

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 OPPOSITION TO
PETITIONER'S MOTION TO SUBMIT SUPPLEMENTAL
INFORMATION**

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I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.64(b)(1), Patent Owner (PO) respectfully requests denial of Petitioners' motion and exclusion of EX1027-1032.

II. BACKGROUND

Petitioner Multi-Color Corporation filed a petition for post-grant review on January 16, 2025. Paper 2. After preliminary briefing, the Board instituted post-grant review on September 19, 2025. Paper 14. Patent Owner filed timely objections to evidence on October 3, 2025. Paper 16. In response, Petitioner moved to submit supplemental information on October 24, 2025. Paper 17. Petitioner seeks to add six new exhibits—Exhibits 1027-1032. *Id.* Patent Owner opposes.

III. PETITIONER'S MOTION SHOULD BE DENIED

A. Exhibits 1027-1032 Could Have Been Included with the Petition

Petitioner's motion to submit "supplemental" information suffers from a fatal flaw. Despite that Petitioner and its experts rely on the documents to show the knowledge of a POSITA and attempt to meet its burden to show that the '422 Patent claims are allegedly anticipated or rendered obvious, Petitioner failed to put forth correct, properly dated, or complete evidence with that Petition. Now, Petitioner transparently attempts to correct these glaring issues under the guise of submitting "supplemental information" despite that each exhibit is either publicly available or entirely within its own possession. Accordingly, there is no excuse for Petitioner's

failure to include these exhibits with its initial petition and the exhibits should be excluded. *Redline Detection, LLC v. Start Envirotech, Inc.*, 811 F.3d 435, 444-45, 448 (Fed. Cir. 2015) (§ 42.123 “does not offer ‘a routine avenue for bolstering deficiencies in a petition raised by a [PO] in a Preliminary Response.’”).

Exhibits 1027-1030 each seek to correct Petitioner’s initial inclusion of documents that post-date the ’422 Patent priority date by providing earlier versions. *See* Mot. at 2-3 (mapping “supplemental” exhibits to previously filed exhibits and indicating operative date prior to priority date). With the possible exception of EX1028, discussed below, Petitioner does not, and indeed cannot, show that these versions were not available to it when it filed the Petition. Nor can Petitioner feign confusion about the priority date of the ’422 Patent, as it described the priority date in the Petition. Pet. 13-14.

Moreover, Petitioner and its expert rely on these exhibits to show the knowledge of a POSITA and attempt to meet its burden to show that the ’422 claims are allegedly anticipated and/or rendered obvious. *See, e.g.*, Ex. 1013 at 4-5 (Bushman citing EX1005-1008, 1012); Ex. 1014 at 4-5 (same for Deible). Despite that Petitioner’s experts stated that they were asked to “consider these materials through the lens of a person of ordinary skill,” Petitioner still failed to cite or attach the pre-priority versions of these documents. It cannot now introduce versions it (1)

did not rely on, and (2) did not supply until after Patent Owner identified the weaknesses of the original exhibits. *See Redline*, 811 F.3d at 448.

B. The Supplemental Evidence is Materially Different from the Evidence Relied Upon in the Petition

Furthermore, at least some of the new exhibits appear to contain material differences compared with their as-filed counterparts. For example, EX1027 (purportedly the pre-priority version of EX1005) contains vastly different information than EX1005, which has a material effect on how a POSITA would have understood the state of recyclability at the priority date of the '422 Patent. For example, EX1027 contains several carve-outs for products that do or do not qualify for the testing described in the guidance document that do not appear in the as-filed version. *Compare* EX1027 at 5, *with* Ex. 1005 at 5.

For Exhibits 1031 (test methods) and 1032 (Deible's supplemental declaration), Petitioner provides entirely new information not previously included with the Petition and which was solely in Petitioner's control long before it filed its Petition. *See, e.g.*, Ex. 1012 at 5 (report authored by Multi-Color Corporation and documenting Craig Bushman's revisions); Ex. 1032 ¶¶ 4-6 (correcting labeling mistakes). Petitioner's corrections to Dr. Deible's declaration relabel multiple test results, which previously implied the results were obtained from a **Febreze** label, and now purportedly show results obtained from a **Gatorade** label. *Id.* Thus, EX1032 effectively creates a new declaration and should be excluded. *See Am. Well Corp. v.*

Teladoc Health, Inc., IPR2021-00748, Paper 23 at 13 (Feb. 28, 2022) (denying motion that “effectively changes the evidence originally relied upon”).

And Petitioner’s supplemental evidence, particularly Dr. Deible’s supplemental declaration, appears to directly respond to failure of proof issues that Patent Owner identified in its POPR. *Compare, e.g.*, Paper 8 at 19 with Ex. 1032 ¶¶ 3-6. *See W. Digit. Corp. v. Spex Techs., Inc.*, IPR2018-00082, Paper 22 at 10 (July 23, 2018) (Board may consider whether supplemental information presents new argument not presented in the petition). Petitioner characterizes the supplemental declaration as mere “clarifications” and claims that it “do[es] not seek to rely upon new prior art or uncited portions of the same prior art.” Paper 17 at 5. But Petitioner’s post-hoc attempt to bolster its Petition is precisely the wait-and-see approach this Board disfavors and is an independent reason to deny Petitioner’s motion. *Redline*, 811 F.3d at 448; *Am. Well Corp.*, IPR2021-00748, Paper 23 at 6-7 (collecting cases).

C. Exhibit 1028 Has Not Been Supplied to Patent Owner

Petitioner’s motion further identifies EX1028, a pre-priority date version of EX1006, titled PET Standard Laboratory Processing Practices. Petitioner indicates that it “is actively working to obtain a copy...and will promptly provide the document to the Board and Patent Owner as soon as it is obtained.” Mot. at 1-2. Yet as of this opposition, that document has not been provided to Patent Owner and

Petitioner's open-ended promise to eventually obtain and provide the pre-priority date version at some later time unduly prejudices PO and should be denied.

For example, the pre-priority version of this document is necessary for Patent Owner to determine whether the protocols described were materially different from those described in Exhibit 1006, and to enable Patent Owner to conform its own testing to the relevant protocols and adequately prepare for the imminent deposition of Petitioner's experts. Indeed, the revision history contained in EX1006 suggests material changes since September 17, 2019. EX1006 at 27. Petitioner's failure to include this information with the Petition offends basic notions of due process and fairness and the supplemental information should be excluded. *See Royal Brush Mfg. v. United States*, 75 F.4th 1250, 1257-58 (Fed. Cir. 2023) (“[T]he law is clear that, in adjudicative administrative proceedings, due process ‘includes the right to know what evidence is being used against one.’”).

Moreover, the fact that Petitioner does not even have EX1028 yet obscures how it plans to rely on it. Thus, it promotes neither a just nor speedy resolution of the proceeding to allow its inclusion later. *See Duration Media LLC v. Rich Media Club LLC*, IPR2023-00953, Paper 21 (PTAB Oct. 12, 2023).

IV. CONCLUSION

PO respectfully requests the Board deny Petitioner's motion.

Dated: October 29, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing document, including any exhibits filed therewith, was served on the 29th day of October, 2025, via electronic mail directed to counsel of record for the Petitioners:

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