

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MULTI-COLOR CORPORATION,
Petitioner,

v.

BROOK & WHITTLE LTD,
Patent Owner.

PGR2025-00025
Patent 11,961,422 B2

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

McGRAW, *Administrative Patent Judge*.

ORDER

Granting Patent Owner's Motion for Routine Discovery
Denying Patent Owner's Motion for Additional Discovery
37 C.F.R. §§ 5, 42.51

Patent Owner, Brook & Whittle Ltd., filed an authorized motion to compel discovery. Paper 26 (“Motion” or “Mot.”). Petitioner, Multi-Color Corp., filed a corrected opposition (Paper 29, “Opposition” or “Opp.”) complying with page limit requirements, to which Patent Owner filed an authorized reply (Paper 30, “Reply Brief” or “Reply”).

For the reasons discussed below, we deny Patent Owner’s motion for additional discovery and grant Patent Owner’s motion for routine discovery .

A. Background and Requested Discovery

Petitioner asserts that the challenged claims of the ’422 patent, which are directed to a recyclable shrink label, are anticipated or rendered obvious by, *inter alia*, Petitioner’s commercially available Gatorade label and that the challenged claims are indefinite under 35 U.S.C. § 112. Paper 2 (“Petition” or “Pet.”), 3.

The independent claims require that the “recyclable shrink label is recyclable with a PET container.” *See, e.g.*, Ex. 1001, 28:36–37. Petitioner states that the ’422 patent discloses tests used to determine if a label is recyclable. *See* Pet. 30 (citing Ex. 1001, 6:61–64, 11:29–53; Ex. 1012 (RD-TM-210-4, a caustic wash test dated Dec. 2018 and revised Dec. 18, 2024 by Mr. Bushman). For example, Petitioner asserts, *inter alia*, that a label is “considered recyclable if no inks are retained on the film after a caustic wash cycle typically used in PET reclaiming processes.” Pet. 30. To support its contention that the Gatorade label is “recyclable with a PET container,” Petitioner asserts that the label is a “PET film and a washable ink system designed to meet the requirements of recyclability per the Association of Plastic Recyclers (“ARP”). Pet. 6, 14 (citing Ex. 1013 ¶¶ 53–30). Petitioner further asserts that a label is “considered recyclable if no inks

are retained on the film after a caustic wash cycle typically used in PET reclaiming processes.” Pet. 30 (citing Ex. 1001, 6:61). Petitioner provides declaration testimony of Michael Deible that “the ink [of the Gatorade label] is being removed during the caustic wash cycle” and that “the ink is readily separated from the flake mixture during the sieving process and is not staining or dyeing the PET flakes.” Pet. 30–31 (citing Ex. 1004 ¶ 77, Image 16).

Petitioner further states that the “Gatorade Label is an SKC Ecolabel™ sleeve label” and that the “APR, the Association of Plastic Recyclers, has recognized this label as meeting or exceeding APR’s Critical Guidance Protocol for Clear PET Articles with Labels and Closures Document requirements.” Pet. 31 (citing Ex. 1013 (Bushman Declaration) ¶ 47; Ex. 1016; Ex. 1018 (APR letter regarding SKC Ecolabel)). Petitioner also states that the silver ink used with the Gatorade Label “passes recyclability/bleed testing set forth in the protocol established by the Association of Postconsumer Plastic Recyclers.” Pet. 31 (citing Ex. 1013 ¶ 48; Ex. 1019 (Technical Data Sheet for SB/INK-98004 Silver Ink)).

Patent Owner requests Petitioner produce documents relating to recyclability testing of the Gatorade Label. In particular, Patent Owner requests that Petitioner be ordered to produce:

- (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.

Mot. 6–7. Patent Owner further requests that Petitioner “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. §§ 42.62(a), 42.51(b). Mot. 2.

Patent Owner asserts it is entitled to discovery of this information as (1) routine information that is inconsistent with positions taken by Petitioner; as well as (2) additional discovery as evidence directly related to factual assertions advanced by either party. Mot. 7 (citing 37 C.F.R. §§ 42.51(b)(1)(iii), 42.51(b)(2)(i)). Petitioner further asserts that it is entitled to the facts or data underlying Petitioner's expert's opinion. *Id.* (citing 37 C.F.R. § 42.65(a)).

B. Legal Standards

In an *inter partes* review, a party must serve as “routine discovery”

“relevant information that is inconsistent with a position advanced by the party during the proceeding.” 37 C.F.R. § 42.51(b)(1)(iii). Unless previously served, such information must be served “concurrent with the filing of the documents or things that contains the inconsistency.” *Id.* The requirement of routine discovery “extends to inventors, corporate officers, and persons involved in the preparation or filing of the documents or things” but “does not make discoverable anything otherwise protected by legally recognized privileges such as attorney-client or attorney work product.” *Id.*

In a post-grant review proceeding, requests for additional discovery beyond routine discovery “may be granted upon a showing of good cause why the discovery is needed” and the additional discovery “is limited to evidence directly related to factual assertions advanced by either party in the proceeding.” 37 C.F.R. § 42.224; *see also* 37 C.F.R. § 42.51(b)(2)(i).

We consider the following factors (the “*Garmin* factors”) in determining whether good cause for the requested discovery has been shown:

- (1) whether the movant has provided a specific factual reason for reasonably expecting that the discovery will be “useful,” i.e., “favorable in substantive value to a contention”;
- (2) whether the requests seek the other party’s litigation positions and the underlying basis for those positions;
- (3) the movant’s ability to generate equivalent information by other means;
- (4) whether the requests have easily understandable instructions; and
- (5) whether the requests are overly burdensome to answer.

See Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC, IPR2012-00001, Paper 26 at 6–7 (PTAB Mar. 5, 2013) (precedential).

Rule 42.65, cited by Patent Owner (Mot. 7, 9–11), relates to expert testimony before the Board. The rule states that expert testimony “that does

not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.” 37 C.F.R. § 42.65(a). The rule further provides that if a party relies on a technical test or data from such a test, the party must provide an affidavit explaining:

- (1) Why the test or data is being used;
- (2) How the test was performed and the data was generated;
- (3) How the data is used to determine a value;
- (4) How the test is regarded in the relevant art; and
- (5) Any other information necessary for the Board to evaluate the test and data. 37 C.F.R. § 42.65(b); *see also* Fed. Rule Civ. P. 26(a)(2) (providing different disclosure requirements before a district court).

As the moving party, Patent Owner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c).

C. Additional Discovery

Patent Owner seeks production of the requested information as “additional discovery” under 37 C.F.R. § 42.65(b)(2). Mot. 7. We deny this request.

As noted above, Patent Owner must show good cause why the discovery is needed. Patent Owner has not presented sufficient reasoning as to why there is good cause that the requested discovery is necessary. *See generally* Mot. Indeed, Patent Owner’s Motion does not address the *Garmin* factors, let alone even mention the good cause standard. *See* Mot.

In its Reply Brief, Patent Owner asserts that good cause exists for production of documents and things “that refer to or describe *any recyclability/bleed testing* performed on the silver ink described in EX1019 regardless of who performed the testing” 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.

Reply 3–4 (emphasis added).

Patent Owner, however, does not sufficiently explain how *any testing* referring or relating to silver ink recyclability or bleed testing, including test data that is *consistent* with Petitioner's contentions, would be of substantive value to the proceeding. As such, Patent Owner has not sufficiently shown good cause for production of the broad category of documents requested under the standard for additional discovery.

D. Routine Discovery

Even if Patent Owner has not met its burden for additional discovery, this does not end our inquiry, because parties are required to “serve relevant information that is inconsistent with a position advanced by the party during the proceeding” so long as they are known to the party to be inconsistent, has not been previously served, and are not otherwise protected by legally recognized privileges such as attorney-client privilege or attorney work

product. 37 C.F.R. § 42.51 (b)(1)(iii).

An order requiring production of “any other relevant information of which [Petitioner] is aware that is inconsistent with a position it advanced” in this proceeding should be unnecessary because the requirement of 37 C.F.R. § 42.51 (b)(1)(iii) is self-executing. Nevertheless, because the parties dispute what information should have been produced as routine discovery, we address this issue below to provide guidance to the parties.

As noted above, Petitioner argues that its Gatorade Label is recyclable with a PET container. *See, e.g.,* Pet. 30. Thus, any evidence that the Gatorade Label is not recyclable with a PET container would be information that is inconsistent with a position that it advanced during this proceeding and should be produced as routine discovery. This would include any test results known to Petitioner, including any test results by Dr. Deible and Mr. Bushman, that the Gatorade Label is not recyclable with a PET container.

Similarly, Petitioner further argues that caustic wash testing is used to determine the recyclability of labels. *See, e.g., id.* (stating a label is considered recyclable if no inks are retained on the film after a caustic wash cycle typically used in PET reclaiming processes). Therefore, evidence that ink, including silver ink, on the Gatorade Label is not removed during caustic wash cycle tests typically used in PET reclaiming processes would be information that is inconsistent with a position advanced during this proceeding. To the extent Petitioner asserts that there is evidence that ink is not removed from its Gatorade Label during a caustic wash cycle test but that such tests results need not be produced because the test is not a “caustic wash cycle test typically used in PET reclaiming processes,” Petitioner must affirmatively so state.

Additionally, the Gatorade Label contains silver ink from Watson Standard that Petitioner asserts is recyclable. *See* Pet. 31 (citing Ex. 1013 ¶ 48; Ex. 1019). Petitioner asserts that Exhibit 1019 is a technical data sheet for the Watson Standard silver ink that “claims that the ink passes recyclability/bleed testing” and that “it is Watson Standard that presumably submitted the data required to obtain APR Guidance recognition, not Petitioner.” Opp. 15. Counsel for Petitioner further asserts that it “inquired of Mr. Bushman” and that Mr. Bushman “indicates that he does not believe” that Petitioner conducted any such testing to confirm that Watson Standard’s claims that the silver ink passes the recyclability/bleed testing as stated in Exhibit 1019. *Id.* The standard for what information must be produced as routine discovery is not limited to that information known to Mr. Bushman. Nor is it limited to testing performed for purposes of filing a petition. Counsel must confirm that it has inquired of Petitioner whether it is aware of information that the silver ink used in its Gatorade Label fails to pass the recyclability/bleed testing or that the Gatorade label is not recyclable with a PET container.

E. Work Product Privilege

During a conference call between the parties to discuss Patent Owner’s request for authorization to file its motion to compel discovery, Petitioner argued that some of its documents are protected by attorney client or work product privilege but agreed to provide a privilege log of these documents and to produce the listed documents for *in camera* inspection. We have reviewed these produced documents (Exs. 1040–1043) and determine that Document No. 3 which is an email and attached curriculum vita, is not privileged. Petitioner is ordered to enter a public version of this

document into the record. We determine that the drafts of Dr. Deible's reports are protected by the work product doctrine and need not be produced, with the following caveat.

Some of these draft reports contain photographs depicting test results, which appear to be the same photographs that were provided as attachments to Dr. Deible's final declaration. To the extent these photographs are the same photographs that already have been provided to Patent Owner as attachments to Dr. Deible's declaration, the photographs need not be produced again. However, if the photographs reflect test results that have not yet been produced to Patent Owner, then such test results are not protected under the work product doctrine. *See Spectrum Solutions v. Longhorn Vaccine & Diagnostics, LLC*, IPR2021-00847, Paper 112, 133–134 (PTAB May 3, 2023) (citing *EchoStar Comms Corp.*, 448 F.3d 1294, 1301 (Fed. Cir. 2006) (noting that the work product doctrine is not absolute and generally allows discovery of factual or non-opinion work product)). None of the remaining documents contained in Exs. 1040–1043 need be produced.

To the extent that Petitioner may contend that any other documents that would otherwise need to be produced as routine discovery need not be produced because they are protected by the work product privilege, we note that the work product privilege “cannot be used to shield factual information from discovery that is inconsistent with positions taken by a party before the Board” because “shielding the factual information from the Board violates the duty of candor and good faith the Office.” *Id.* at 134 (internal citations omitted).

It is hereby:

ORDERED that Petitioner file Document No. 3, contained within Exhibit 1040, as a new exhibit available to the public;

FURTHER ORDERED that Patent Owner's motion for additional discovery is denied;

FURTHER ORDERED that Petitioner is ordered to comply with its obligations to produce routine discovery within 3 business days;

FURTHER ORDERED that Petitioner shall provide a privilege log for any documents that it asserts are protected by privilege (other than those already listed on a submitted privilege log) within three business days.

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