

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MULTI-COLOR CORPORATION
Petitioner

v.

BROOK & WHITTLE LIMITED
Patent Owner

PGR2025-00025
Patent No. 11,961,422

PATENT OWNER'S SUR-REPLY

Despite Petitioner’s posturing, there is no genuine dispute that Patent Owner’s claim scope disavowal during prosecution was both permissible and effective in limiting the scope of the claimed invention, thereby eliminating any ambiguity of the scope of the claim term “recyclable.” Rather, Petitioner’s Reply demonstrates a fundamental misunderstanding of the doctrine of patent prosecution and its role in limiting the scope of a claim. As made clear in its Preliminary Response, Patent Owner unmistakably disavowed any claim scope of “recyclable” that requires removing the label before or during the recycling process.

First, Patent Owner does not dispute that the standard for disavowal is “exacting.” Petitioner’s Reply (“Reply”) at 1. Yet Petitioner’s reading of the case law would eviscerate the standard if, in this instance, Patent Owner’s clear and unmistakable disclaimer of scope was not sufficient to show disavowal. *Traxcell Techs., LLC v. Nokia Sols. & Networks Oy* is particularly instructive. 15 F.4th 1136, 1141 (Fed. Cir. 2021). The district court construed “location” to mean “location that is not merely a position in a grid pattern,” and “[i]t did so mainly in view of arguments that the applicant made during prosecution.” *Id.* at 1141. The Federal Circuit agreed with the district court’s construction, finding that “the disclaimer here was clear and unmistakable” where the Applicant “distinguished the claims from prior art that used a position in a grid pattern as the location.” *Id.* at 1141-42.

Similarly, during the prosecution of the '422 Patent, Applicant made clear that “[t]he term ‘recyclable’ does further limit the claim in that the claimed label **must be capable of being recycled**,” EX1002 at 335 (emphasis in original), and explained “[i]t should also be noted that *removing the label before or during the recycling process is not evidence of the recyclability* of the label.”¹ *Id.* With these remarks, Applicant amended its claims to add the language “wherein the recyclable shrink label is recyclable with a PET container” to the pending independent claims. *Id.* at 316. As such, there is no ambiguity that Patent Owner’s use of the word “recyclable” required the claimed label to be capable of being recycled without removing the label from the container before or during a recycling process.

Second, Petitioner asserts—without citing any supporting case law—that Patent Owner’s construction is wrong because it is not a “positive construction.” Reply at 2. However, Petitioner’s position borders on non-sensical. The very *purpose* of disavowal in claim construction is to clarify what the scope of a term *does not include*. Indeed, case law cited elsewhere by Petitioner makes this clear: “[d]isavowal requires that the specification or prosecution history make clear that the invention *does not include a particular feature* ... or is clearly limited to a particular form of the invention” *Hill-Rom Servs., Inc. v. Stryker Corp.*, 755 F.3d

¹ Emphasis added unless stated otherwise.

1367, 1372 (Fed. Cir. 2014) (internal quotation marks omitted) (cleaned up); *see also Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 653 F.3d 1296, 1306 (Fed. Cir. 2011) (“[t]o disavow claim scope, the specification must contain expressions of ***manifest exclusion or restriction***, representing a clear disavowal of claim scope.”) (internal quotation marks omitted). Unsurprisingly, courts have found disavowal through a limiting construction. *See, e.g., Traxcell Techs.*, 15 F.4th at 1141-42 (limiting term with exclusion in construction after finding disavowal in the prosecution history); *Verizon Servs. Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1306 (Fed. Cir. 2007) (same); *Bd. of Regents of the Univ. of Tex. Sys. v. BENQ Am. Corp.*, 533 F.3d 1362, 1370 (Fed. Cir. 2008) (same).

Third, there is no issue that Patent Owner’s construction of “recyclable” including the phrase “capable of being recycled” is circular. The purpose of a disavowing construction is to ***limit*** the scope of an invention, not ***re-define or clarify*** the invention through construction. As such, courts have adopted constructions which include the term being construed. *See, e.g., Mannatech, Inc. v. Techmedia Health, Inc.*, No. CIV.A.3:06-CV-00813-P, 2009 WL 3614359, at *15 (N.D. Tex. Oct. 29, 2009) (rejecting an argument that a construction is “circular” when the adopted construction is based on an express definition in the specification); *Traxcell Techs.*, 15 F.4th at 1141-42 (upholding construction of “location” using the word “location” with additional limitations). ***None*** of the cases cited by Petitioner involve

a disclaimer or disavowal provided in the specification or prosecution history. Reply at 4 (citing *Univ. of Fla. Rsch. Found. v. Motorola Mobility, LLC*, 3 F. Supp. 3d 1374 (S.D. Fla. 2014); *Lecat’s Ventriloscope v. MT Tool*, 283 F. Supp. 3d 702 (N.D. Ill. 2018); *Ravin Crossbows, LLC v. Hunter’s Mfg.*, 2024 U.S. Dist. LEXIS 35842, *9 (N.D. Ohio 2024)).

Fourth, Petitioner suggests because Applicant distinguished Mitchell on multiple grounds, Patent Owner’s construction “is not reflective of the prosecution history and is incomplete.” Reply at 4. Yet Patent Owner’s construction is not that “recyclable” means “not removed (and was therefore subjected to the recycling process)” as Petitioner’s argument requires, *id.* at 3, but a construction that seeks to limit the invention as “**capable of being recycled** without removing the label from a container before or during the recycling process.” Applicant specifically distinguished prior art “[l]abels made of other materials, including polypropylene, polyethylene, and paper,” which “are considered contaminants in a PET recycling stream and **need to be removed** for the PET container to be recycled.” EX1002 at 336. An improvement of the claimed invention is that the label was capable of being recycled with the container, therefore eliminating the requirement for removal before or during the recycling process. As such, Patent Owner does not, nor needs to, take a position on every requirement or possibility for a label to be recyclable. Instead, Patent Owner takes the position that, based on its disavowal, recyclability

requires a label that need not be removed from the container before or during the recycling process to practice its claimed invention. Whether or not other properties are required to render a label “recyclable” is irrelevant.

Even if other properties were relevant to POSA’s understanding of recyclability, the other references in Petitioner’s Reply provide characteristics that are “an important consideration,” “desirable,” and “may” exist, none of which rise to the “exacting” standard Petitioner agrees applies. Reply at 3. Indeed, a Patent Owner may disclaim scope with regard to *one characteristic* without disclaiming *as to others*. See, e.g., *Genuine Enabling Tech. LLC v. Nintendo Co.*, 29 F.4th 1365, 1371 (Fed. Cir. 2022) (finding patent owner’s construction of “input signal” as “a signal having an audio or higher frequency” correct based on prosecution history disclaimer and overturning district court adopting of accused infringer’s construction “signals above 500 Hz and excluding signals generated from positional change information, user selection information, physiological response information, and other slow-varying information,” as too narrow and excluding subject matter not disclaimed).

Ultimately, although Patent Owner agrees the standard is “exacting,” Petitioner’s Reply ignores the clear and unambiguous disavowal of claim scope presented in the Applicant’s statements during the prosecution of the ’422 Patent. Accordingly, the PTAB should adopt Patent Owner’s construction.

Dated: August 7, 2025

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 7th day of August, 2025, via electronic mail directed to counsel of record for the Petitioners:

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