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Sent: Wednesday, June 24, 2026 4:35 PM

To: Trials <Trials@USPTO.GOV>

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Subject: MCC v. B+W, PGR2025-00025 -- Request for Leave to File a Motion to Strike

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Dear Administrative Patent Judges New, McGraw, and McGee,

Patent Owner Brook + Whittle Limited writes to request a conference call with the Board to discuss a request for leave to file a motion to strike in PGR2025-00025.

Patent Owner seeks to strike two species of argument from the Reply (Paper 54) and related filings. First, Patent Owner seeks to strike portions of Dr. Deible's declaration—and the parts of the Reply relying on said portions—related to Mitchell, on the grounds that it is undisputed Dr. Deible did not review Mitchell prior to the filing of the Petition. See, e.g., Paper 54 at 10–11; EX1046 ¶¶ 51–52, 61, 81. Second, Patent Owner seeks to strike new indefiniteness arguments from the Reply (and the corresponding support from EX1046 and EX1047). Specifically, Patent Owner believes that several of the indefiniteness arguments in the Reply are neither disclosed in the Petition (Paper 2) nor responsive to arguments in Patent Owner's Response (Paper 34). For example, on reply, Petitioner argues that APR recognition is inherently subjective due to its three-member-panel-nature. See, e.g., Paper 54 at 18–19, 21, 24. But the briefing predating the Reply (and the Institution Decision) never discussed APR panel processes, its composition, or any purported subjectivity arising therein. As another example, on reply, Petitioner also refers to additional APR standards that were not disclosed in the Petition. See, e.g., Paper 54 at 19, 23–24. Patent Owner's position is that these exemplary arguments are untimely, out-of-scope, and nonresponsive.

Patent Owner has notified Petitioner Multi-Color Corporation ("MCC") of its intent to seek leave. Petitioner opposes Patent Owner's request.

Petitioner opposes Patent Owner's request because Patent Owner's allegations are not only incorrect, but certainly do not present the rare circumstance warranting the "exceptional remedy" of a motion to strike. Rather, Patent Owner seeks to strike arguments and portions of declarations that are responsive to positions advanced in Patent Owner's Response and supporting expert testimony. With respect to Mitchell, Patent Owner seeks relief that is substantially broader than the premise of its asserted concern. With respect to indefiniteness, Petitioner's Reply (Paper 54) does not present a new ground or theory, but instead responds to positions advanced in Patent Owner's Response (Paper 34), including Patent Owner's claim construction and indefiniteness arguments concerning the various descriptions and tests for recyclability discussed in the '422 patent and Patent Owner's contention that those descriptions are consistent with its proposed construction. See Paper 34 at 14. The Reply likewise responds directly to testimony from Patent Owner's experts regarding those descriptions and tests. Pursuant to well-established Board precedent, the portions of the Reply and supporting declarations identified by Patent Owner fall squarely within the proper scope of reply because they address issues raised by Patent Owner and elaborate on grounds already presented in the Petition.

If the Board agrees that a call is necessary, both parties are available on June 30 and July 1–2 between 9:00 a.m. and 11:00 a.m. ET each day.

Respectfully,

Todd Baker

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