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Paper 23
Date: November 24, 2025

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 11,961,422 B2

Before KIMBERLY McGRAW and SHELDON M. McGEE, *Administrative Patent Judges*.

McGRAW, *Administrative Patent Judge*.

ORDER
Granting Petition's Motion to Submit Supplemental Information
37 C.F.R. § 42.223(a)

Petitioner filed an authorized Motion to Submit Supplemental Information, seeking to enter Exhibits 1027–1032 into the record under 37 C.F.R. § 42.223. Paper 17 ("Mot."). Patent Owner filed an Opposition. Paper 18 ("PO Opp."). For the reasons set forth below, we grant Petitioner's motion.

I. ANALYSIS

Under 37 C.F.R § 42.223(a), a party may file a motion to submit supplemental information if:

> (1) A request for the authorization to file a motion to submit supplemental information is made within one month of the date the trial is instituted.
>
> (2) The supplemental information must be relevant to a claim for which the trial has been instituted.

Petitioner has complied with these requirements. The request was filed within the one-month deadline and the exhibits are relevant to a claim for which the trial has been instituted. Indeed, Patent Owner seemingly acknowledges that the information is relevant to showing the knowledge of a POSITA and whether the challenged claims are unpatentable. PO Opp. 1–2.

Rather, Patent Owner asserts that Petitioner's motion should be denied because the supplemental information was available at the time the Petition was filed and should have been submitted then. PO Opp. 1–3. Patent Owner asserts that Petitioner cannot now introduce evidence that it did not rely on and did not supply until after Patent Owner identified the weaknesses of the original exhibits. *Id.* at 2–3 (citing *Redline Detection, LLC v. Start Envirotech, Inc*., 811 F.3d 435, 444–45, 448 (Fed. Cir. 2015)).

In evaluating a motion to submit supplemental information, we are cognizant that "the introduction of new evidence in the course of the trial is to be expected" during post-grant review trial proceedings, and "as long as the opposing party is given notice of the evidence and an opportunity to respond to it, the introduction of such evidence is perfectly permissible." *Genzyme Therapeutic Prods. Ltd. P'ship v. Biomarin Pharm. Inc.*, 825 F.3d 1360, 1366 (Fed. Cir. 2016); *see also id.* at 1367 (stating the purpose of the trial in a post grant review proceeding "is to give the parties an opportunity to build a record by introducing evidence—not simply to weigh evidence of which the Board is already aware"). On the other hand, the opportunity to submit supplemental information does not allow a petitioner to completely reopen the record, by, for example, changing theories after filing a petition. *Redline Detection*, 811 F.3d at 445, 447–448 (citations and internal quotations omitted). Thus, we consider whether admission of the supplemental information would change the grounds initially presented in the petition or otherwise unfairly change the evidence underlying those grounds. *Id.* We also consider whether the patent owner would be unduly prejudiced in having to respond to the supplemental information if permitted.

Under this framework, and for the reasons explained below, we grant Petitioner's motion to submit Exhibits 1027–1032 as supplemental information.

A. Exhibits 1027–1031

Exhibits 1027–1030 appear to be various protocols by the Association of Plastic Recyclers ("APR"). For example, Exhibit 1027, dated April 11, 2019 is titled "Critical Guidance Protocol for Clear PET Articles with Labels and Closures" and is labeled "Document number PET-CG-02." Exhibit

1031 appears to be two test methods from Multi-Color Global Label Solutions, the first labeled "Document # GEN-TM-7A" and the second labeled "Document # GEN-TM-7B" both which are dated December 21, 2018. Ex. 1031, 1–2 (GEN-TN-7A), 3–5 (GEB-TM-7B).

In its Motion, Petitioner states that Exhibits 1027–1031 are earlier versions of protocols that were submitted with its Petition. *See* Mot. 1–3. For example, Petitioner asserts that Exhibit 1027 is the earlier dated operative version of PET-CG-02 that was submitted as Exhibit 1005. Mot. 1; *see also id.* at 1–3 (stating Exhibits 1028 –1030 are earlier-dated versions of the APR protocols set forth in Exhibits 1006–1008). Petitioner also states that Exhibit 1031 contains the earlier dated operative versions of test methods GEN-TM-7A and GEN-TM-7B, which were later combined into the single test method RD-TM-210-4 submitted as Exhibit 1012. Mot. 3. (citing Pet. 30; Ex. 1014 ¶ 71); *see also* Ex. 1012 (RD-TM-210-4).

Petitioner asserts that each of Exhibits 1027–1031 are relevant to at least one claim for which trial has been instituted, including with respect to Petitioner's expert's analysis of the claims of the '422 patent. *Id.* (citing Ex. 1013 ¶¶ 10, 69, 74, 82; Ex. 1014 ¶¶ 10, 147, 155). Petitioner further points to Patent Owner's assertions that the earlier-dated versions (i.e., Exs. 1027–1031) are "more relevant" than the later-dated versions (i.e., Exs. 1005–1008, 1012). *Id.* (citing Paper 16, 2–5); *see also* Paper 16, 2–3 (objecting to Exhibits 1005–1008 because, *inter alia*, they were "not the operative versions of the documents" as of the priority date of the U.S. Patent 11,961,422 ("the '422 patent")), 5 (objecting to Exhibit 1012 because the exhibit was published in 2018 "thus predating the '422 patent (and were merely *revised* Bushman 'to focus only on' shrink sleeve labels on 12/28/2024)".

We grant Petitioner's request to submit these exhibits as supplemental information into the record. None of these exhibits change the grounds initially presented in the Petition. The Petition relies on the sale of a Gatorade shrink label (Ex.1003), either alone or in combination with other art, as rendering certain claims of the '422 patent unpatentable under 35 U.S.C. §§ 102, 103. *See, e.g.*, Pet. 13–53; Ex. 1014 ¶¶ 71–78. Petitioner also asserts that the challenged claims are indefinite under 35 U.S.C. § 112 because the term "wherein the recyclable shrink label is recyclable" does not have a definite meaning. *See, e.g.*, Pet. 13, 53–58; Ex. 1014 ¶¶ 147, 155. None of Exhibits 1027–1031 change these grounds asserted in the Petition.

Nor do these exhibits appear to unfairly change the evidence underlying those grounds. In order to show unpatentability under §§ 102 and 103, Petitioner states that it conducted tests in reference to disclosures in the '422 patent (*e.g.*, "PET-CG-02") and RD-TM-2104 to show the assert prior art label is "recyclable with a PET container" as required by claim 1. Pet. 30–31 (citing Ex. 1001, 11:29–53; Ex. 1014 ¶¶ 71–77). Exhibits that provide information about the standards may have evolved over time do not change the tests results that were submitted with the Petition.

Patent Owner asserts that Exhibit 1027 contains "vastly different information" than its later dated Exhibit 1005, "which has a material effect on how a POSITA would have understood the state of recyclability at the priority date of the '422 patent. PO Opp. 2–3. Patent Owner further states that Exhibit 1027 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 Exhibit 1005. We are not persuaded by this argument. As noted above, exhibits that provide information about how the standards may have evolved over time do not change the tests results that were submitted with the

Petition. Moreover, the protocol submitted as Exhibit 1005 refers to earlier dated versions of the protocol by revision number and publication date and explains in the "Revision notes" what revisions were made to earlier-dated versions. *See* Ex. 1005, 11. Admitting an earlier version of a protocol (i.e., Ex. 1027) explicitly referred to in the later-dated protocol (Ex. 1005) will clarify the record by providing more details about the protocol has changed over time. Similarly, Exhibits 1006–1008 also appear to refer to their respective earlier-dated version (i.e., Exhibits 1028–1030) by revision number and publication date and explain in the "Revision notes" what revisions were made to earlier-dated versions. *See* Ex. 1006, 27; Ex. 1007, 5; Ex. 1008, 6.

Patent Owner also argued that Exhibit 1028 had not been supplied to Patent Owner and, therefore, the exhibit should be excluded. *See* PO Opp. 4–5. We disagree with this argument because Exhibit 1028 has since been filed by Petitioner.

For the foregoing reasons, we grant Petitioner's motion to submit Exhibits 1027–1031 as supplemental information.

1. Exhibit 1032

Petitioner also asserts that Exhibit 1032 is a supplemental declaration by Dr. Michael Deible that clarifies the source of the label samples he analyzed in connection with his January 16, 2025 Declaration (Ex. 1014). *Id*. 4–5. Patent Owner asserts that the supplemental declaration provides entirely new information not included with the Petition and that was solely in Petitioner's control. PO Opp. 3. Patent Owner further states that the corrections to Dr. Deible's Declaration relabel test results obtained from a Febreze label as not obtained from a Gatorade label and thus "effectively creates a new declaration." *Id.* (citing Ex. 1032). We disagree with Patent

Owner. Permitting Petitioner to submit the supplemental declaration as supplemental information will facilitate Patent Owner's ability to question the declarant as to the test results that were submitted with the Petition. Whether the original declaration contains insufficient information to support Petitioner's assertions of unpatentability is a matter to resolved during trial.

ORDER

For the foregoing reasons, it is

ORDERED that Petitioner's Motion to Submit Supplemental Information is granted.

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