

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 MOTION TO COMPEL EXPERT DECLARANT
COMMUNICATIONS**

LISTING OF EXHIBITS

EX	DESCRIPTION
2001	"Going for Gold," Multi-Color Corporation, available at https://www.mcclabel.com/en/resources/going-for-gold
2002	"NESCAFÉ® Debuts Gold Espresso and Ice Roast Instant Coffee in the U.S., Offering Rich Variety for Every Occasion," Nestle, April 3, 2024, available at https://www.nestleusa.com/media/pressreleases/gold-espresso-ice-instant-coffee
2003	recycLABEL™ Shrink Sleeve brochure, Multi-Color Corporation
2004	"Labeled with Care – Sustainability Update," Multi-Color Corporation, available at https://issuu.com/mcclabel/docs/mcc_2024_sustainability_update?fr=sOTFjMjY0MTE4OTQ
2005	"Nestlé to use recyclable, light-blocking shrink sleeves on some beverage products," Packaging Dive, April 17, 2024, available at https://www.packagingdive.com/news/nestle-recyclable-shrink-sleeve-label-light-blocking/713427/
2006	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, Docket Report, generated May 13, 2025
2007	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, D.I. 16 (Docket Control Order)
2008	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, D.I. 50 (Defendants' Unopposed Motion for Leave to Supplement Invalidity Contentions Under P.R. 3-6(b))
2009	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, D.I. 51 (Order granting D.I. 50)
2010	Deposition Transcript of A. Craig Bushman dated November 18, 2025, PGR-2025-00025
2011	Deposition Transcript of Dr. Michael Deible dated December 2, 2025, PGR2025-00025

I. INTRODUCTION AND RELIEF REQUESTED

Despite Dr. Deible citing Mr. Bushman's declaration over twenty times throughout his expert declaration in this case, Dr. Deible testified that he had never read Mr. Bushman's declaration. EX2011 ("M. Deible Tr.") at 154:19-24. Instead, Dr. Deible testified that he relied on counsel for each representation in his expert report where he cites to Mr. Bushman's declaration (EX1013). M. Deible Tr. at 162:18-24 ("Q: ... is it fair to say that for every citation to Exhibit 1013 in your expert report, that that information was relayed to you through Counsel? A: Yes.>"). The PTAB has routinely found that such communications of facts, data, and assumptions are not privileged or protected from disclosure by work product protection and should be produced. *Adobe Inc. v. Rah Color Techs. LLC*, IPR2019-00627, Paper 59 at 4-9 (P.T.A.B. Dec. 12, 2019) (facts and data considered by reporting expert not protected by work product doctrine). Here, the Board should do the same.

Moreover, Petitioner seems to believe that it is absolved from producing these communications as a result of Dr. Deible's testimony that he did not independently communicate with Mr. Bushman without counsel present. First, Dr. Deible's testimony is in *direct conflict* with Mr. Bushman's testimony. EX2010 ("C. Bushman Tr.") at 197:7-9 ("Q: Have you had discussions with Dr. Deible? A: Yes.>") Such conflict raises more questions, not answers, and therefore should be reviewed

with close scrutiny by the Board. Second, when one expert relies on communications with another expert in support of their opinions, the fact that counsel was present on those communications is of no moment. EX1014 ¶ 59 (Dr. Deible citing communications with Mr. Bushman for support). Third, it appears Petitioner sought to cherry pick the best evidence it could find and withhold the rest under the guise of ginned-up attorney-client privilege and work product protection claims while simultaneously feeding its expert facts, data, and assumptions to help him form his opinions and shield against Patent Owner's proper attempts to test these opinions. Petitioner's conduct cannot and should not be permitted.

Patent Owner respectfully requests that the Board compel Petitioner to produce all communications between its expert Dr. Deible, counsel for Petitioner, and/or employees of Petitioner (e.g., Mr. Bushman) conveying any facts, data, or assumptions under 37 C.F.R. §§ 42.65(a), 42.51(b).

II. FACTUAL BACKGROUND

The claims at issue relate to recyclable, light blocking shrink labels that are recyclable with a PET container. EX1001, cl. 1. Petitioner asserts that its commercially available Gatorade product labels anticipate or render obvious the claims of the '422 Patent because the shrink labels purportedly contain light-blocking components and inks that wash off in a caustic wash. Pet. at 30 ("For example, the '422 Patent states ... that a label is [] considered recyclable if no inks

are retained on the film after a caustic wash cycle.’’). In support of its Petition for post-grant review, Petitioner submitted declarations from two declarants: Mr. Craig Bushman, Petitioner’s then-Vice President of Global R&D, and its expert Dr. Michael Deible. EX1013; EX1014. In his declaration, Dr. Deible describes various tests he performed on the Gatorade label to show how the label purportedly meets the limitations in the ’422 Patent, including scanning electron microscopy, Fourier-transformed infrared spectroscopy, optical micrograph, percent transmittance, and caustic wash testing. EX1014 ¶¶ 60, 63, 67, 71, 123.

Presumably because Dr. Deible has little to no experience with label design, manufacturing, testing, or recycling processes, Petitioner relies heavily on Mr. Bushman to fill numerous critical gaps in Dr. Deible’s opinions. M. Deible Tr. at , 20:20-21:7; 154:12-18, 194:9-10, 232:15. Petitioner’s reliance on Mr. Bushman’s knowledge and experience take on several forms including citations within Dr. Deible’s declaration indicating reliance on Mr. Bushman’s declaration and conversations between Mr. Bushman and Dr. Deible, as well as reliance on Mr. Bushman’s experience designing, manufacturing, and testing labels, including testing to determine whether a particular label is recyclable under APR standards.

Deposition testimony from both Mr. Bushman and Dr. Deible confirm that Dr. Deible extensively relied on facts, data, and assumptions provided to him from Mr. Bushman either directly or indirectly through counsel for Petitioner and that Dr.

Deible considered these facts, data, and assumptions when forming his opinions. Despite over twenty citations in his declaration “relying on the declaration of Mr. Craig Bushman” in Dr. Deible’s declaration, *e.g.*, EX1014 ¶ 102, Dr. Deible testified that he never once looked at Mr. Bushman’s declaration but rather received that information from counsel for Petitioner. M. Deible Tr. at 154:19-24.

Moreover, Mr. Bushman instructed Dr. Deible how to perform certain testing, received Dr. Deible’s test results, and provided feedback on those results. C. Bushman Tr. at 203:4-19, 203:25-204:11, 213:5-11, 214:7-11, 216:9-19. And, neither Mr. Bushman nor Dr. Deible denied that Mr. Bushman provided guidance on how to interpret the results of the testing. *Id.* at 205:22-24 (“Q: ... did Dr. Deible ask you how to interpret the results? A: I don’t recall.”); M. Deible Tr. at 38:13-18 (“Q: Did you have any discussions with Mr. Bushman or anyone at MCC regarding how to interpret any of the results ...? A: I don’t recall.”). As one example of the influence Mr. Bushman had on Dr. Deible’s testing, Dr. Deible performed caustic wash testing on the Gatorade label to show that the label purportedly contains inks that wash off in order to determine that the Gatorade labels are recyclable with a PET container. EX1014 ¶ 71. With his lack of recycling experience, however, Dr. Deible had never actually performed a caustic wash test consistent with the recycling industry standards, so Mr. Bushman supplied an internal MCC testing protocol that Dr. Deible should use to conduct the testing. C. Bushman Tr. at 203:4-19, 203:25-

204:11, 216:9-19. Contrary to statements made by counsel for Petitioner during the teleconference hearing with the Board, there are *two* different versions of this MCC caustic wash protocol in the record (EX1012 and EX1031)—because Mr. Bushman admittedly revised the test protocol shortly before Dr. Deible signed his declaration. C. Bushman Tr. at 224:21-225:5. Yet, Dr. Deible did not follow either version of the MCC internal protocol. *Compare* EX 1014 ¶¶ 73-75 (using only 40mL of caustic wash solution from a batch of 500mL), *with* EX1012 at 3 (using complete volume for test) *and* EX1031 at 4 (using compete solution volume). When Dr. Deible obtained the results from these tests, he sent them to Mr. Bushman who provided feedback on the results. C. Bushman Tr. at 213:5-11, 214:7-11. Critically, when asked whether Mr. Bushman knew if counsel for Petitioner had instructed Dr. Deible to perform additional testing on the Gatorade label after he had seen the results, counsel instructed the witness not to answer on the basis of privilege. C. Bushman Tr. at 212:11-16. All of these interactions, both with counsel for MCC and with Mr. Bushman (or other MCC employees) helped form the basis of Dr. Deible's opinions related to the Gatorade label as Dr. Deible had little to no experience with the Gatorade label or recyclability of labels, generally. Yet, none of these bases were disclosed to Patent Owner.

When Patent Owner discovered these significant discovery deficiencies, Patent Owner promptly raised the issue with Petitioner and requested the additional

discovery. Petitioner immediately forwarded Patent Owner's email to the Board and requested a protective order and *in camera* review of additional materials Petitioner had readily available but refused to produce. The Board scheduled a teleconference, during which Petitioner confirmed the existence of additional documents that were not produced and agreed to produce certain documents, including test results allegedly supporting APR certification letter in EX1018, wash water evaluation, and silver ink testing related to EX1019. The Board further authorized Patent Owner to file the present motion to compel additional information about Petitioner's communications and exhibits related to Dr. Deible's opinions.

Patent Owner respectfully requests that the Board compel production of the following categories of documents: (1) communications with Dr. Deible providing any testing protocols, including but not limited to caustic wash test protocols; (2) communications involving Dr. Deible providing results of his testing directly or indirectly to any MCC employee; (3) communications with Dr. Deible providing any feedback, interpretation, or instruction related to his testing results; (4) communications with Dr. Deible that relate to revised, modified, or altered test protocols, data, or assumptions; (5) any communications with Dr. Deible that relate to any analysis by Mr. Bushman or any other MCC employee of test results obtained by Dr. Deible; (6) communications with Dr. Deible reflecting any questions that Dr. Deible asked about the test protocols, results, or interpretation of results; (7)

communications with Dr. Deible requesting additional testing after initial testing; (8) any data reflecting outcomes adverse or inconsistent with Dr. Deible's declaration; and (9) any test protocols or results of any analysis performed on the Watson Standard silver ink described in EX1019, regardless of whether the testing was performed in connection with the Petition in this case.

III. LEGAL STANDARDS

Pursuant to 37 C.F.R. § 42.51(b)(1)(iii), Petitioner must serve relevant information that is inconsistent with any of its positions. Patent Owner is also entitled to additional discovery under § 42.51(b)(2)(i) of evidence directly related to factual assertions advanced by either party.

Patent Owner is therefore entitled to the "facts or data" underlying Petitioner's expert's opinion and any "relevant information that is inconsistent" with Petitioner's positions. 37 C.F.R. §§ 42.65(a), 42.51(b)(1)(iii). The "facts or data" an expert considered is critical to testing the expert's independence, reliability, and credibility and the expert report's evidentiary value. 37 CFR §42.65(a) ("Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight."); *see, e.g., Propel Orthodontics, LLC v. Orthoaccel Techs., Inc.*, No. IPR2018-00296, 2019 WL 2426533, at *9 (P.T.A.B. June 10, 2019) (expert opinion that merely repeats party's argument merits no weight.).

Petitioner bears the burden to establish any privilege it asserts. *In re Queen's Univ. at Kingston*, 820 F.3d 1287, 1301 (Fed. Cir. 2016). While PTAB proceedings are not governed by the Federal Rules of Civil Procedure, they are informative. *Adobe*, IPR2019-00627, Paper 59 at 8. Fed. R. Civ. P. 26 does not create an independent privilege for expert witnesses. *Republic of Ecuador v. Mackay*, 742 F.3d 860, 869 (9th Cir. 2014) (distinguishing the broader, attorney work product protections under Rule 26(b)(3) from the narrower protections for experts under Rule 26(b)(4)); *In re Republic of Ecuador*, 735 F.3d 1179, 1186 (10th Cir. 2013) (same). Instead, Rule 26(b)(4)(B) protects draft reports and 26(b)(4)(C) protects some attorney communications. “Rules 26(b)(3)(A) and (B) protect communications between the party’s attorney and any witness required to provide a report under Rule 26(a)(2)(B), regardless of the form of the communications, *except*¹ to the extent that the communications: (i) relate to compensation for the expert’s study or testimony; (ii) identify facts or data that the party’s attorney provided and that the expert considered in forming the opinions to be expressed; or (iii) identify assumptions that the party’s attorney provided and that the expert relied on in forming the opinions to be expressed.” Fed. R. Civ. P. 26(b)(4)(C). Thus, the Rule explicitly states that not all attorney communications are shielded from discovery.

¹ Emphasis added unless stated otherwise.

The 2010 Advisory Committee Notes explain that Rules 26(a)(2)(B)(ii) and (b)(4) require: “[T]hat ‘facts or data’ be interpreted broadly to require disclosure of *any material considered by the expert*, from whatever source, that contains factual ingredients. The disclosure obligation extends to any facts or data ‘considered’ by the expert in forming the opinions to be expressed, not only those relied upon by the expert.” Thus Rules 26(a)(2)(B)(ii) and 26(b)(4)(C)(ii) mandate disclosure of facts or data a party’s attorney provided to its expert and its expert considered. The same Notes limit any work product privilege to only the attorney’s mental impressions: Rule 26(b)’s “[p]rotection does not extend to the expert’s own development of the opinions to be presented; those are subject to probing in deposition or at trial.”

IV. ARGUMENT

A. Petitioner Should be Compelled to Produce All Communications Involving Dr. Deible that Convey Facts, Data, or Assumptions

Complete discovery of all facts, data, and assumptions considered by an expert is not only required but is also critical to testing the expert’s independence, reliability, and credibility, and the expert report’s evidentiary value. *Adobe*, IPR2019-00627, Paper 59 at 2. Patent Owner is therefore entitled to discovery of communications between its expert, Dr. Deible, and counsel for Petitioner or any of Petitioner’s employees, including Mr. Bushman, that disclose facts, data, or assumptions which Dr. Deible considered when forming his opinions. 37 C.F.R. §

42.65(a); Fed. R. Civ. P. 26(a)(2)(B). The record already confirms that these communications exist and have not been produced.

On November 18, Patent Owner deposed Mr. Bushman, Petitioner's former Vice President of Global R&D. In addition to serving as a declarant himself, Mr. Bushman's testimony also confirmed that he played a role in shaping Dr. Deible's opinions and performing the testing that helped form the basis for those opinions. Mr. Bushman testified that he provided Dr. Deible's testing protocols and received Dr. Deible's test results by email. C. Bushman Tr. at 203:4-19, 203:25-204:11, 214:7-11, 216:9-19. He then reviewed those results and provided feedback on the testing. *Id.* at 204:18-20. Dr. Deible, for his part, all but confirmed that he received that feedback. M. Deible Tr. at 32:12-15 ("Q: Prior to submitting your declaration in this case, did Mr. Bushman provide any information to you? A: To me directly?"), 38:13-18 (responding "I don't recall" to a question of whether he had any discussions with Bushman or MCC regarding interpreting the test results), 69:5-9 (responding "I don't recall" to a question of whether he had ever discussed testing related to this litigation). Dr. Deible further confirmed that he sent or received multiple emails that included MCC employees, such as Mr. Bushman, *see* M. Deible Tr. at 30:12-18 ("I've only ever communicated with counsel, whether there were emails that [Mr. Bushman] was cc'd on or as part of, you know, yeah.")—and that he had discussions with Mr. Bushman about the testing related to the Gatorade and

Febreze labels, *id.* at 70:15-71:3 (“I would say, at a high level, those conversations [with Mr. Bushman] may have at times included, you know, an update that, you know, on the progress of testing.”).

Whether Mr. Bushman's feedback was received by Dr. Deible directly or indirectly through counsel for MCC is of no consequence, 37 C.F.R. § 42.65 and Fed. R. Civ. P. 26(b) require disclosure of any transmission of facts, data, or assumptions that Dr. Deible considered in forming his opinions and Petitioner cannot shroud that communication by routing it through attorneys. *Adobe*, IPR2019-00627, Paper 59 at 2. Notably, neither Dr. Deible nor Mr. Bushman deny that they discussed the results of Dr. Deible's testing. C. Bushman Tr. at 205:22-24 (“Q: ... did Dr. Deible ask you how to interpret the results? A: I don't recall.”); M. Deible Tr. at 38:13-18 (“Q: Did you have any discussions with Mr. Bushman or anyone at MCC regarding how to interpret any of the results ...? A: I don't recall.”). Indeed, Mr. Bushman admitted that he had provided feedback on the results. C. Bushman Tr. at 204:18-20.

Here, the involvement of Petitioner's counsel in feeding facts, data, and assumptions to Dr. Deible that he affirmatively relied on in forming his opinions is beyond dispute. Dr. Deible confirmed that, despite “relying on the declaration of Mr. Craig Bushman” in over twenty citations, Dr. Deible had *never even seen* Mr. Bushman's declaration. M. Deible Tr. at 154:19-24. Instead, all of the information

contained within Mr. Bushman's declaration that Dr. Deible cites to and incorporates into his own declaration was provided by counsel for MCC. M. Deible Tr. at 154:19-24, 162:18-24 ("Q: ... is it fair to say that for every citation to Exhibit 1013 in your expert report, that that information was relayed to you through Counsel? A: Yes."). Yet now, Petitioner attempts to shield this information from production under the guise of privilege. These facts, data, and assumptions were undoubtedly considered and relied on by Dr. Deible, yet Patent Owner stands unable to test whether the information about Mr. Bushman's declaration provided to Dr. Deible comports with the information contained within Mr. Bushman's declaration. Such tactics cannot be permitted and Patent Owner is entitled to test the complete bases, bias, credibility, and veracity of Dr. Deible's opinions. *Adobe*, IPR2019-00627, Paper 59 at 2.

B. Petitioner Should Be Compelled to Produce Silver Ink Testing

At the December 3 teleconference hearing with the Board, Petitioner agreed to look for and produce any testing performed by MCC related to the silver ink allegedly used in the Gatorade label. Mr. Bushman testified that MCC may have conducted such testing to confirm Watson Standard's claims that the ink passes recyclability/bleed testing as stated in EX1019, which Petitioner relies on to support its assertion that the Gatorade label is recyclable. *See* C. Bushman Tr. at 100:25-101:3, 102:1-21, 103:13-17; Pet. at 31 ("In connection with this analysis, Petitioner also notes that the silver ink used in connection with the Gatorade Label ... passes

recyclability/bleed testing”). Yet, in its December 5 transmittal letter, in which Petitioner produced data related to EX1018, Petitioner stated that it “did not conduct any silver ink testing in preparing the Petition and thus does not possess any corresponding test results or protocols.” Paper 24 at 2. Patent Owner’s discovery request is not, however, limited to testing conducted as part of “preparing the Petition,” but instead covers any testing conducted by MCC (or its subsidiary Fort Dearborn) to confirm the claims that the Watson Standard silver ink “passes the recyclability/bleed testing set forth in the protocol established by the Association of Postconsumer of Plastic Recyclers,” as described in EX1019.

As bleed testing is generally used to confirm that inks *do not wash off the label*, EX1030 at 1 (according to the APR Wash Water Evaluation, “it is usually undesirable for inks and adhesives from film labels to become dispersed in the hot caustic wash water”), this testing is likely inconsistent with the positions taken by MCC in this case – *i.e.*, that EX1019 supports the conclusion that the Gatorade label features inks that wash entirely off the label. Pet. at 31; C. Bushman Tr. at 107:15-25 (“there were examples in [the] market of labels that used washable ink systems, specifically the Watson Standard washable ink system ... designed to wash off [] the PET film”); 37 C.F.R. § 42.51(b)(1)(iii). At base such information would be directly related to the factual assertions advanced by MCC in this case and would therefore be appropriate additional discovery. 37 C.F.R § 42.51(b)(2).

V. CONCLUSION

For the reasons stated above, Patent Owner respectfully requests the Board compel production of all communications with Dr. Deible that convey facts, data, and assumptions, as well as all silver ink testing. In particular, Patent Owner respectfully requests that the Board compel production of the following categories of documents: (1) communications with Dr. Deible providing any testing protocols, including but not limited to caustic wash test protocols; (2) communications involving Dr. Deible providing results of his testing directly or indirectly to any MCC employee; (3) communications with Dr. Deible providing any feedback, interpretation, or instruction related to his testing results; (4) communications with Dr. Deible that relate to revised, modified, or altered test protocols, data, or assumptions; (5) any communications with Dr. Deible that relate to any analysis by Mr. Bushman or any other MCC employee of test results obtained by Dr. Deible; (6) communications with Dr. Deible reflecting any questions that Dr. Deible asked about the test protocols, results, or interpretation of results; (7) communications with Dr. Deible requesting additional testing after initial testing; (8) any data reflecting outcomes adverse or inconsistent with Dr. Deible's declaration; and (9) any test protocols or results of any analysis performed on the Watson Standard silver ink described in EX1019, regardless of whether the testing was performed in connection with the Petition in this case.

Dated: December 10, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Patent Owner's Motion to Compel Expert Declarant Communications was served on December 10, 2025, via electronic mail directed to counsel of record for the Petitioner:

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CERTIFICATE OF COMPLIANCE

This Patent Owner's Motion to Compel Expert Declarant Communications complies with the type-volume limitations as mandated in 37 C.F.R. § 42.24. According to the word processing system used to prepare this document, the motion contains less than 15 pages.

/s/ W. Todd Baker

W. Todd Baker