UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

Brook + Whittle LTD,

Plaintiff,

v.

Nestlé USA, Inc., et al.,

Defendants.

Case No. 2:24-CV-00735-JRG-RSP

JURY TRIAL DEMANDED

DEFENDANT NESTLÉ USA, INC.'S
ANSWER AND COUNTERCLAIMS

Defendant Nestlé USA, Inc. ("NUSA"), for its answer to Plaintiff Brook + Whittle LTD's ("B+W") complaint, states as follows:[1]

NATURE OF THE ACTION

1. NUSA admits that the complaint purports to assert a claim for patent infringement brought under the patent laws of the United States, 35 U.S.C. § 1, et seq., but NUSA denies any allegation or implication that NUSA has infringed any valid claim of U.S. Patent No. 11,961,422 ("the '422 patent") in any respect. NUSA denies the remaining allegations of paragraph 1.

2. NUSA is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 2 and therefore denies them on that basis.

3. Admitted.

4. NUSA is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 4 and therefore denies them on that basis.

[1] Except as expressly admitted, NUSA denies each and every allegation of the complaint. The responses herein correspond, paragraph-by-paragraph, to the numbered paragraphs of the complaint.

JURISDICTION AND VENUE

5. NUSA admits that district courts have original jurisdiction over certain civil actions under 28 U.S.C. §§ 1331 and 1338. NUSA denies the remaining allegations of paragraph 5.

6. NUSA admits that the Court has personal jurisdiction over NUSA. NUSA denies the remaining allegations of paragraph 6.

7. Denied.

8. Denied.

9. Denied.

10. Denied.

11. Denied.

12. Denied.

13. Denied.

14. Denied.

15. Denied.

16. Denied.

17. NUSA is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 17 and therefore denies them on that basis.

18. NUSA is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 18 and therefore denies them on that basis.

19. NUSA is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 19 and therefore denies them on that basis.

20. NUSA is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 20 and therefore denies them on that basis.

21. NUSA is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 21 regarding Defendant Fuji Seal Int'l Inc.'s ("FSI") knowledge or awareness as to any alleged facts and therefore denies those allegations on that basis. NUSA denies the remaining allegations of paragraph 21.

22. NUSA is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 22 regarding FSI's knowledge or awareness as to any alleged facts and therefore denies those allegations on that basis. NUSA denies the remaining allegations of paragraph 22.

23. NUSA is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 23 regarding FSI's knowledge or awareness as to any alleged facts and therefore denies those allegations on that basis. NUSA denies the remaining allegations of paragraph 23.

24. NUSA is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 24 regarding FSI's knowledge or awareness as to any alleged facts and therefore denies those allegations on that basis. NUSA denies the remaining allegations of paragraph 24.

25. NUSA is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 25 regarding FSI's knowledge or awareness as to any alleged facts and therefore denies those allegations on that basis. NUSA denies the remaining allegations of paragraph 25.

26. NUSA is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 26 and therefore denies them on that basis.

27. NUSA is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 27 and therefore denies them on that basis.

BACKGROUND

28. NUSA is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 28 and therefore denies them on that basis.

29. NUSA is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 29 and therefore denies them on that basis.

30. Admitted.

31. NUSA is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 31 and therefore denies them on that basis.

32. NUSA is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 32 and therefore denies them on that basis.

33. NUSA is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 33 and therefore denies them on that basis.

THE '422 PATENT

34. NUSA is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 34 and therefore denies them on that basis.

35. Denied.

ACCUSED PRODUCT

36. Denied. Answering further, NUSA understands that the "Accused Product(s)" in this case is/are the product(s) specifically defined and/or identified in B+W's Disclosure of Asserted Claims and Infringement Contentions, served on November 7, 2024.

ALLEGED CLAIMS FOR RELIEF

Count 1—Alleged Infringement of United States Patent No. 11,961,422

37. In response to the allegations of paragraph 37, NUSA incorporates by reference its foregoing responses as though fully restated herein.

38. Denied.

39. Denied.

40. Denied.

41. NUSA admits that Exhibit B purports to include charts comparing claims 1 and 19 of the '422 Patent to the Accused Products. NUSA denies the remaining allegations of paragraph 41.

42. NUSA admits that paragraph 42 restates claim 1 of the '422 patent as recited in the '422 patent. NUSA denies the remaining allegations of paragraph 42.

43. Denied.

44. The contents of the April 12, 2024 press release speak for themselves. NUSA denies the remaining allegations of paragraph 44.

45. The contents of the April 12, 2024 press release speak for themselves. NUSA denies the remaining allegations of paragraph 45.

46. Denied.

47. NUSA is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 47 and therefore denies them on that basis.

48. The contents of the April 12, 2024 press release speak for themselves. NUSA denies the remaining allegations of paragraph 48.

49. The contents of the Nesquik video speak for themselves. NUSA denies the remaining allegations of paragraph 49.

50. The contents of the Nesquik video speak for themselves. NUSA denies the remaining allegations of paragraph 50.

51. The contents of the Nesquik video speak for themselves. NUSA denies the remaining allegations of paragraph 51.

52. The contents of the Nesquik video speak for themselves. NUSA denies the remaining allegations of paragraph 52.

53. NUSA admits that paragraph 53 restates claim 19 of the '422 patent as recited in the '422 patent. NUSA denies the remaining allegations of paragraph 53.

54. Denied.

55. Denied.

56. The contents of the Nesquik video speak for themselves. NUSA denies the remaining allegations of paragraph 56.

57. NUSA is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 57 related to FSI's knowledge or awareness of the '422 patent and therefore denies them on that basis. NUSA denies the remaining allegations of paragraph 57.

58. NUSA admits that it has been aware of the '422 patent since the filing date of the complaint. NUSA denies the remaining allegations of paragraph 58.

59. Denied.

60. Denied.

61. Denied.

62. Denied.

63. The content of NUSA'S advertising speaks for itself. NUSA denies the remaining allegations of paragraph 63.

64. Denied.

65. Denied.

66. Denied.

67. Denied.

68. Denied.

69. Denied.

70. NUSA admits that it has no express license or authorization under the '422 Patent. NUSA denies the remaining allegations of paragraph 70.

71. Denied.

72. Denied.

73. Denied.

74. Denied.

JURY TRIAL DEMANDED

75. NUSA demands a trial by jury on all issues so triable.

PRAY FOR RELIEF

76. In response to the prayer for relief paragraphs in B+W's complaint, NUSA denies that B+W is entitled to any and all relief it seeks. NUSA respectfully requests that the Court deny any and all relief to B+W.

AFFIRMATIVE AND OTHER DEFENSES

FIRST DEFENSE

The complaint fails to state a cause of action for which relief can be granted as to direct infringement of the '422 patent by NUSA.

SECOND DEFENSE

The complaint fails to state a cause of action for which relief can be granted as to indirect infringement of the '422 patent by NUSA.

THIRD DEFENSE

Under 28 U.S.C. § 1400(b), venue is improper in this judicial district for B+W's claims of patent infringement alleged against NUSA.

FOURTH DEFENSE

NUSA does not infringe, and has not infringed under any theory of infringement, including joint infringement, direct infringement, willful infringement, contributory infringement, and/or active inducement of infringement, any valid claim of the '422 patent.

FIFTH DEFENSE

The claims of the '422 patent are invalid, at least because of the reasons described in NUSA's counterclaim below, NUSA's Supplemental P.R. 3-3 and 3-4 Invalidity Contentions and Disclosures, served on February 25, 2025 in this case, the petition for inter partes review of the '422 patent filed with the Patent Trial and Appeal Board ("PTAB") on June 25, 2025 by American Fuji Seal, Inc. in IPR2025-01176, and the petition for post-grant review of the '422 patent filed with PTAB on January 16, 2025 by Multi-Color Corporation in PGR2025-00025, each of which is incorporated by reference herein, for failing to comply with the conditions of patentability set forth in Title 35, United States Code §101, et seq. including but not limited to, 35 U.S.C. § 101,

102, 103, and/or 112 and the rules, regulations, and laws pertaining thereto.

SIXTH DEFENSE

Under 35 U.S.C. § 287, NUSA is not liable to B+W for any alleged damages that occurred before B+W provided actual notice of the '422 patent to NUSA.

SEVENTH DEFENSE

Under 35 U.S.C. § 154, NUSA is not liable to B+W for any alleged damages that occurred before the '422 patent issued.

EIGHTH DEFENSE

Under 35 U.S.C. § 286, NUSA is not liable to B+W for any alleged damages that occurred more than six years before the date that B+W filed its complaint in this case.

NINTH DEFENSE

B+W's attempted enforcement of the '422 patent against NUSA is barred in whole or in part by the equitable doctrines of laches, estoppel, waiver, acquiescence, and/or other equitable doctrines.

TENTH DEFENSE

B+W is precluded from asserting infringement under the doctrine of equivalents to the extent any such infringement theory would encompass or "ensnare" the prior art.

ELEVENTH DEFENSE

B+W is precluded from asserting infringement under the doctrine of equivalents to the extent any such infringement theory would vitiate any claim limitation(s) to which B+W intends to apply the doctrine of equivalents.

TWELFTH DEFENSE

B+W is precluded from asserting infringement under the doctrine of equivalents to the extent any such infringement theory would seek to recapture claim scope surrendered, abandoned, disclaimed, or disavowed during the prosecution of the application that issued as the '422 patent.

THIRTEENTH DEFENSE

B+W is precluded from asserting infringement under the doctrine of equivalents to the extent any such infringement theory would seek to reclaim or recapture any subject matter that has been disclosed but not claimed in the '422 patent.

FOURTEENTH DEFENSE

NUSA has engaged in all activities relevant to this case in good faith, thereby precluding B+W, even if it prevails, from recovering its reasonable attorneys' fees and/or costs under 35 U.S.C. § 285.

RESERVATION OF RIGHTS

NUSA reserves its right to assert any and all additional defenses which may be determined during the course of discovery.

COUNTERCLAIMS

Defendant NUSA, for its counterclaims against Plaintiff B+W, states:

THE PARTIES, JURISDICTION, AND VENUE

1. NUSA is a Delaware corporation with a principal place of business in Arlington, VA.

2. On information and belief, and as B+W alleges in its complaint, B+W is a Delaware corporation with its principal place of business at 20 Carter Dr., Guilford, CT 06437.

3. The below claims are for declaratory judgment of noninfringement and invalidity of the '422 patent under 28 U.S.C. §§ 2201 and 2202.

4. The Court has subject matter jurisdiction under 28 U.S.C. §§ 1331 and 1338(a).

5. The Court has personal jurisdiction over B+W because, among other things, B+W has asserted the '422 patent in this jurisdiction against NUSA and FSI in the complaint.

6. On this basis—and subject to and without waiving NUSA's objection that venue is improper under 28 U.S.C. § 1400(b) as to B+W's claims against NUSA—venue is proper in this judicial district under 28 U.S.C. § 1391.

7. This dispute arises out of an actual controversy between B+W and NUSA. B+W alleges in this litigation that it is the owner of the '422 patent and that NUSA infringes at least one claim of the '422 patent.

FIRST CLAIM FOR RELIEF
(Declaratory Judgment of Invalidity of the '422 patent)

8. NUSA incorporates the foregoing paragraphs by reference as though fully set forth herein.

9. The '422 patent and each of its claims are invalid under one or more of the conditions of patentability specified in 35 U.S.C. §§ 101, 102, 103, and/or 112.

10. For example, each claim of the '422 patent is invalid for at least the reasons described in NUSA's Supplemental P.R. 3-3 and 3-4 Invalidity Contentions and Disclosures, served on February 25, 2025 in this case, the petition for inter partes review of the '422 patent filed with the Patent Trial and Appeal Board ("PTAB") on June 25, 2025 by American Fuji Seal, Inc. in No. IPR2025-01176, and the petition for post-grant review of the '422 patent filed with PTAB on January 16, 2025 by Multi-Color Corporation in No. PGR2025-00025, each of which is incorporated by reference herein.

11. There is an actual, substantial, and continuing justiciable controversy between B+W and NUSA regarding the validity of each of the claims of the '422 patent.

12. B+W knows or should know that the claims of the '422 patent are invalid at least for the reasons alleged above. This is thus an exceptional case entitling NUSA to an award of its attorneys' fees under 35 U.S.C. § 285.

SECOND CLAIM FOR RELIEF
(Declaratory Judgment of Noninfringement of the '422 patent)

13. NUSA incorporates the foregoing paragraphs by reference as though fully set forth herein.

14. NUSA is not infringing and has not infringed any claims of the '422 patent as alleged by B+W and/or under any other theory of infringement, including direct infringement, indirect infringement, literal infringement, infringement under the doctrine of equivalents, joint infringement, divided infringement, and/or willful infringement.

15. For example, NUSA does not infringe any claims of the '422 patent at least because the Accused Product does not meet the limitation of "a heat shrink film comprising polyethylene terephthalate (PET) and having a first surface and a second surface opposite the first surface, the heat shrink film having a thickness of 15 µm to 100 µm," as required by each claim of the '422 patent.

16. Moreover, as alleged above, each claim of the '422 patent is invalid and therefore cannot be infringed.

17. There is an actual, substantial, and continuing justiciable controversy between B+W and NUSA regarding the alleged infringement of the '422 patent.

18. B+W knows or should know that NUSA has not and is not in any way infringing the '422 patent. This is thus an exceptional case entitling NUSA to an award of its attorneys' fees under 35 U.S.C. § 285.

PRAYER FOR RELIEF

WHEREFORE, NUSA requests a judgment:

A. Declaring that NUSA does not infringe any claims of the '422 patent;

B. Declaring that the claims of the '422 patent are invalid;

C. Declaring that NUSA is not liable in any way for the relief sought in the complaint, denying B+W all such relief, and dismissing the complaint with prejudice;

D. Declaring that this is an exceptional case under 35 U.S.C. § 285 and entering a judgment awarding NUSA its costs and attorneys' fees; and

E. Awarding such other and further relief as the Court deems equitable and just.

DEMAND FOR JURY TRIAL

Defendant NUSA demands a trial by jury for all issues so triable.

Date: September 26, 2025

/s/ John F. Bennett

Amy E. LaValle
Texas State Bar No. 24040529
FROST BROWN TODD LLP
2101 Cedar Springs Road, Suite 900
Dallas, Texas 75201
Phone: (214) 545-3472
Fax: (214) 545-3473
alavalle@fbtlaw.com

Melissa R. Smith
Texas State Bar No. 24001351
GILLAM & SMITH, LLP
303 South Washington Avenue
Marshall, Texas 75670
Phone: (903) 934-8450
Fax: (903) 934-9257
melissa@gillamsmithlaw.com

John F. Bennett
Paul J. Linden
Derek M. Freitas
FROST BROWN TODD LLP
301 East Fourth Street, Suite 3300
Cincinnati, Ohio 45202
Phone: (513) 651-6426
Fax: (513) 651-6981
jbennett@fbtlaw.com
plinden@fbtlaw.com
dfreitas@fbtlaw.com

Ava M. Bowden
FROST BROWN TODD LLP
633 W. Fifth Street, Suite 900
Los Angeles, California 90071
Phone: (213) 629-7045
Fax: (213) 229-2499
abowden@fbtlaw.com

Attorneys for Defendant
Nestlé USA, Inc.

CERTIFICATE OF SERVICE

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 the foregoing document via the Court's CM/ECF system per Local Rule CV-5(a)(3).

Date: September 26, 2025

/s/ John F. Bennett
John F. Bennett