Not only does this language fail to define the term “crystallizable PET” (which is the actual claim term at issue), it does not define “crystallizable heat shrink films” to mean “PET shrink films” or vice versa. Rather, the specification notes that PET shrink films are “generally” an example of a “clear crystallizable heat shrink film[,],” and nothing more.

Third, Dr. Storey’s citation to the Sasaki reference in the prosecution history is unavailing. Dr. Storey argues that Sasaki teaches PET that “can be used in both the heat shrinkable synthetic resin film . . . and a crystalline polymer film,” and, as a result, the Examiner found it obvious that Sasaki’s PET is crystallizable. Ex. 5 (Storey Decl.) ¶ 93. This example fails to define “crystallizable PET” or show patentee disclaimed scope. *Cont’l Cirs. LLC v. Intel Corp.*, 915 F.3d

788, 798 (Fed. Cir. 2019). Rather, Sasaki merely provides an example of a PET film that the Examiner believed was also crystallizable.

Fourth, similar to his treatment of the other terms, Dr. Storey admitted at his deposition that Defendants’ construction of “crystallizable PET” (and his opinions supporting the same) are not due to “any express definition in the patent” or “any disclaimer [] in the prosecution history,” but rather his own belief that the construction is necessary to aid *laypersons*. Ex. 3 (Storey Dep. Tr.) 147:7–148:8. But this again runs afoul of *Philips* and the principle that claim construction must be understood from the point of view of a POSITA. Specifically, Dr. Storey testified: “I didn’t want a *layperson*, such as a juror, to think that crystallizable PET is something special or something different than the PET that I construed above.” *Id.* 148:9–20; *see also id.* 150:7–13; Ex. 5 (Storey Decl.) ¶ 102. Similar to Defendants’ (and Dr. Storey’s) improper justification for construing the term “PET,” potential layperson confusion is not a reason warranting deviation from a term’s plain and ordinary meaning, particularly where Defendants attempt to redefine the term, as discussed below in Section IV.D.3.

3. Defendants’ Proposed Construction Is Contrary to the Intrinsic and Extrinsic Evidence and Does Not Add Clarity

Defendants’ proposed construction—as understood by Dr. Storey’s opinion that all PET is crystallizable—is improper for at least two reasons: (1) it violates the doctrine of claim differentiation and (2) improperly redefines the claim term.

First, Defendants’ construction should be rejected because it violates the core tenant of claim differentiation. Under Federal Circuit law, individual claims have different scope and should not be construed to be redundant with other claims. *See Clearstream Wastewater Systems, Inc.*, 206 F.3d at 1446-1447. Yet, under Defendants’ proposed construction, Claims 1 and 18 would become redundant. As explained above, Dr. Storey opined that “[t]he ability to crystallize is an

inherent and fundamental property of [PET]” (Ex. 5, Storey Decl. ¶ 96) and later testified that “Claim 1 and Claim 18 are the same.” Ex. 3 (Storey Dep. Tr.) 155:4–156:4. Thus, Defendants’ proposed construction should be rejected on the basis of claim differentiation.

Second, provided Dr. Storey’s apparent understanding that all PET is crystallizable, Defendants’ proposed construction should be rejected for the separate reason that it is factually incorrect—by Dr. Storey’s own admission, there are forms of PET that are not crystallizable. Accordingly, adopting Defendants’ proposed construction would unfairly limit Claim 1 to not include such PET materials. Specifically, Dr. Storey readily agreed that there are processing steps that can remove PET’s capability to crystallize, contradicting Defendants’ proposal:

Q: Can you provide an example of an irreversible change that would completely inhibit the ability of PET to crystallize?

A: ***Possibly degradation by oxidation might be an example.*** There may be additives that could be added -- although I can't name any, but there could be additives that were capable of inhibiting crystallization. And those additives might be difficult or impossible to remove back out of the polymer.

Q. So PET that has been sufficiently degraded by oxidation may be irreversibly changed, such that it can no longer crystallize. Is that right?

A. ***I'm saying that that's possible, yes.***

Q: And it’s also possible that certain additives could permanently affect or completely inhibit the ability of PET to crystallize if those additives cannot be removed from the PET that they're added to. Is that possible?

A: ***It is possible, yes.***

Ex. 3 (Storey Dep. Tr.) 145:11–146:7.

Because Defendants’ construction improperly renders Claim 18 redundant with Claim 1 and improperly seeks to narrow the scope of Claim 1, Defendants’ construction should be rejected.

E. “Comprising Polyethylene Terephthalate (PET)”

Claim Term (Where Term Appears)	Plaintiff B+W's Proposed Construction	Defendants' Proposed Construction
"comprising polyethylene terephthalate (PET)" (Claims 1, 19)	Plain and ordinary meaning Term is not indefinite under 35 U.S.C. § 112	Indefinite under 35 U.S.C. § 112 or, in the alternative, should be construed as "the majority of which is polyethylene terephthalate (PET) (as construed)"

Defendants incorrectly contend that the term "comprising polyethylene terephthalate (PET)" is indefinite under 35 U.S.C. § 112 or, in the alternative, should be construed as "the majority of which is polyethylene terephthalate (PET) (as construed)." Defendants fail to clear the high bar of indefiniteness, as 35 U.S.C. § 112 only requires a patent's claims to "inform those skilled in the art about the scope of the invention with *reasonable certainty*." *Nautilus*, 572 U.S. at 910. The statute "does not require absolute certainty, but only reasonable certainty around the boundaries of the term." *Nanoco Techs.* 2021 WL 1890453 at *8; Ex. 3 (Storey Dep. Tr.) 64:17–65:25. The intrinsic and extrinsic record make clear that a POSITA would have no difficulty understanding the scope of this term, which should be given its plain and ordinary meaning. Defendants' alternative construction is unsupported: far from being based on an express definition or clear disavowal of scope, Defendants' alternative construction appears to be made out of whole cloth, without citation to any intrinsic or extrinsic source. *Thorner*, 669 F.3d at 1365.

1. A POSITA Would Understand the Scope of the Claim Term and Its Plain and Ordinary Meaning

At the outset, it is important to note that the parties agree that "PET" is not indefinite—the only indefiniteness dispute rests on whether "comprising PET" has a meaning discernible to a POSITA with reasonable certainty. "Comprising polyethylene terephthalate (PET)" is not

indefinite, and the intrinsic and extrinsic record provide more than the requisite clarity for a POSITA to have reasonably certainty as to its bounds.

First, the claims make the scope of the claim clear. Claim 1 recites “a heat shrink label film **comprising** polyethylene terephthalate (PET).” Ex. 1 (’422 Patent), Cl. 1. “Comprising” is a term defined by Federal Circuit law, which has ruled that “comprising” is “a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.” *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed. Cir. 1997). Further, in contrast to Claim 1, Claim 5 recites “[t]he recyclable shrink label of claim 1, wherein the heat shrink film **consists of** polyethylene terephthalate (PET).” *Id.* at Cl. 5. In view of this context, a POSITA would have readily understood the plain and ordinary meaning of “comprising PET,” which refers to a material that includes PET (as a stated element) and possibly includes other elements—unlike the heat shrink film recited in Claim 5, which may only include PET. *See* Ex. 4 (Askounis Decl.) ¶¶ 45–51.

Indeed, Defendants’ expert Dr. Storey does not agree with Defendants’ own interpretation, which requires a departure from the plain reading of the term “comprising PET.” His declaration agreed that the plain and ordinary meaning was clear: “the patentee **made it clear** that the scope of Claim 1 was intended to cover films that contain PET and films that are not 100 percent PET.” Ex. 5 (Storey Decl.) ¶ 103; *see also* Ex. 3 (Storey Dep. Tr.) at 156:14–162:21. When questioned in his deposition, Dr. Storey confirmed the plain and ordinary meaning of “comprising PET,” testifying that “‘comprises’ is open-ended. ‘It could be--it could be anywhere from the barest fraction of 1 percent up to 99-and-a-fraction percent.’” *Id.* at 160:4–13. Accordingly, both the plain reading of the claims themselves and Dr. Storey’s opinion supports that the term is not indefinite.

Second, the specification further confirms that “comprising PET” would have had a clear and well-understood meaning to a POSITA. Indeed, the specification provides a clear definition of the term “comprises” (and “consists of”) consistent with how the terms are used in the claims and with Federal Circuit law, as discussed above. The specification states that “[t]he term ‘comprises’ and variations thereof do not have a limiting meaning where these terms appear in the description and claims. Such terms will be understood to imply the inclusion of a stated step or element or group of steps or elements but not the exclusion of any other step or element or group of steps or elements.” Ex. 1 (’422 Patent), 3:15–20; *see also* Ex. 4 (Askounis Decl.) ¶ 40.

The specification also provides support as to the definition of “comprises” as it contrasts the term with other defined terms such as “consisting of” and “substantially” (and Defendants’ construction improperly overlaps with these other defined terms). The ’422 Patent states that “the phrase ‘consisting of’ indicates that the listed elements are required or mandatory, and that no other elements may be present.” *Id.* at 3:22–24. Therefore, a POSITA would have understood “consisting of” (but not “comprising”) to mean that one thing includes an element (or set of elements) and excludes all other elements. Ex. 4 (Askounis Decl.) ¶ 41. Similarly, the ’422 Patent states that “[t]he term ‘substantially’ as used here has the same meaning as ‘nearly completely,’ and can be understood to modify the term that follows by at least about 90%, at least about 95%, or at least about 98%.” *Id.* at 3:34–37. A POSITA would thus have understood “substantially” (but not “comprising”) to mean that one thing includes an element (or set of elements) as a majority, as further discussed below. Ex. 4 (Askounis Decl.) ¶ 43.

The specification provides further clarity to this term through numerous examples of a shrink film “comprising PET.” For instance, the ’422 Patent expressly indicates that “[i]llustrative specific polymers or polymer types that can be utilized to form shrink films can include, for

example, polyethylene terephthalate (PET), [other polymers], and copolymers and blends thereof.” *Id.* at 9:3–10. In addition, the ’422 Patent states that “[i]n a preferred embodiment, the shrink film **includes** polyethylene terephthalate (PET)” while “[i]n some embodiments, the shrink film **consists of** polyethylene terephthalate (PET),” explicitly contrasting shrink films that only include PET from those that include PET with other elements. *Id.* at 9:15–18; *see also id.* at 20:63–21:6. As a further example, the ’422 Patent describes Embodiment 6, which is “the recyclable shrink label according to any of [the preceding embodiments of the invention], wherein the heat shrink film **comprises polyethylene terephthalate (PET)**, polyethylene terephthalate glycol-modified (PETG or PET-G), polyvinyl chloride (PVC), polystyrene or oriented polystyrene (OPS), polylactic acid (PLA), polypropylene (PP), polyethylene (PE), **or a combination thereof.**” *Id.* at 20:52–58. Accordingly, a POSITA would have understood that the heat shrink film recited by Claim 1 of the ’422 Patent encompasses films made from PET and possibly including other materials. *Scale Video Coding LLC v. Cisco Sys., Inc.*, No. 4:23-CV-803, 2025 WL 1024663, *6-*7 (E.D. Tex. Apr. 7, 2025).

Third, the extrinsic record also demonstrates that “comprises PET” has a clear and well-understood meaning to a POSITA. For example, as explained above, **both parties’** experts agree that “the patentee made it clear that the scope of claim 1 was intended to cover films that contain PET and films that are not 100% PET.” Ex. 5 (Storey Decl.) ¶ 103; *see also* Ex. 3 (Storey Dep. Tr.) at 156:14–162:21. Dr. Askounis also opined that “a POSITA would have understood that a certain material (such as a heat shrink label) could be made entirely from PET or, alternatively, be made partially from PET.” Ex. 4 (Askounis Decl.) ¶ 46. Dr. Askounis provided several examples of commonly known PET blends, such as “PET may be blended with several different types of polymers such as high-density polyethylene (HDPE), epoxy, nylon, and polybutylene

terephthalate (PBT).” *Id.* ¶ 32; *see also id.* ¶ 33. Dr. Storey’s deposition testimony further supports this understanding as he confirmed that a specific prior-art reference (U.S. Pat. Pub. No. 2022/0389214 (“Lee”)) that he cited in an IPR declaration (challenging the validity of the ’422 Patent) discloses “a heat shrink film that ***comprises PET and something that is not PET***, that it can be successfully processed within a standard PET recycling stream.” Ex. 3 (Storey Dep. Tr.) at 179:4–8. Therefore, a POSITA would have understood the scope of “comprising PET” and its plain and ordinary definition—namely, a material that includes PET and may optionally include other components.

To the extent Defendants argue that the term “comprising PET” is unclear when read in conjunction with the term “recyclable with a PET container,” this argument is unavailing. ***First***, Defendants’ argument is irrelevant because it is not a proper test for indefiniteness. Whether a material “comprises PET” and whether it is “recyclable with a PET container” are separate analyses. Neither Defendants nor Dr. Storey have provided any support for their bid to import the term “recyclable with a PET container”—which the parties agree is not indefinite—into the analysis for whether something comprises PET. Indeed, when provided with the below chart at his deposition, Dr. Storey confirmed so and agreed that “there are four possible outcomes if we were considering the two questions, ‘does a label include PET’ and ‘does a label meet industry-recognized benchmarks for recyclable with PET status.’” Ex. 3 (Storey Dep. Tr.) at 189:18-24.

	Meets industry-recognized benchmarks for "recyclable with PET" status	Does not meets industry-recognized benchmarks for "recyclable with PET" status
Includes PET	Yes, includes PET Yes, meets industry-recognized benchmarks	Yes, includes PET No, does not meet industry-recognized benchmarks
Does not include PET	No, does not include PET Yes, meets industry-recognized benchmarks	No, does not include PET No, does not meet industry-recognized benchmarks

Ex. 6 (Storey Dep. Demonstrative Ex. 3). As shown above, a particular material may include PET and meet industry-recognized benchmarks for “recyclable with PET,” which Dr. Storey admitted was how a POSITA would have understood the term “recyclable with PET.” Ex. 3 (Storey Dep. Tr.) at 187:17–188:4. Such a material would fall under the scope of Claim 1 of the ’422 Patent (assuming the other limitations are met) which Dr. Storey admits. Ex. 3 (Storey Dep. Tr.) at 190:4–10. By contrast, a second material might not include any PET but would still be recyclable with PET. A third material might include PET but not be recyclable with PET. And yet a fourth material might not include PET and might not be recyclable with PET. As Dr. Storey admits, these latter three materials would not fall under the scope of Claim 1. Ex. 3 (Storey Dep. Tr.) at 190:12–19. Thus, Dr. Storey’s own admitted understanding of the bounds of the term “comprising PET”—even when simultaneously considering the unrelated term “recyclable with a PET container”—demonstrates a POSITA’s understanding of the scope of Claim 1.

Second, Dr. Storey’s testimony confirms that “comprising PET” is not in fact indefinite, even when read with the term “recyclable with a PET container.” Dr. Storey’s indefiniteness argument boils down to his theory that a POSITA would be confused when presented with a material that comprises PET and other components (such as PVC or PLA), because a POSITA would purportedly not know how to make such a material recyclable with a PET container. Storey Decl. ¶¶ 104–106. But Dr. Storey’s sworn testimony directly contradicts his declaration: he admits that a POSITA would have known exactly what materials could be used with PET such that the resulting film would still be recyclable with a PET container.¹ For example, Dr. Storey testified that “a POSITA, at the time of the ’422 Patent, would have been aware that to achieve recyclable

¹ Dr. Storey, in fact, walked back his opinion that “comprising PET” is ambiguous, testifying: “And if ambiguity was the—perhaps it’s not the right word.” Ex. 3 (Storey Dep. Tr.) at 168:20–169:12.

with PET status, that determination [of recyclability] would be informed by established industry practices and guidelines” and “[t]hese guidelines often address factors such as the label material itself.” Ex. 3 (Storey Dep. Tr.) at 75:2–15. Further, Dr. Storey testified that “a POSITA would have been familiar with the published design guidelines and testing protocols from the APR with respect to PET recycling” and that “[a] POSITA would understand that achieving recyclable with PET status, particularly for widespread commercial use, generally involves meeting such industry-recognized benchmarks to ensure the label contributes to, rather than detracts from, the circular economy of PET.” Ex. 3 (Storey Dep. Tr.) at 75:18–76:23; *see also id.* at 186:22–188:4.

Even more notable, however, was Dr. Storey’s sworn testimony that it would have been “*fundamental knowledge*” to a POSITA whether certain materials could be recycled with PET. *Id.* at 166:20–168:19. For example, when asked whether “a POSITA . . . would know, [...] I’m not supposed to put PET and PVC together if this thing is going to be recycled [...]?” he confirmed, “[a] POSITA should know that.” *Id.* at 168:9–15. Dr. Storey then clarified a POSITA *would* know what combinations of PET to avoid in order to make a film recyclable with PET. *Id.* 168:17–19.

Dr. Storey’s testimony thus makes it abundantly clear that a POSITA would not have been confused by the scope of Claim 1—with respect to “comprising PET” and/or “recyclable with a PET container” (which Defendants did not challenge)—because there are established industry benchmarks for determining the recyclability of materials with PET. Defendants’ proposal, which flies in the face of a POSITA’s understanding as confirmed by both sides’ experts, would lead to the absurd conclusion that the ’422 Patent would have needed to provide a numerical amount for each possible combination of PET and other polymers in order for the term not to be indefinite, which is not the proper test for indefiniteness. *See Biosig Instruments, Inc. v. Nautilus, Inc.*, 783

F.3d 1374, 1381 (Fed. Cir. 2015) (definiteness standard does not require “absolute or mathematical precision”).

Accordingly, Defendants’ indefiniteness challenge should be rejected, and the term should be given its plain and ordinary meaning.

2. Defendants’ Alternative Proposed Construction is Unsupported by the Intrinsic Or Extrinsic Record

Defendants’ fallback argument that “comprising PET” should be construed as “the majority of which is polyethylene terephthalate (PET) (as construed)” is improper for two principal reasons. **First**, Defendants have provided no support for this opinion other than Dr. Storey’s declaration, let alone shown the required bases for deviating from a term’s plain and ordinary meaning. *Thorner*, 669 F.3d at 1365; *Phillips*, 415 F.3d at 1318 (Fed. Cir. 2005) (conclusory, unsupported asserts by an expert are not useful and should be discounted). Defendants do not cite the patent or prosecution history or any extrinsic evidence other than Dr. Storey, who again, cited no support for this opinion. Ex. 5 (Storey Decl.) ¶¶ 116–18. When asked at his deposition “[w]here did the 50 percent number come from?” Dr. Storey testified that it was “just the logical reasoning that if it was less, then it would not be considered PET-based. It’s just the only—the only interpretation that—that I felt made sense in this—in this case.” Ex. 3 (Storey Dep. Tr.) at 195:5–196:4; *see also id.* at 198:23–199:3. Dr. Storey’s undefined “logical reasoning,” however, is not a basis recognized for rewriting the claims and deviating from the plain and ordinary meaning of a term. *Thorner*, 669 F.3d at 1365. Further, Dr. Storey did not propose this construction for “comprising PET” in his sworn declaration in support of American Fuji Seal, Inc.’s petition for *inter partes* review; in fact, he proposed no construction. Ex. 3 (Storey Dep. Tr.) at 81:19–22, 85:2–5; *see* 37 CFR Part 42 (same claim construction standard applies in IPR and civil action).

Second, in addition to lacking valid support for construing the term as “the majority of

which is polyethylene terephthalate (PET) (as construed),” Defendants’ construction improperly conflicts with another defined term: “substantially.” The ’422 Patent states that “[t]he term ‘substantially’ as used here has the same meaning as ‘nearly completely,’ and can be understood to modify the term that follows by at least about 90%, at least about 95%, or at least about 98%.” Ex. 1 (’422 Patent), 3:34–37. As Dr. Askounis opined, a POSITA would have understood “‘substantially’ (but not ‘comprising’)” to mean that one thing includes an element (or set of elements) as a majority. Ex. 4 (Askounis Decl.) ¶ 43. The fact that Claim 1 recites “comprising PET” rather than “substantially PET,” and does not otherwise include any quantitative measure, strongly indicates that Defendants’ alternative construction should be rejected as an improper attempt to redefine a claim term. Further, extrinsic evidence demonstrates that a POSITA would understand labels that include less than “50%” PET as comprising PET. For example, Dr. Askounis explained, “PET may be used in blended polymers even where PET is not a ‘majority’ of the blend, such as in reported fractions from 10% to 40%.” *Id.* ¶¶ 56-58.

Because Defendants’ construction is unsupported and would improperly exclude embodiments absent proper justification, it should be rejected.

V. CONCLUSION

For the reasons set forth above, B+W respectfully requests that the Court construe “recyclable” as “capable of being recycled without removing the label from a container before or during the recycling process,” reject Defendants’ unfounded indefiniteness argument, and reject Defendants’ improper proposed constructions in favor of giving the disputed terms their plain and ordinary meanings.

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Respectfully submitted,

/s/ Brandon H. Brown

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served on all counsel of record who are deemed to have consented to electronic service via the Court's CM/ECF system per Local Rule CV-5(a)(3) on October 7, 2025.

/s/ *Brandon H. Brown*
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CERTIFICATE OF CONFERENCE

The undersigned hereby certifies that all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document via the Court's CM/ECF system pursuant to Local Rule CV-5(a)(3) on October 7, 2025.

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