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 RESPONSE TO PATENT OWNER'S MOTION TO COMPEL

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Exhibit 1001:	U.S. Patent No. 11,961,422
Exhibit 1002:	The Prosecution History of the ‘422 Patent
Exhibit 1003:	Petitioner’s Gatorade Label
Exhibit 1004:	Petitioner’s Febreze Label
Exhibit 1005:	PET-CG-02 – Critical Guidance protocol for clear PET articles with labels and closures
Exhibit 1006:	PET Standard Laboratory Processing Practices
Exhibit 1007:	PET-S-04 – PET Package Materials Balance Test
Exhibit 1008:	PET-S-01 – Labels for PET - Wash Water Test
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Exhibit 1016:	SKC inc. EL62 Product Description
Exhibit 1017:	Brook+Whittle webpage print, retrieved from https://brookandwhittle.com/recyclable-light-blocking-shrink-sleeves/
Exhibit 1018:	Association of Plastic Recyclers recognition correspondence
Exhibit 1019:	Watson Standard Technical Data Sheet
Exhibit 1020:	U.S. Patent Publication No. 2017/0223879 to Mitchell et al.
Exhibit 1021:	Second Declaration of Mr. Craig Bushman
Exhibit 1022:	*Brook + Whittle LTD v. Nestle USA, Inc. et al.*, 2:24-cv-00735-JRG-RSP, D.I. 63 (Defendant's Motion to Stay Pending Resolution of Related Declaratory Judgment Action)
Exhibit 1023:	*Brook + Whittle LTD v. Nestle USA, Inc. et al.*, 2:24-cv-00735-JRG-RSP, D.I. 18 (Defendant Nestlé USA, Inc.'s Motion to Dismiss for Improper Venue)
Exhibit 1024:	*Brook + Whittle LTD v. Nestle USA, Inc. et al.,* 2:24-cv-00735-JRG-RSP, D.I. 32 (Defendant Fuji Seal International, Inc.'s Motion to Dismiss for Lack of Personal Jurisdiction). Motion is sealed and not publicly available; see *American Fuji Seal, Inc. v. Brook + Whittle LTD*, 24-1215-MN, D.I. 23
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Exhibit 1026:	U.S. Appln. No.: 18/667,677, "Recyclable heat shrink film for recyclable container," (Prosecution History)
Exhibit 1027:	PET-CG-02, Critical Guidance protocol for clear PET articles with labels and closures, Revision Date 04.11.2019
Exhibit 1028:	PET-P-00, PET Standard Laboratory Processing Practices, Revision Date 09.17.2019

Exhibit 1029:	PET-S-04, PET Package Materials Balance Test, Revision Date 11.16.2018
Exhibit 1030:	PET-S-01, Labels for PET - Wash Water Test, Revision Date 11.16.2018
Exhibit 1031:	GEN-TM-7A-B, Caustic Evaluation PET SSL, Revision Date 12.21.2018
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Exhibit 1035:	3191167 images
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I. INTRODUCTION

Patent Owner's Motion to Compel Expert Declarant Communications (Paper 26) ("Motion") should be denied because all communications between Petitioner's counsel and Dr. Deible in connection with the preparation of his declaration are protected work product. Such communications inherently include the strategy and mental impressions of Petitioner's counsel, a fact made clear by the Supreme Court, countless federal courts, and even the PTAB decisions relied upon by Patent Owner.

Indeed, the case relied upon by Patent Owner, *Adobe Inc. v. Rah Color Techs. LLC*, IPR2019-00627, Paper 59 at 4-9 (P.T.A.B. Dec. 12, 2019), demonstrates that Patent Owner's Motion should be denied. In *Adobe*, the Board determined that *questions* asked of an expert witness relating to "the underlying factual basis for [the expert's] testimony presented in his declarations" should be allowed. *Id.* at 4 (emphasis added). Importantly, the Board's decision in *Adobe* was explicitly contingent upon the fact that "[t]he questions do not seek the substance of any *communication* between [the expert] and Petitioner's attorneys and do not, for example, seek information regarding the specific content of…" the communications. *Id.* at 4-5 (emphasis added). Thus, *Adobe* emphasizes that communications between counsel and witnesses constitute work product and are not subject to discovery.

The Board has repeatedly determined that discovery of the communications that Patent Owner's Motion seeks, which is nothing more than a speculative fishing expedition, should not be allowed. Because "[a]fter-the-fact cross examination inquiries into declaration preparation tend to chill an inquiry an attorney might initially make into what the facts are and who should testify concerning particular facts," the Board should not permit Patent Owner to invade privileged communications. *Pevarello v. Lan*, 85 U.S.P.Q.2d 1771, 2007 WL 594728, at *11 (B.P.A.I. 2007).

In addition, Patent Owner fails to demonstrate that any of the documents it seeks constitutes information that is inconsistent with a position advanced by Petitioner. Indeed, Patent Owner is not seeking routine discovery at all. Even if the discovery was routine, the Board's rules exclude "legally recognized privileges such as attorney-client or attorney work product" from routine discovery and limit the "scope of the [cross] examination … to the scope of the direct testimony." 37 C.F.R. §§ 42.51(b)(1)(iii), 42.53(d)(5)(ii).

Instead, Patent Owner itself confirms that it is seeking nonroutine additional discovery, repeatedly citing 37 C.F.R. § 42.51(b)(2) throughout its Motion. *See, e.g.*, Paper 26 at 7, "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." Yet, Patent Owner does not even mention the factors governing additional

discovery, much less demonstrate that those factors warrant production of the communications Patent Owner seeks. Patent Owner bears the burden of proving that good cause exits to be entitled to additional discovery under 37 C.F.R. § 42.224 - a burden it has not met.

Petitioner also notes that it has already (1) produced the 2019 APR critical guidance recognition test data as requested by Patent Owner (see Exhibit 1038), (2) produced all test results and protocols for wash-water evaluations undertaken by Petitioner in preparing the Petition, for in camera review (Exhibits 1033-1036), and (3) confirmed that no silver ink testing was conducted in preparing the Petition.

II. PETITIONER'S RESPONSE TO PATENT OWNER'S PRELIMINARY COMMENTS

Patent Owner introduces its Motion by explaining that Dr. Deible cited Mr. Bushman's declaration on numerous occasions, and that Dr. Deible relied on counsel for those citations. In doing so, Patent Owner unwittingly concedes that the facts, data, and assumptions relied upon by Dr. Deible have already been fully disclosed. Dr. Deible did in fact disclose all facts, data, and assumptions in specific detail, in his declaration. (*See e.g.*, EX1014, ¶14: "In forming my analysis and conclusions expressed in this Declaration, I have applied the legal principles described in the following paragraphs, which were provided to me by Counsel for the Petitioner"; EX1014, ¶55: "I am relying upon the Declaration of Mr. Craig

Bushman (EX 1013, at ¶¶43-57) relating to relevant dates and the respective qualification of the art as prior art, including the disclosed dates relevant to the Gatorade Label and the Febreze Label."). In doing so, Dr. Deible and Petitioner complied with the Board's August 2018 Update to the Office Patent Trial Practice Guide regarding disclosure of all underlying facts and data.

Patent Owner then misstates Petitioner's position, and also fabricates a perceived "direct conflict" which does not, in fact, exist. Patent Owner misstates Petitioner's position by arguing "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." (Paper 26, 1). Not so. To the contrary, Petitioner need not produce communications with Dr. Deible because those communications incorporate counsel's mental impressions and are work product.

There is also no "direct conflict" as Patent Owner postulates. To explain, Dr. Deibel did not "independently communicate with Mr. Bushman"; *i.e.*, Dr. Deible did not have any communications with Mr. Bushman without counsel's involvement. At the same time, Mr. Bushman has "had discussions with Dr. Deible," but all such discussions included counsel. Thus, there is no "direct conflict" between Dr. Deibel not "independently communicat[ing] with Mr. Bushman" and Mr. Bushman having discussions with Dr. Deible.

Finally, Patent Owner falsely, and without any support whatsoever, argues that "it appears Petitioner sought to cherry pick the best evidence it could find and withhold the rest…". (Paper 26, 2). Patent Owner is wrong, a fact demonstrated though Petitioner's submission to the Board of all requested information, as described above. Patent Owner's accusation is egregious and unsupported.

III. PETITIONER'S RESPONSE TO PATENT OWNER'S FACTUAL BACKGROUND

Patent Owner attempts to bolster its Motion by reference to Mr. Bushman's deposition testimony. (Paper 26, 4). Mr. Bushman's deposition testimony does not support Patent Owner's Motion, because it demonstrates all facts, data, and assumptions relied upon by Dr. Deible were not only disclosed, but inquired of by Patent Owner during his deposition. Regardless, Mr. Bushman's deposition cannot support Patent Owner's Motion, because the law protects the communications Patent Owner seeks, based on work product privilege.

To explain, Mr. Bushman disclosed that he had discussions with Dr. Deible before the Petition was filed. EX2010, 200:8-14. As a part of those discussions, Mr. Bushman did not provide any input to Dr. Deible's opinions. *Id.* at 200:25-201:3. Mr. Bushman also did not provide any input as to how Dr. Deible was to run any tests that Dr. Deible performed. *Id.* at 202:6-20. Mr. Bushman did not provide any input regarding how to run the tests or how Dr. Deible did the tests. *Id.*

In particular, Mr. Bushman did not tell Dr. Deible how to do the analytical testing. *Id.*

Mr. Bushman did confirm what has already been disclosed to Patent Owner in this proceeding. Mr. Bushman testified that he provided to Dr. Deible "general commentary related to how [Petitioner] produced the [Gatorade and Febreze] labels in the market and how [Petitioner] supply them to the market." *Id.* at 202:1-5. Mr. Bushman also supplied Dr. Deible with Petitioner's test method. *Id.* at 202:25-203:7. This is precisely the information that Petitioner (already) disclosed in connection with Mr. Bushman's declaration (EX1013, 5: Petitioner's test method "RD-TM-210-4 (Ex. 1012)") and Dr. Deible's declaration (EX1014, ¶55: "I am relying upon the Declaration of Mr. Craig Bushman (Ex. 1013, at ¶¶43-57) relating to relevant dates and the respective qualification of the art as prior art, including the disclosed dates relevant to the Gatorade Label and the Febreze Label"; EX1014, ¶71: "To determine if a label is recyclable with a PET container, laboratory tests were conducted in reference to the disclosures in the '422 patent (Ex. 1001, at 6:61-64; 11:29-53) and RD-TM-210-4 (Ex. 1012)."). This includes Petitioner's test method, which was cited in Mr. Bushman's declaration (EX1013, 5; *see also* EX2010, 216:9-14) and in Dr. Deible's declaration (EX1014, ¶71). And, this test method, conducted independently by Dr. Deible without any

involvement of Mr. Bushman, is consistent with testing undertaken to obtain APR Guidance recognition. EX2010, 220:13-222:6.

Contrary to Petitioner's argument, Mr. Bushman also testified that he did not provide any feedback regarding Dr. Deible's results, and had no recollection of providing any such feedback. EX2010, 205:4-9. That confirms Mr. Bushman's other testimony, because Mr. Bushman does not recall even being asked to interpret any test results (*Id.* at 205:22-24), does not recall providing any answers to any questions about any test results (*Id.* at 206:11-13), does not recall providing information that any testing methodology should be changed (*Id.* at 213:14-17), and does not recall any instructions to change test results or test protocols (*Id.* at 213:20-214:3).

Mr. Bushman's testimony is entirely consistent with that of Dr. Deible. Dr. Deible testified that he never provided any drafts of his declaration to Mr. Bushman. EX2011, 32:9-11. Dr. Deible also has no recollection of discussing Petitioner's test method with Mr. Bushman. *Id.* at 36:14-19. Dr. Deible repeatedly testified that he did not recall ever having any conversation involving Mr. Bushman or anyone at Petitioner regarding the caustic wash test method that he used. *Id.* at 71:5-9.

In terms of caustic wash test results, Dr. Deible did not provide any results to Mr. Bushman before submitting his declaration (*Id.* at 38:4-18) and did not have

any discussions with Mr. Bushman regarding how to interpret the caustic wash test results (*Id.*). Indeed, Dr. Deible did not recall ever having any discussions regarding how to interpret any of the results of any testing on either the Gatorade label or the Febreze label. *Id.* at 38:13-18.

IV. LEGAL STANDARDS

Patent Owner's Motion fails to mention, much less substantively apply, the proper standards at issue. For example, Patent Owner does not mention or apply the "good cause" standard and factors required by 37 C.F.R. § 42.224(a) and applied in *Bloomberg Inc. v. Markets-Alert Pty Ltd.*, Case CBM2013-00005 (PTAB May 29, 2013) (Paper 32) (Precedential). Patent Owner, as the moving party, has the burden of proof in establishing entitlement to the requested relief under the good cause standard. *See id.* at 4. Petitioner addresses the proper standard and factors here.

As a preliminary matter, however, Petitioner notes Patent Owner's Motion states that "[p]ursuant to 37 C.F.R. § 42.51(b)(1)(iii), Petitioner must serve relevant information that is inconsistent with any of its positions." What Patent Owner curiously leaves out is the sentence that immediately follows: "This requirement does not make discoverable anything otherwise protected by legally recognized privileges such as attorney-client or attorney work product." 37 C.F.R. § 42.51(b)(1)(iii).

A. The Board's Rules Exclude Attorney Work Product From "Routine Discovery"

In *Hickman v. Taylor*, 329 U.S. 495 (1947), the Supreme Court held that the work product of attorneys - which may be "reflected…in interviews, statements, memoranda, correspondence, briefs, mental impressions, personal beliefs, and countless other tangible and intangible ways" - is protected from discovery. *Id.* at 511. "Not even the most liberal of discovery theories can justify unwarranted inquiries into the files and the mental impressions of an attorney." *Id.* at 510.

The attorney work product immunity is applicable in all tribunals. In Post Grant Reviews ("PGRs"), the Board's rules explicitly exclude from "routine discovery" anything "otherwise protected by legally recognized privileges such as attorney-client or attorney work product." 37 C.F.R. § 42.51(b)(1)(iii).

B. Nonroutine Additional Discovery Should Not Include Attorney Work Product Or Declaration Preparation Information

The Board may authorize nonroutine "additional discovery." 37 C.F.R. § 42.51(b)(2)(i). As the Board's predecessor, the Board of Patent Appeals and Interferences ("BPAI"), has explained in detail, discovery into the process of preparing witness declarations and the attorney work product underlying that process are not in the interests of justice because they are "a waste of time, both for the witness and the Board." *Pevarello*, 2007 WL 594728 at *11.

In *Pevarello*, an expanded panel of Patent Judges addressed cross examination practices before the BPAI. *Id.* at 1. The panel counseled against questions regarding the preparation of direct testimony, such as whether experts wrote their declarations, whether they suggested changes, whether certain passages originated from them, and correspondence with attorneys. *Id.* at *10. The panel explained that such questions were a "waste of time," emphasizing that "it does not matter how a declaration for direct testimony is prepared, who suggested what, what changes were made, how drafts and the final declaration were transmitted to a witness for signature, etc." *Id.* at *11. "If a witness signed a declaration, a good starting point is to presume that the witness agrees with the content of the declaration apart from who wrote it and how many changes were made or why they were made." *Id.* The panel "ha[d] no problem whatsoever" with attorneys creating "at least the first draft of a declaration" and corresponding with experts on revisions to the declaration. *Id.*

The *Pevarello* panel also explained that questions about declaration preparation were improper because they intrude into matters protected by attorney-client privilege and work product immunity. *Id.* "An attorney needs to be able to freely talk with a client witness or a non-client witness to formulate a litigation strategy…". *Id.* "After-the-fact cross examination inquiries into declaration preparation," the panel continued, "tend to chill an inquiry an attorney might

initially make into what the facts are and who should testify concerning particular facts." *Id.*

Ultimately, the *Pevarello* panel concluded: "[i]n the future, absent a compelling reason, we counsel against any attempt to inquire on cross-examination into how direct testimony declarations came to be prepared." *Id.* at *1.

C. Patent Owner Fails To Mention, Much Less Apply, The Good Cause Standard For Nonroutine Additional Discovery

Because what Patent Owner seeks is not routine discovery, there is a "good cause" standard set forth in 37 C.F.R. § 42.224(a) ("[r]equests for additional discovery may be granted upon a showing of good cause as to why the discovery is needed." 37 C.F.R. § 42.224(a)). The precedential case applying factors in consideration of discovery requests under the "good cause" standard is *Bloomberg Inc. v. Markets-Alert Pty Ltd.*, Case CBM2013-00005 (PTAB May 29, 2013) (Paper 32) (Precedential). Patent Owner, as the moving party, has the burden of proof in establishing entitlement to the requested relief under the good cause standard. *See id.* at 4. Patent Owner fails to mention, much less support its argument by addressing substantively, any of these required factors.

D. The Attorney Work Product Immunity Protects Attorney-Expert Communications in PGRs

For decades after the Supreme Court's *Hickman* decision, courts were divided on whether expert materials were protected by the work product doctrine.

As *Pevarello* demonstrates, the BPAI afforded such protection. Indeed, *Pevarello* disavowed the then-prevailing view in the federal courts that "documents and information disclosed to an expert in connection with the expert's testimony are discoverable by the opposing party," which was based on Fed. R. Civ. P. 26(a)(2) as it existed in 2007. *Id.* at *11. Citing an "August 2006 report of the American Bar Association point[ing] out why an amendment to Rule 26(a)(2) to limit discovery would be in the public interest," the panel reaffirmed the policy against "permitting inquiry into how a direct testimony declaration was prepared." *Id.* at *11-12.

Of course, the practice of the federal courts has been adapted to conform to the rule of *Pevarello*. In 2010, Rule 26 was amended to protect attorney-expert communications and draft expert reports because "routine discovery into attorney-expert communications and draft reports has had undesired effects." Fed. R. Civ. P. 26, 2010 Advisory Committee Notes. These amendments "protect counsel's work product and ensure that lawyers may interact with retained experts without fear of exposing those communications to searching discovery." *Id.* With these amendments to Rule 26, the federal courts' approach to attorney work product is now in harmony with the Board's long-held practice of protecting attorney-expert communications.

E. The Case Relied Upon By Patent Owner Demonstrates That The Attorney Work Product Immunity Protects Attorney-Expert Communications That Patent Owner Seeks Here

The case relied upon by Patent Owner, *Adobe Inc. v. Rah Color Techs. LLC*, IPR2019-00627, Paper 59 at 4-9 (P.T.A.B. Dec. 12, 2019), demonstrates that Patent Owner's Motion should be denied. In *Adobe*, the Board determined that *questions* asked of an expert witness relating to "the underlying factual basis for [the expert's] testimony presented in his declarations" should be allowed. *Id.* at 4. (emphasis added). Importantly, the Board noted that "[t]he questions do not seek the substance of any *communication* between [the expert] and Petitioner's attorneys and do not, for example, seek information regarding the specific content of…" the communications. *Id.* at 4-5 (emphasis added). Thus, *Adobe* emphasizes that communications between counsel and witnesses is work product and not the subject of discovery.

V. ARGUMENT

A. Petitioner Should Not Be Compelled To Produce All Communications Involving Deible That Convey Facts, Data, Or Assumptions

Citing *Adobe*, Patent Owner argues that "[c]omplete 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." (Paper 26, 9). Patent Owner is wrong, for several independent reasons.

First, *Adobe* not only does not support Patent Owner's argument, it completely refutes it. As explained above, in *Adobe*, the Board determined that *questions* could be asked of an expert witness relating to underlying facts. However, even questions cannot seek the substance of any communications between the expert and attorneys. Not only did the Board not compel discovery of any communications, which is what Patent Owner seeks here, it emphasized that communications between counsel and witnesses are off limits. Indeed, even questions about the substance of such communications cannot be asked.

Second, work product immunity shields the communications sought by Patent Owner. *Hickman v. Taylor*, 329 U.S. 495 (1947). That immunity shields work product regardless of the form it is in, and particularly in the form of written communications. *Id.* at 511. "Not even the most liberal of discovery theories can justify unwarranted inquiries into the files and the mental impressions of an attorney." *Id.* at 510; *Carlin v. DairyAmerica, Inc.*, No. 109CV00430AWIEPG, 2017 WL 3896327, at *3 (E.D. Cal. Sept. 6, 2017) (rejecting discovery request for communications with witnesses and noting that "[t]he Court agrees with Plaintiffs and holds that all documents between Plaintiffs' counsel and witnesses…obtained in anticipation of litigation are protected under work product immunity…").

"[C]ommunications with witnesses…were done in preparation of their declarations…and are protected by the work product doctrine." *Id.* Work product extends specifically to communications between a party's attorney and an expert and the expert's assistants. *In re Application of Republic of Ecuador*, 280 F.R.D. 506, 514 (N.D. Cal. 2012), *aff'd sub nom. Republic of Ecuador v. Mackay*, 742 F.3d 860 (9th Cir. 2014).

> Communications between [expert] Kelsh and his assistants and Chevron's attorneys are expressly protected as work product under Rule 26(b)(4)(C). See FED. R. CIV. P. 26(b)(4) (2010 Advisory Committee Notes) ("Protected 'communications include those between the party's attorney and assistants for the expert witness."). Because the term 'expert' includes assistants of the expert, such internal communications, as well as those between [expert] Kelsh's assistants and Chevron attorneys, are protected work product.

Id.; see also *United States v. Veolia Environnement N. Am. Operations, Inc.*, No. CV 13-MC-03-LPS, 2014 WL 5511398, at *6 (D. Del. Oct. 31, 2014), amended, No. CV 13-MC-03-LPS, 2014 WL 6449973 (D. Del. Nov. 17, 2014) ("Attorney-expert communications…These documents contain communications between [ ] counsel and the two testifying experts…These documents are protected, as each contains attorney mental impressions and theories regarding the creation of the [ ] report, and each comes within the scope of Rule 26(b)(4)(C)'s protection for an attorney's mental impressions when contained in a communication with a testifying expert.").

Third, even if work product immunity did not shield the communications sought by Patent Owner, the Board's rules explicitly exclude from "routine discovery" anything "otherwise protected by legally recognized privileges such as attorney-client or attorney work product." 37 C.F.R. § 42.51(b)(1)(iii).

Fourth, because the discovery Patent Owner seeks is not routine, Patent Owner must make a showing of "good cause" as to why the discovery is needed, as set forth in 37 C.F.R. § 42.224(a). The precedential case applying factors in consideration of discovery requests under the "good cause" standard is *Bloomberg Inc. v. Markets-Alert Pty Ltd.*, Case CBM2013-00005 (PTAB May 29, 2013) (Paper 32) (Precedential). By failing to apply or even address the governing factors, Patent Owner necessarily fails to satisfy its burden to compel non-routine discovery.

Fifth, the facts do not support Patent Owner's argument. That is because, as explained below, the deposition testimony of both Mr. Bushman and Dr. Deible demonstrate that the communications sought do not include facts, data, or assumptions that Dr. Deible considered. Without question, though, those communications incorporate counsel's mental impressions and strategy, and drafts. (*See* Exhibit 1039, Privilege Log). Each communication falls squarely within work product immunity.

Mr. Bushman did not provide any input to Dr. Deible's opinions (EX2010, 200:25-201:3), did not provide any input as to how Dr. Deible was to run any tests that Dr. Deible performed (*Id.* at 202:6-20), and did not provide any input regarding how to run the tests or how Dr. Deible did the tests (*Id.*). Mr. Bushman also testified that he did not provide any feedback regarding Dr. Deible's results, and had no recollection of providing any such feedback (*Id.* at 205:4-9), and does not recall even being asked to interpret any test results (*Id.* at 205:22-24), to provide any answers to any questions about any test results (*Id.* at 206:11-13), or to provide information that any testing methodology should be changed (*Id.* at 213:14-17; 213:20-214:3).

In like manner, Dr. Deible testified that he never provided any drafts of his declaration to Mr. Bushman (EX2011, 32:9-11), and has no recollection of discussing Petitioner's test method with Mr. Bushman (*Id.* at 36:14-19), or any conversations involving Mr. Bushman or anyone at Petitioner regarding the caustic wash test method that he used (*Id.* at 71:5-9).

In terms of caustic wash test results, Dr. Deible did not provide any results to Mr. Bushman before submitting his declaration (*Id.* at 38:4-18) and did not have any discussions with Mr. Bushman regarding how to interpret the caustic wash test results (*Id.*). Indeed, Dr. Deible did not recall ever having any discussions

regarding how to interpret any of the results of any testing on either the Gatorade label or the Febreze label. (*Id.* at 38:13-18).

Sixth, the facts, data, and assumptions relied upon by Dr. Deible have already been fully disclosed. Dr. Deible identified all such information in his declaration, noting each time he relied upon input from counsel and Mr. Bushman. (*See e.g.*, EX1014, ¶¶14, 55). Patent Owner admits that Dr. Deible included all such information in his declaration, and further admitted that Patent Owner questioned Dr. Deible about the information during his deposition. (Paper 26, 4-5).

B. Petitioner Has No Silver Ink Testing To Produce

Exhibit 1019 is a technical data sheet for Watson Standard silver ink, who was an ink supplier to Petitioner. (EX2010, 99:1-18). Exhibit 1019 demonstrates that the ink incorporated in the Gatorade label passed the testing established by the Association of Postconsumer of Plastic Recyclers. *Id.* Watson Standard, the supplier of the ink, issued Exhibit 1019 and provided it to its customer, Petitioner. In particular, Exhibit 1019 is Watson Standard's statement. (EX2010, 100:23-101:3). As such, it is Watson Standard that presumably submitted the data required to obtain APR Guidance recognition, not Petitioner. *Id.* Counsel has inquired of Mr. Bushman regarding this matter, and Mr. Bushman indicates that he does not believe that Petitioner conducted any "such testing to confirm Watson

Standard's claims that the ink passes recyclability/bleed testing as stated in EX1019," as requested by Patent Owner.

VI. CONCLUSION

Based on the foregoing, Petitioner respectfully requests that Patent Owner's Motion to Compel Expert Declarant Communications be denied.

Respectfully submitted,

Dated: December 17, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on December 17, 2025, a complete and entire copy of Petitioner's Response to Patent Owner's Motion to Compel was provided via email to the Patent Owner by serving the email correspondence addresses of record as follows:

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