

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 PRELIMINARY RESPONSE SUR-REPLY

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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)

Petitioner's reply envisions an alternate reality but fails to address the fatal deficiencies identified in the POPR. The Board should deny institution.

I. PETITIONER FAILS UNDER ANY PROPOSED CONSTRUCTION

The Board need not resolve any claim construction disputes to deny institution because Petitioner's arguments fail under any proposed construction. Petitioner glosses over its selection and application of art that explicitly teach away from light blocking shrink labels recyclable with a container. Schurr and Kitano expressly teach separating label from container. *See* EX1006, 15:40-60 (Schurr discloses a label that is "*separated* from the material *of the transparent object*...so that the transparent material *of the object* can be used again"); EX1007, [0009] (Kitano's "shrink film *that is separable from the container* has excellent environmental advantages"). Lee expressly refers to a clear label and says nothing about the recyclability of a light blocking label. EX1010, [0010]. Even then, Petitioner's expert disclaimed any opinion about Lee's recyclability with the container. EX2023, 174:3-8.

Petitioner asserts that "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." Paper 11, 2 (citing EX1004 ¶111-14). But, the relevant question is whether a POSITA *would* do (not what *could* be done), *InTouch Techs., Inc. v. VGO Commc'ns, Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014) (reversing obviousness determination because expert opinion only showed what a POSITA

“*could*” do, not what they “*would* have been motivated to do”), and a POSITA would not have been motivated to modify Schurr and Kitano when both teach away. EX1006, 15:40-60; EX1007, [0009]. Moreover, Petitioner’s argument that Schurr’s layered design makes it recyclable has already been rejected. EX1003 at 88, 121 (overcoming Mitchell, which discloses “multilayer shrinkable film”). In any event, the ability to *enter* the recycling stream says nothing of its ability to be *recycled with the container*, especially where, as here, the prior art explicitly praises removal of the label. EX1006, 15:40-60; EX1007, [0009]; EX1003 at 88 (“removing the label before or during the recycling process is not evidence of the recyclability”).

II. DR. STOREY’S OPINIONS SHOULD BE GIVEN LITTLE WEIGHT

Petitioner seeks to rewrite history with its unsupported, post-hoc explanation for Dr. Storey’s explicit deposition testimony. According to Petitioner, rather than recanting his opinion that Lee’s label is recyclable with a container, Dr. Storey merely distinguished “what Lee discloses” and “whether an industry group might permit or acknowledge its use.” Paper 11, 2. But, when expressly asked about *his own opinion*, Dr. Storey affirmed that he had none. *See* EX2023, 174:3-8 (“Q. So *you have no opinion* on whether Lee’s disclosed heat shrinkable label can be processed within a standard PET recycling stream. Is that right? A. *That’s correct.*”). Petitioner wrongly asserts that Dr. Storey’s deposition testimony supports his motivation analysis. Paper 11, 3. Even if Dr. Storey could recall his opinion without

help (EX2023, 107:22-108:4), Petitioner ignores that Dr. Storey cites no evidence of *how* a POSITA would modify or have a reasonable expectation of success.

III. PO'S SECONDARY CONSIDERATIONS EVIDENCE IS PROPERLY TIED TO PATENTED FEATURES AND STANDS UNREBUTTED

Petitioner asserts PO failed to show a “nexus” between secondary considerations evidence and the “merits of the claimed invention.” Paper 11, 3. Not true. PO's labels have received industry praise precisely for the “unique characteristic[s]” at the heart of the '422 Patent. *Compare* EX2029-2030 (sustainability award for recyclable light blocking shrink label that blocks up to 99% of light); EX2031-2033 (similar), *with* EX1001, cl. 1 (claiming “heat shrink film,” “light blocking layer...to block 80% of incident light,” “recyclable with a PET container”). *Google LLC v. Zipit Wireless, Inc.*, a case cited by Petitioner, confirms proper nexus where industry praise is the “direct result of the unique characteristics of the claimed invention.” IPR2019-01568, Paper 39, at 25 (PTAB 2021). Petitioner cites no authority to the contrary. *See id.*, 33 (PO failed to show “evidence of praise was a result of unique characteristics of the claimed invention.”); *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 33, at 31-35 (P.T.A.B. 2020) (industry praise awarded for an entirely different “critical feature”). Petitioner's inability to rebut PO's secondary considerations evidence is telling and dooms the Petition.

IV. CONCLUSION

Petitioner's arguments fail at every turn. The Board should deny institution.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Patent Owner's Sur-Reply was served on the 14th day of November, 2025, via electronic mail directed to counsel of record for the Petitioners:

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