

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 Request for Authorization to
File a Motion to Strike
37 C.F.R. § 42.20

On June 25, 2020, Patent Owner submitted an email for a request for leave to file a motion to strike. Ex. 3006. In particular, Patent Owner requests authorization to file a motion to strike portions of two separate arguments from Petitioner's Reply (Paper 54) and related filings.

First, Patent Owner seeks to strike portions of Petitioner's declarant's declaration testimony and the parts of the Reply relying on that testimony that relate to the Mitchell reference (Ex. 3002). Ex. 3006, 1. Patent Owner states that "it is undisputed" that Petitioner's declarant Dr. Deible "did not review Mitchell prior to the filing of the Petition." Ex. 3006, 1 (citing Paper 54 at 10–11; Ex. 1046 ¶¶ 51–52, 61, 81). Petitioner responds that Patent Owner seeks relief that is substantially broader than the premise of its asserted concern. Ex. 3006, 2

Second, Patent Owner seeks to strike indefiniteness arguments from the Reply (and the corresponding supporting material from Exhibits 1046 and 1047). Ex. 3006, 1. 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). Patent Owner asserts that, for example, Petitioner's argument "that APR recognition is inherently subjective due to its three-member-panel-nature" is new as none of briefing that predates the Reply or the Institution Decision discussed APR panels. Ex. 3006 (citing Paper 54 at 18–19, 21, 24). Patent Owner also asserts that Petitioner refers to additional APR standards that were not disclosed in the Petition. Ex. 3006, 2 (citing Paper 54 at 19, 23–24). Patent Owner's position is that these exemplary arguments are untimely, out-of-scope, and nonresponsive.

Petitioner states that its Reply does not present a new ground or theory, but instead responds to positions advanced in Patent Owner's Response, including Patent Owner's assertion that its indefiniteness arguments are consistent with its proposed construction. Ex. 3006, 2 (citing Paper 34, 4).

After considering the respective positions of the parties and reviewing the relevant portions of Petitioner's Reply, Patent Owner Response, and exhibits cited therein, we determine that briefing on a motion to strike would be helpful to the panel.

Accordingly, we authorize Patent Owner to file a motion to strike, not exceeding seven pages, no later than July 8, 2026. We also authorize Petitioner to file an opposition to the motion to strike, not exceeding seven pages, no later than July 15, 2026.

No conference call is necessary.

ORDER

Accordingly, it is:

ORDERED that Patent Owner is authorized to file a motion to strike portions of Petitioner's Reply and associated exhibits no later than July 8, 2026;

FURTHER ORDERED that Petitioner is authorized to file, no later than July 15, 2026, an opposition to any motion to strike Petitioner files; and

FURTHER ORDERED that both the motion to strike and the opposition shall be limited to seven pages.

PGR2025-00025
Patent 11,961,422 B2

For PETITIONER:

Brett Schatz
Louis Sitler
WOOD, HERRON & EVANS LLP
bschatz@whe-law.com
lsitler@whe-law.com

For PATENT OWNER:

W. Baker
KIRKLAND & ELLIS LLP
todd.baker@kirkland.com