

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-in-Part and Denying-in-Part Patent Owner's
Motion to File a Reply Brief

Granting Patent Owner's Motion to Strike Portions of Opposition Brief

Granting Petitioner's Motion to File an Amended Opposition Brief

Ordering Production of Documents for *In Camera* Review

37 C.F.R. §§ 42.5, 42.52

Patent Owner filed an authorized motion to compel (“Mot.” or “Motion,” Paper 26), to which Petitioner filed a response (“Mot. Resp.” or “Response”, Paper 27). Patent Owner now requests leave to file a five-page reply to address issues raised in the Response and to clarify the scope and the basis of the discovery requests at issue. Ex. 3003. In particular, Patent Owner states that the reply would (1) clarify the nature of discovery requests, (2) address the good cause standard, (3) respond to work product assertions, (4) clarify scope of routine discovery, (5) clarify silver ink testing requests, and (6) address references to 37 C.F.R. § 42.51(b)(2) set forth in its motion. Patent Owner also requests that pages 16–18 of the opposition be stricken for exceeding the 15 page limit. *Id.*

Petitioner opposes Patent Owner’s requests. Ex. 3003. Petitioner also requests leave to file an amended response, limited to 15 pages that would only delete information from the original opposition (Paper 27). Ex. 3003, 2; Ex. 3004.

I. ANALYSIS

A. *Pages 16–18 of Petitioner’s Response*

Patent Owner requests that pages 16–18 of Petitioner’s Response be stricken as they are over the page limit. Petitioner does not provide a reason why it filed a response greater than 15 pages, other than stating that the length of its response was an “oversight,” and requests leave to file an amended response of no more than 15 pages. Ex. 3003. Petitioner states that the amended response would be limited to 15 pages, would only delete information from the original paper, and no new arguments would be presented. *Id.*

We grant both parties' request. Petitioner's response is over the 15 page limit set forth in our rules and striking the additional pages is an appropriate remedy. *See* 37 C.F.R. § 42.24. Thus, we grant Patent Owner's request to strike these "over-limit" pages. However, in the particular circumstances presented here, we recognize that the record may benefit if some of the statements contained in these "over-limit" pages remain in the record. Thus, we also grant Petitioner's request to file an amended response limited to 15 pages that only deletes information from the original paper. Petitioner's amended response shall be filed **within 3 business days**.

B. Silver Ink Testing

In its Motion, Patent Owner requested "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." Mot. 7 (emphasis added); *see also id.* at 12–13. Patent Owner also notes that Petitioner agreed, during the December 3, 2025 teleconference with the Board, to look for and produce "any testing performed by [Petitioner] related to the silver ink" used in the Gatorade label. *Id.* at 12. In its email request, Patent Owner seeks leave to clarify that the request for silver ink testing is not limited to testing conducted in preparation of the Petition, but includes any relevant testing performed by or for Petitioner that is inconsistent with Petitioner's positions. Ex. 3003, 2.

Patent Owner's request is granted. Although Petitioner states in its Response that "Petitioner fully addressed Patent Owner's request regarding silver ink" (Ex. 3003, 2), the Response merely confirms that "no silver ink testing was conducted in preparing the Petition." Mot. Resp. 3.

The Response further states that Petitioner’s counsel “inquired of Mr. Bushman”¹¹ and that Mr. Bushman “indicates that he “does not believe that Petitioner conducted any ‘such testing to confirm [third party] Watson Standard’s claims that its silver ink passes the recyclability/bleed testing stated in EX1019.’” Mot. Resp. 18–19. The Board, however, does not understand Patent Owner’s request to be limited to just the particular recyclability/bleed testing stated in Exhibit 1019, but rather is directed to “any test protocols or results of any analysis” relating to recyclability of the silver ink identified by Exhibit 1019. Mot. 3; *see also id.* at 12 (discussing *any* silver ink testing performed by Petitioner). As it appears the parties have a different understanding as to what Patent Owner’s request relating to the recyclability of the silver ink entails, Patent Owner is authorized to file a reply further clarifying its request and the types of documents encompassed by its request.

C. Work Product Assertions

Patent Owner request leave to respond to Petitioner’s assertion of work product privilege to “clarify that facts, data, and assumptions provided to and considered by an expert are not protected.” Ex. 3003, 1. This request is denied as the Board does not require clarification as to what information is purportedly protected by work product privilege. Petitioner, however, is ordered to provide the documents identified in the privilege log (Ex. 1039) for *in camera* inspection **within three business days**.

¹¹ The parties are reminded that routine discovery of “inconsistent” information under 37 C.F.R. § 42.51(b)(1)(iii) is not limited to information known to any one particular person, but rather extends to information known to “inventors, corporate officers, and persons involved in the preparation or filing of the documents or things.”

D. Patent Owner's Remaining Requests

Patent Owner's remaining requests to address several additional points raised in the Response are denied. Ex. 3003, 1–2. These requests are either to clarify what was stated in Patent Owner's Motion or to address or clarify legal standards raised in the Motion. *Id.* The Board is capable of addressing these issues without additional briefing.

Accordingly, it is:

ORDERED that pages 16 and above of Petitioner's Response (Paper 27) are considered stricken from the record;

FURTHER ORDERED that Petitioner's request to file an amended response limited to 15 pages that only deletes information from the original Response is granted and any such amended response shall be filed **within 3 business days**.

FURTHER ORDERED THAT Patent Owner may file a reply brief to Petitioner's Response (Paper 27) to clarify the documents that it seeks relating to silver ink testing and that the reply brief is limited to no more than 3 pages;

FURTHER ORDERED that Petitioner shall provide the documents identified in its privilege log (Ex. 1039) for *in camera* inspection **within three business days**; and

FURTHER ORDERED that Patent Owner's remaining requests are denied.

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