

From: [Director Discretionary Decision](#)
To: [Linden, Paul J.](#); [Director Discretionary Decision](#)
Cc: [Trials](#); [Baker, W. Todd](#); [Dirks, Steven](#); [#BWhittle IPR KE](#); [#Brook-Nestle](#); [Visconte, Barry M.](#); [Bieber, John H.](#); [NestleFSI B+W](#); [Director DI](#)
Subject: RE: American Fuji Seal, Inc. v. Brook + Whittle, LTD; IPR2025-01176; U.S. Patent No. 11,961,422
Date: Tuesday, October 28, 2025 3:56:17 PM
Attachments: [image002.png](#)
[image003.png](#)
[image004.png](#)

Petitioner is authorized to file a corrected opposition brief on discretionary issues that comports with the 20-page limit. As noted below, Petitioner's brief shall not contain any new arguments. Petitioner's corrected brief is due by 5 pm (EST) on Thursday October 30, 2025. Patent Owner is authorized to file a one page document providing an update on the status of the concurrent district court trial by Friday, October 31, 2025. All other requests for additional briefing on discretionary issues are denied as there is not sufficient time.

The request for additional briefing for the POPR will be addressed at a later time.

From: Linden, Paul J. <plinden@fbtlaw.com>
Sent: Monday, October 27, 2025 4:01 PM
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Subject: American Fuji Seal, Inc. v. Brook + Whittle, LTD; IPR2025-01176; U.S. Patent No. 11,961,422

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Dear Director,

Counsel have met and conferred regarding disputes pertaining to the briefing of Patent Owner's discretionary denial request and Petitioner's merits challenge in the Petition and submit this joint report to the Director requesting a conference (if necessary) to discuss these disputes outlined below or a decision resolving those disputes.

The disputes are as follows:

1. Re: Petitioner's Opposition Brief in Response to Patent Owner's Discretionary Denial Request:
 - a. Patent Owner seeks to strike portions of Petitioner's opposition brief that exceed the 20-page limit.
 - b. Patent Owner also seeks leave to file a reply to Petitioner's opposition brief.

- c. Petitioner seeks leave to file an opposition brief that exceeds the 20-page limit or, in the alternative, permission to file a corrected brief of no more than 20 pages.
- d. Petitioner also seeks leave to file a surreply in response to Patent Owner's reply, if the Director permits the reply.

2. Re: Patent Owner's Preliminary Response:

- a. Petitioner seeks leave to file a reply to the POPR.
- b. Patent Owner seeks leave to file a surreply in response to Petitioner's reply, if the Director permits the reply.

The parties' respective positions are stated below:

Petitioner:

Petitioner opposes Patent Owner's request to strike portions of Petitioner's brief in opposition (Paper 7) to Patent Owner's request for discretionary denial (Paper 6). As filed, Petitioner's opposition brief is 27 pages. When filing its opposition brief, Petitioner applied the page limit that was in effect when the bifurcated discretionary denial briefing schedule was implemented, i.e., 14,000 words. That limit was changed recently for discretionary denial requests filed after September 1, 2025. Here, Patent Owner filed its request for discretionary denial on September 16, 2025 in close proximity to the rule change. Petitioner's opposition brief is 6,112 words, well within the word limit Petitioner believed applied to its opposition brief. Petitioner's filing of an overlength brief, therefore, was an inadvertent error not a strategic decision designed to provide Petitioner a tactical advantage.

Moreover, good cause exists for Petitioner to be permitted to file a brief of 27 pages. Patent Owner's discretionary denial request presents complex issues for consideration, including arguments based on multiple frameworks—including Fintiv, Advanced Bionics, and General Plastic—each of which require discussion of numerous factors to adequately respond to Patent Owner's request. As such, Petitioner requests that the Director retroactively waive the 20-page limit for Petitioner's opposition brief and allow Petitioner's opposition brief to stand as filed.

As an alternative request, Petitioner seeks leave to file an opposition brief that comports with the 20-page limit. During the meet and confer, Petitioner confirmed for Patent Owner that its proposed corrected brief, if permitted, would contain no new arguments.

Patent Owner would not be prejudiced by the Director granting either request. This is especially true if the Director permits Patent Owner leave to file a reply to Petitioner's opposition brief. Petitioner, on the other hand, would be significantly prejudiced if 7 pages (or more) of the arguments it intended for the Director to consider are stricken and thereby not considered by the Director in reaching an institution decision.

Petitioner does not oppose Patent Owner's request to file a reply to Petitioner's opposition brief.

provided Petitioner is granted leave to file surreply of equal length. During their meet and confer, counsel reached an agreement that neither party would oppose each other's request for a reply brief provided they were granted a surreply of equal length.

Good cause exists for Petitioner to be granted leave to file a reply to Patent Owner's preliminary response. Patent Owner's POPR contains claim construction arguments, arguments based on Petitioner's technical expert's deposition testimony taken in connection with the concurrent litigation, and evidence and arguments pertaining to objective indicia of non-obviousness. None of these arguments were foreseeable at the time Petitioner filed its petition in June 2025 and Petitioner would be prejudiced if not permitted to address the factual and legal bases of these arguments.

For these reasons, Petitioner respectfully requests that (i) the Director waive the 20-page limit for Petitioner's opposition brief to Patent Owner's discretionary denial request, allowing Petitioner's opposition brief to stand as filed (or, in the alternative, allow Petitioner to file a corrected brief that comports with the 20-page limit), (ii) allow Petitioner to file a surreply in response to Patent Owner's reply to Petitioner's discretionary denial opposition brief, if such a reply is permitted, and (iii) permit Petitioner leave to file a reply to Patent Owner's preliminary response.

Patent Owner:

Discretionary Denial Opposition Brief Page Limit Issue

Patent Owner Requests that the Director strike pages 21 to 27 of Petitioner's opposition brief. This is the only remedy that preserves the integrity of the process and avoids rewarding non-compliance. Patent Owner opposes Petitioner taking any alternative corrective action to address the issue for the following reasons:

1. The Patent Owner's discretionary denial brief complied with the 20-page limit. The Petitioner's request for post hoc approval to file a 27-page opposition brief should be denied because Rule 42.24(a)(2) explicitly states that a "motion to waive word counts or page limits must be granted in advance of filing a motion, opposition, or reply for which the waiver is necessary."
2. Permitting Petitioner to refile an edited opposition brief which complies with the 20-page limit would unfairly prejudice Patent Owner by affording Petitioner a "second bite at the apple." This is fundamentally unfair and contrary to the principles of orderly and efficient briefing.
3. The current bifurcated briefing schedule does not accommodate a re-filed discretionary denial opposition brief submitted more than a week after the original deadline. Allowing Petitioner to refile at this stage would disrupt the established schedule to the detriment of Patent Owner and the Director's efficient administration of the proceeding.

Good cause exists for Patent Owner to be granted leave to file a reply to Patent Owner's Discretionary Denial Opposition Brief

As noted above, counsel for both parties have agreed that neither side will oppose the other's request to file a reply brief, provided that each is granted a surreply of equal length. To the extent the Director would benefit from understanding the basis for Patent Owner's request, Patent Owner submits that good cause exists to file a reply in order to update the Director on the status of the concurrent district court trial and to correct certain statements in Fuji's opposition brief regarding the extent of discovery completed to date in relation to the overall district court schedule.

Respectfully submitted,

Paul Linden
Attorney at Law



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