

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN FUJI SEAL, INC.,
Petitioner

v.

BROOK & WHITTLE LIMITED
Patent Owner

IPR2025-01176
Patent No. 11,961,422

**PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION TO
REQUEST FOR DISCRETIONARY DENIAL**

LISTING OF EXHIBITS

EX	DESCRIPTION
2001	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, Dkt. 1 (Complaint)
2002	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, Dkt. 46 (Fuji Reply to Motion to Dismiss)
2003	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, FSI Resp. to Plaintiff's Interrogatories
2004	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, Dkt. 50 (Defendants' Unopposed Motion for Leave to Supplement Invalidity Contentions Under P.R. 3-6(b))
2005	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, Dkt. 51 (Order granting D.I. 50)
2006	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, Docket Report, generated Sept. 4, 2025
2007	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, Dkt. 16 (Docket Control Order)
2008	<i>American Fuji Seal, Inc. v. Brook + Whittle LTD</i> , 1:24-cv-01215-MN, D.I. 24 (Order granting motion to stay)
2009	<i>American Fuji Seal, Inc. v. Brook + Whittle LTD</i> , 1:24-cv-01215-MN, D.I. 13 (Motion to dismiss)
2010	E.D. Tex. Median Time to Trial Statistics
2011	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, Dkt. 80 (Report and Recommendation recommending denying motion to dismiss for improper venue)
2012	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, Dkt. 87 (Order adopting Report and Recommendation and denying motion to dismiss)
2013	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, Invalidity Contentions
2014	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, Dkt. 61
2015	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, Dkt. 62
2016	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, Dkt. 64
2017	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, Dkt. 71

2018	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, Dkt. 72
2019	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, Dkt. 83 (Joint claim construction and prehearing statement).
2020	Stipulation of American Fuji Seal, Inc.
2021	Stipulation of Nestle USA, Inc.
2022	Stipulation of Fuji Seal International, Inc.
2023	Deposition Transcript of Dr. Robson F. Storey, <i>Brook + Whittle LTD v. Nestle' USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP (September 16, 2025, rough).
2024	U.S. Patent Application Publication 2017/0223879 ("Mitchell")
2025	Evaluation of the Near Infrared (NIR) Sorting Potential of a Whole Plastic Article (SORT-B-01)
2026	Evaluation of Sorting Potential for Plastic Articles Utilizing Metal, Metalized or Metallic Printed Components (SORTB- 03)
2027	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, Dkt. 93 (B+W Opening Claim Construction Brief)
2028	Declaration of Andy Sharp
2029	PACKAGING EUROPE, <i>Winners of the Sustainability Awards 2024 Announced!</i> , (Nov. 14, 2024).
2030	PACKAGING EUROPE, <i>Sustainability Awards 2024 Finalist Interview: Brook+Whittle's Recyclable, Light-Blocking Shrink Sleeve</i> , (Sept. 24, 2024).
2031	<i>AWA Sleeve Label Awards 2024 - Winners</i> (October 28, 2024)
2032	US Plastics Pact 2023 LinkedIn Post
2033	US Plastics Pact 2024 LinkedIn Post
2034	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, Dkt. 44 (B+W's Opposition to Motion to Dismiss)
2035	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, Dkt. 91 (Nestle Answer to Complaint)
2036	https://packagingeurope.com/shrink-sleeve-labelling-how-fuji-seal-is-engineering-the-future-of-circularity/13433.article
2037	https://www.linkedin.com/posts/association-of-plastic-recyclers_we-are-proud-to-celebrate-a-major-milestone-activity-7371184359241932800-y0Lp
2038	Email from A. Leonard (Nestle) to S. Figueroa (B+W)
2039	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, Docket Report, generated October 30, 2025

2040	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, Dkt. 17 (Discovery Order).
2041	Motion Metrics for Judge Gilstrap

Each of the discretionary factors strongly favors denial and Petitioner's misleading statements about EDTX do not change the outcome. PO corrects these statements and updates the Director on additional efforts undertaken in EDTX.

Petitioner's statement that "little progress has been made" in EDTX is wrong. Paper 9 at 16. Markman briefing and depositions are complete, and the hearing is set for Nov. 24. EX2039. Fact discovery closes in under two months, the substantial production completion deadline has passed, with over 200,000 documents produced, and the parties are scheduling up to 300 hours of depositions to take place in the next two months. EX2040 at 4. Expert reports are in progress and due December 22. EX2007. Trial is set to begin in less than seven months. EX2007.

Petitioner's attempts to question the likelihood of trial are equally unavailing. The "customer-suit exception" motion "pending" (Paper 9 at 16) seeks to ignore the first-to-file rule in favor of the later action in Delaware, *which that court already rejected*. EX2008; EX1018. And, Petitioner's "intend[ed]" motion to stay pending post-grant proceedings" is, contrary to the out-of-district citation, far from "compelling" (Paper 9 at 15) where Judge Gilstrap has a grant rate of less than 30% and less than 10% when opposed. EX2041. Nor do Petitioner's outdated statistics (EX1021) mean that the EDTX trial date is likely to slip to August 2026. Paper 9 at 16. Besides, even if correct, trial would still occur prior to the anticipated FWD.

Accordingly, the Director should exercise his discretion and deny the Petition.

Dated: October 31, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Patent Owner's Reply to Petitioner's Opposition to Request for Discretionary Denial was served on October 31, 2025, via electronic mail directed to counsel of record for the Petitioner:

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