

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN FUJI SEAL, INC.,

Petitioner,

v.

BROOK + WHITTLE LTD.,

Patent Owner.

Case No.: IPR2025-01176

U.S. Patent No. 11,961,422

**PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

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PETITIONER'S EXHIBIT LIST

NO.	DESCRIPTION	REFERRED TO AS
1001	U.S. Patent No. 11,961,422	'422 Patent or Challenged Patent
1002	File History for '422 Patent (Part I)	'422 Patent File History
1003	File History for '422 Patent (Part II)	'422 Patent File History
1004	Declaration of Dr. Robson F. Storey, Ph.D.	Storey Decl. or EX-1004
1005	CV of Dr. Robson F. Storey, Ph.D.	Storey CV or EX-1005
1006	US 11,358,363 B2	Schurr or EX-1006
1007	JP 2017-114041 A	Kitano or EX-1007
1008	JP 2004-250040 A	Ohta or EX-1008
1009	U.S. Pat. Pub. No. 2016/0361939	Keulders or EX-1009
1010	U.S. Pat. Pub. No. 2022/0389214	Lee or EX-1010
1011	Tamma, Paola; Schaart, Eline; Gurzu, Anca (11 December 2019). "Europe's Green Deal plan unveiled". <i>POLITICO</i> .	Tamma or EX-1011
1012	Schyns, Zoé OG, and Michael P. Shaver. "Mechanical recycling of packaging plastics: a review." <i>Macromolecular rapid communications</i> 42.3 (2021): 2000415.	Schyns or EX-1012
1013	Ügdüler, Sibel, et al. "Towards closed-loop recycling of multilayer and coloured PET plastic waste by alkaline hydrolysis." <i>Green chemistry</i> 22.16 (2020): 5376-5394	Ügdüler or EX-1013

NO.	DESCRIPTION	REFERRED TO AS
1014	Limbo, Sara, et al. "Storage of pasteurized milk in clear PET bottles combined with light exposure on a retail display case: A possible strategy to define the shelf life and support a recyclable packaging." <i>Food chemistry</i> 329 (2020): 127116.	Limbo or EX-1014
1015	JP 2017-114041A	Japanese Version Kitano
1016	JP 2004-250040 A	Japanese Version Ohta
1017	<i>Brook + Whittle LTD v. Nestlé USA, Inc., et al.</i> , Case No. 2:24-cv-735 (E.D. Tex.), Dkt. 35 (Fuji Seal International, Inc.'s Motion to Dismiss)	-
1018	<i>Brook + Whittle LTD v. Nestlé USA, Inc., et al.</i> , Case No. 2:24-cv-735 (E.D. Tex.), Dkt. 63 (Fuji Seal International, Inc. and Nestlé USA, Inc.'s Motion to Stay)	-
1019	<i>Brook + Whittle LTD v. Nestlé USA, Inc., et al.</i> , Case No. 2:24-cv-735 (E.D. Tex.) (Compilation of Deposition Notices)	-
1020	Judge Gilstrap's Current Docket	-
1021	District Courts' Time to Trial Statistics	-
1022	<i>Brook + Whittle LTD v. Nestlé USA, Inc., et al.</i> , Case No. 2:24-cv-735 (E.D. Tex.), 10/07/25 Dkt. Entry (Resetting Claim Construction Hearing)	-

In Patent Owner's ("PO") Preliminary Response, PO fails to rebut Petitioner's compelling showing of unpatentability, instead choosing to assert diversionary claim construction arguments, distort Petitioner's expert's testimony, and offer legally insufficient evidence of secondary considerations.

I. THE CLAIMS ARE OBVIOUS UNDER ANY PROPOSED CONSTRUCTION¹

PO's focus on claim construction is a diversionary tactic that fails to create a genuine issue for institution. The challenged claims are obvious under any construction of "recyclable" yet proposed, rendering the dispute moot at this stage. Additional claim construction arguments may be addressed following institution. *See Motorola Mobility LLC v. Multifold Int'l, Inc. PTE, Ltd*, IPR2025-00041, Paper 7, at 10 (PTAB May 21, 2025).

First, both grounds offered in the Petition satisfy PO's proposed construction requiring a label that is recyclable "without removing" it from the container. The Kitano/Lee combination is invalidating because Lee discloses a label that "can be reused ***while attached*** to a PET container." (EX-1004, ¶ 215 (quoting EX-1010, [0010].) And a POSITA would understand that Schurr, with its layered design, could be processed ***with*** the container, where its pigmented layers are managed during the caustic wash, not separated beforehand. (*Id.*, ¶¶ 111-14.)

¹ Neither the Court nor Board has formally construed "recyclable" to date.

The same is true under the Board's preliminary construction from the co-pending PGR, which focuses on not removing the label and preventing contamination of the PET recycling stream. Lee is the embodiment of this standard, as it is expressly engineered to *avoid* fusion and contamination during co-recycling. (*Id.*, ¶ 215.) Likewise, Schurr's design, which confines pigments to distinct layers rather than embedding them in the film, is specifically designed to *prevent* contamination of the rPET flake during processing. (*Id.*, ¶¶ 113-14.)

Finally, both grounds satisfy Petitioner's proposed construction, as a POSITA would understand both Schurr and the Kitano/Lee combination to teach a label that could enter the recycling stream simultaneously with the container. (*Id.*, ¶¶ 111-14, 215.) Because the challenged claims are obvious under any construction of "recyclable" proposed to date, the Board need not resolve this merits-based dispute to institute review.

II. PO'S EVIDENTIARY ARGUMENTS ARE FATALY FLAWED

PO's attempts to discredit Petitioner's evidence and to bolster its own case are based on distortions of the record and legally incompetent proof. First, contrary to PO's claim that Dr. Storey "abandoned" his opinion on Lee, he did no such thing. Rather, Dr. Storey correctly distinguished between what Lee *discloses* (the relevant legal question here for obviousness) and whether an industry group might *permit* or *acknowledge* its use (a legally distinct issue). The record is undeniable: Dr. Storey

expressly confirmed that Lee teaches a label recyclable with a PET container even though some may disagree with Lee's teaching. (EX-2023, at 172:5-173:20.) Likewise, PO's claim that Dr. Storey's motivation analysis is unsupported is directly contradicted by his testimony confirming a POSITA's awareness of the dual market needs for light-shielding and recyclability. (*Id.*, 108:6-109:9.) PO's omission of Dr. Storey's full testimony for both issues is telling.

Finally, PO's secondary consideration arguments are legally irrelevant. The law requires a nexus between any purported commercial success or praise and the *merits of the claimed invention*. See *Google LLC v. Zipit Wireless, Inc.*, IPR2019-01568, Paper 39, at 24 (PTAB March 9, 2021). PO touts sales and awards for its "GreenLabel BlockOut" product but offers *zero evidence* that its product actually embodies the challenged claims. Without proof that the product is coextensive with the claims, any alleged success or praise is meaningless for the non-obviousness inquiry. See *id.* And Petitioner had no obligation to rebut this legally deficient evidence in its Petition. See *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 33, at 31-35 (PTAB Jan. 24, 2020).

III. CONCLUSION

The Petition presents a compelling case of unpatentability based on prior art and arguments the Examiner never considered. PO fails to identify any genuine deficiency in the Petition. The Director should therefore institute IPR.

Dated: November 10, 2025

Respectfully submitted,

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