

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MULTI-COLOR CORPORATION,
Petitioner,

v.

BROOK & WHITTLE LIMITED,
Patent Owner.

Case PGR2025-00025
U.S. Patent No. 11,961,422

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

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Patent Owner’s Preliminary Response argues for denial of institution based on a construction of the term “recyclable” purportedly supported by prosecution history disclaimer. This Reply, Ordered by Paper 11, demonstrates that Patent Owner’s construction is not supported by prosecution history disclaimer, and is independently legally erroneous.

I. PATENT OWNER’S CONSTRUCTION OF RECYCLABLE IS NOT SUPPORTED BY DISCLAIMER AND IS LEGALLY ERRONEOUS

A. The Exacting Law Governing Prosecution History Disclaimer

“The standards for finding...disavowal are exacting.” *Hill-Rom v. Stryker*, 755 F.3d 1367, 1371 (Fed. Cir. 2014). “To disavow claim scope, the specification must contain ‘expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope.’” *Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 653 F.3d 1296, 1306 (Fed. Cir. 2011) (quoting *Epistar Corp. v. Int’l Trade Comm’n*, 556 F.3d 1321, 1335 (Fed. Cir. 2009)).

B. Patent Owner Misapplied The Law Governing Prosecution History Disclaimer

Patent Owner argues that prosecution history disclaimer applies to the claim term “recyclable,” based upon Applicant’s attempt to distinguish over the Mitchell reference. *See* Paper 8, pp. 11-14. According to Patent Owner, Applicant argued that Mitchell requires “removing the label before or during the recycling process,” and added claim language, *i.e.*, “wherein the recyclable shrink label is recyclable

with a PET container,” to distinguish over Mitchell. Paper 8, at 13-14. Patent Owner further argues “Applicant unmistakably disavowed any claim scope of ‘recyclable’ that requires ‘removing the label before or during the recycling process.’” Paper 8, at 13. Against this backdrop, Patent Owner suggests that “recyclable” should be construed to mean “capable of being recycled without removing the label from a container before or during the recycling process.” Patent Owner is not correct.

First, Patent Owner’s proposed construction does not provide any guidance regarding what constitutes a “recyclable” label. Rather than offering a positive construction of what constitutes a “recyclable” label, Patent Owner merely asserts what the term “recyclable” does not mean, namely, that removing the label does not make it “recyclable.” Indeed, Patent Owner notes that Applicant argued over Mitchell that “removing the label before or during the recycling process is not evidence of the recyclability of the label.” Paper 8, at 13. This negative framing fails to provide any meaningful criteria for determining what constitutes a “recyclable” label, and thus fails to resolve the underlying indefiniteness of the term “recyclable.”

Second, Patent Owner’s proposed construction ignores statements in the prosecution history , where Applicant provided additional reasoning as to why Mitchell fails to disclose a “recyclable” label. Specifically, Applicant argued that

Mitchell did not disclose a “recyclable” label because that requires that the ink be removed by caustic wash and not contaminate or discolor PET flake. Tellingly, Applicant argued that even if the Mitchell label was not removed (and was therefore subjected to the recycling process), it would not meet the “recyclable” requirement:

An important consideration for inks on shrink sleeve labels is that the ink not contaminate or discolor PET flake when mixed in hot caustic wash water used in the recycling process. If the ink separates from the label film in the wash step, it is desirable that the ink be readily filtered from the PET flake as well as the wash water. If the sleeve label floats, it is desirable that the ink remain adhered to the floating label, and that the ink density not cause a floating label to sink.

Ex. 1002, at 337.

According to Applicant, “[e]ven if the label in Mitchell ‘879 was otherwise capable of being recycled, the pigments being incorporated into the core layer would contaminate the polymer flake during the recycling process.” *Id.*

Thus, Applicant additionally argued that a label is not “recyclable” simply because it is not removed and allowed into the recycling process. Rather, “the present application teaches that the inks and pigments used in the recyclable shrink label may be removed by washing, leaving behind a label that can be recycled with the article.” Ex. 1002, at 337. An important consideration for determining if a label is “recyclable” is whether the ink contaminates or discolors PET flake. *Id.* These additional statements made by Applicant during prosecution make clear that,

according to Applicant, the term “recyclable” involves more than whether a label is “capable of being recycled without removing the label from a container before or during the recycling process.” These additional statements by Applicant underscore the fact that Patent Owner’s proposed construction, which seeks to narrowly construe the term “recyclable,” is not reflective of the prosecution history and is incomplete.

Third, Patent Owner’s proposed construction of “recyclable” includes the phrase “capable of being recycled,” which is circular at best, and is wrong. *See, e.g., Univ. of Fla. Rsch. Found. v. Motorola Mobility, LLC*, 3 F. Supp. 3d 1374, 1377 (S.D. Fla. 2014) (citing *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1090 (Fed. Cir. 2003) (finding the use of "wireless" to define "wireless" was "circular and unhelpful" and "constitute[d] improper claim construction.")); *Lecat’s Ventriloscope v. MT Tool*, 283 F. Supp. 3d 702, 712 (N.D. Ill. 2018); *Ravin Crossbows, LLC v. Hunter’s Mfg.*, No. 5:23-cv-598, 2024 U.S. Dist. LEXIS 35842, *9 (N.D. Ohio Mar. 1, 2024).

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on July 31, 2025, a complete and entire copy of Petitioner's Reply to Patent Owner's Preliminary Response was provided via email to the Patent Owner by serving the email correspondence addresses of record as follows:

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