

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 REPLY TO MOTION TO COMPEL

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

Pursuant to the Board's Order Granting In-Part Patent Owner's Motion to File a Reply Brief, Patent Owner respectfully requests that the Board compel discovery of any testing performed by or for Petitioner related to the recyclability of the silver ink described in EX1019, which was allegedly used for the Gatorade Label.

Petitioner relies on statements in EX1019 to establish that the Gatorade label is allegedly recyclable as claimed by the '422 Patent. Specifically, Petitioner points to the statement, "This ChemSHIELD product passes recyclability/bleed testing set forth in the protocol established by the Association of Postconsumer of Plastic Recyclers." EX1019; *see also* Pet. at 31; EX1013 ¶ 57; EX1014 ¶ 79; EX2010 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"). Yet, nowhere in the Petition or in either of Petitioner's declarations does Petitioner explain what "recyclability/bleed testing" entails or what protocol or endpoints are used to determine whether an ink passes such testing. When asked in his deposition, Mr. Bushman testified that he does not even know what the statement means. EX2010 at 103:12-17 ("Q. ... Sitting here today, you don't know what the basis is for Watson Standard claiming that it met the recyclability/bleed testing standards, correct? A. Correct.").

Patent Owner requests that the Board compel production of any document, email, test data, or test result that describes any recyclability/bleed testing performed

on the silver ink, regardless of who performed the testing. Initially, Petitioner inappropriately limited its search to testing performed in preparation of the Petition. Paper 24 at 2. In its Response to Patent Owner's motion to compel, Petitioner merely stated that, "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'" Paper 27 at 18-19. As the Board noted, Petitioner's search is insufficient. For example, Mr. Bushman is no longer even an employee of Petitioner, EX2010 at 7:22-8:4, therefore, Petitioner's counsel admittedly did not even ask *Petitioner* to search for such testing. Regardless, Patent Owner's request is not limited to testing performed by Petitioner. Instead, Patent Owner requests any documents that refer to *any* testing related to the silver ink recyclability/bleed testing in Petitioner's possession or control. For example, if there are any documents or emails that describe the testing performed by Watson Standard, MCC, Fort Dearborn, or any other third parties on behalf of Petitioner, those documents should also be produced. 37 C.F.R. § 42.51(b)(1)(iii) ("This requirement extends to inventors, corporate officers, and persons involved in the preparation or filing of the documents or things.").

Bleed testing is often 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”). Therefore, this testing is likely inconsistent with the positions taken by Petitioner in this case – *i.e.*, that EX1019 supports the conclusion that the Gatorade label features inks that wash cleanly off the label. Pet. at 31; EX2010 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). Good cause exists for this request because: (1) Patent Owner has adduced specific evidence that suggest that testing exists and would be useful to show whether or not the ink washes cleanly off the label as Petitioner alleges (2) the requested testing does not seek litigation positions but instead seeks information related to the underlying bases for Petitioner’s positions in the current PGR proceeding (*i.e.*, that the silver ink washes cleanly off the PET film), (3) such testing would be exclusively in Petitioner’s possession or control and therefore Patent Owner has no ability to generate the information by other equivalent means, (4) Patent Owner has provided easily understandable instructions for searching for and producing such information, and (5) the requests are not overly burdensome and Petitioner has not adduced any argument to the contrary. *Bloomberg, Inc. v. MarketsAlert Pty. Ltd.*, CBM2013-00005, Paper 32 (May 29, 2013).

Accordingly, Patent Owner requests that the Board order Petitioner to search for and produce any documents or things in its possession or control that refer to or describe any recyclability/bleed testing performed on the silver ink described in EX1019 regardless of who performed the testing.

Dated: December 31, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Patent Owner's Reply to Motion to Compel was served on December 31, 2025, via electronic mail directed to counsel of record for the Petitioner:

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