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 MOTION TO STRIKE

TABLE OF CONTENTS

I. INTRODUCTION 1

II. LEGAL STANDARD 3

III. ARGUMENT 3

A. Dr. Deible's New Mitchell-Based Opinions Should be Struck 3

B. Petitioner's "Subjective" APR Arguments Should be Struck 4

IV. CONCLUSION 7

All emphasis added unless otherwise noted

TABLE 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	*Brook + Whittle LTD v. Nestle USA, Inc. et al.*, 2:24-cv-00735-JRG-RSP, Docket Report, generated May 13, 2025
2007	*Brook + Whittle LTD v. Nestle USA, Inc. et al.*, 2:24-cv-00735-JRG-RSP, D.I. 16 (Docket Control Order)
2008	*Brook + Whittle LTD v. Nestle USA, Inc. et al.*, 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	*Brook + Whittle LTD v. Nestle USA, Inc. et al.*, 2:24-cv-00735-JRG-RSP, D.I. 51 (Order granting D.I. 50)
2010	Deposition Transcript of Mr. Craig Bushman
2011	Deposition Transcript of Dr. Michael Deible
2012	Declaration of Dr. Maureen Reitman
2013	Declaration of Dr. Scott Phillips
2014	"Gatorade and Cheetos are Among the Pepsi Products Getting a Natural Dye Makeover," NY Post
2015	"Can I Drink Gatorade Past the Best Before Date on the Bottle," PepsiCo
2016	US Patent Application No. 2025/0273094
2017	"Nesquik Makes Bottles Easier to Recycle for Consumers," Nestle
2018	Email from A. Leonard (Nestle) to S. Figueroa (B+W)

EX	DESCRIPTION
2019	PACKAGING EUROPE, *Winners of the Sustainability Awards 2024 Announced!*, (Nov. 14, 2024).
2020	PACKAGING EUROPE, *Sustainability Awards 2024 Finalist Interview: Brook+Whittle's Recyclable, Light-Blocking Shrink Sleeve*, (Sept. 24, 2024).
2021	*AWA Sleeve Label Awards 2024 - Winners* (October 28, 2024)
2022	US Plastics Pact 2023 LinkedIn Post
2023	US Plastics Pact 2024 LinkedIn Post
2024	*Brook + Whittle LTD v. Nestle USA, Inc. et al.*, 2:24-cv-00735-JRG-RSP, Dkt. 1 (Complaint)
2025	*Brook + Whittle LTD v. Nestle USA, Inc. et al.*, 2:24-cv-00735-JRG-RSP, Dkt. 1, Ex B (Claim Chart)
2026	PET-S-09, Evaluation of PET Plaques for Color, Haze and Inclusions
2027	US Patent Application No. 18/667,677 September 3 Remarks
2028	US Patent Application No. 18/667,677 October 24 Final Rejection
2029	"Heat Treatment Impacts on Film Morphology in Biaxially Oriented Polypropylene Films," Kivilcim, Fadime Nulufer, *Food Sci. & Nut.*
2030	"The Amazing Shrink Inks," Packaging Impressions
2031	"Wrinkling-to-delamination Transition in Thin Polymer Films on Compliant Substrates," Nolte, Adam J., *Soft Matter*, 2017
2032	"Review Article: Stress in Thin Films and Coatings: Current Status, Challenges, and Prospects," Abadias, Gregory, *J. Vac. Sci. Technol.* 2018
2033	"Product Decoration Technologies: Sleeving," Finishing & Embellishment
2034	"Brook + Whittle's GreenLabel BlockOut Receives Important Recyclability Recognition and Prequalification," Brook + Whittle
2035	"MCC Receives APR Recognition for recycLabel Roll-Fed Label on PET Bottles," MultiColor Corp
2036	"Trap (printing)," Grokipedia
2037	*Brook + Whittle LTD v. Nestle USA, Inc. et al.*, 2:24-cv-00735-JRG-RSP, Dkt. 112, Claim Construction Order
2038	Plastics Forming Enterprises LLC, Laboratory Report #2467 APR PET Benchmark
2039	Declaration of Steven Dirks in support of Admission *Pro Hac Vice*
2040	Declaration of Tera Stone in support of Admission *Pro Hac Vice*
2041	Declaration of Kelly Tripathi in support of Admission *Pro Hac Vice*

I. INTRODUCTION

Petitioner's Reply seeks a do-over to remedy flawed arguments in its Petition, including in Grounds 2 and 4. These arguments neither elaborate on the Petition nor respond to the POR, but are "entirely new rationales" that should be struck.

First, there is simply no dispute that Dr. Deible ***never reviewed*** the Mitchell reference—the secondary reference in Petitioner's Ground 2 obviousness combination—for the Petition. Rather, he relied solely on the Examiner's discussion of Mitchell, which is incomplete and was overcome. EX1046 ¶135.[1] While Dr. Deible's reply declaration openly admits he had not reviewed Mitchell before, he attempts to circumvent this fundamental flaw and rehabilitate his opinions through a post-hoc review. *See* EX1046 ¶ 135 ("[S]ince [my deposition], I have reviewed Mitchell…My opinions are unchanged."). The Board should strike or disregard each of Dr. Deible's opinions regarding Mitchell—and portions of the Reply relying on them—as an improper runaround. *See id*. ¶¶ 134–147; Paper 54 at 10–11.

Second, the sole indefiniteness argument raised in the Petition was that the '422 patent defined "recyclable" in nine allegedly "disparate ways," thus "making it

[1] PO also concurrently moves to exclude Dr. Deible's entire opinion in light of significant falsities in Dr. Deible's representation in his initial declaration that he ***did*** review Mitchell (and other materials) he later admitted he never reviewed.

impossible for a POSITA to determine a definitive meaning and [] scope." Paper 2 at 53–54. The POR rebutted this incorrect assertion by explaining how the nine statements are consistent and provide reasonable certainty. Paper 34 at 75–97.

Petitioner's Reply introduces a brand-new theory of indefiniteness: that guidance from the independent third-party Association of Plastics Recyclers (APR) is too subjectively administered for a POSITA to reliably apply. Putting aside that label manufacturers, Petitioner's expert, and Petitioner itself, all consistently rely on APR guidance and recognition to establish recyclability, Petitioner's new argument has no foundation in its Petition. Indeed, Petitioner's Reply tacks on these new arguments transparently, in its Sections VII.C – VII.E, all three of which contend that the disclosed APR standards rely on "subjective" criteria—arguments completely contrary to the Petition's reliance on APR standards as sufficient to establish the recyclability of the prior art products in Grounds 1 and 2.

Nor is Petitioner's belated framework responsive to the POR or the Institution Decision, both of which address Petitioner's "disparate standards" framework. Petitioner could have raised these subjectivity arguments in its Petition but chose not to. Indeed, Petitioner's new arguments are largely driven by the purported "personal knowledge" of Petitioner's own former VP of R&D, Mr. Bushman, whose initial declaration did not include these opinions. Raising them now is improper.

These new arguments prejudice PO's ability to respond to them in sur-reply and at the Oral Hearing. The Board should therefore strike the following new arguments and portions of the declarations: Paper 54 at 17–26 (§§ VII.C-E); EX1046 ¶¶ 134–147; EX1047 ¶¶ 25–30, 33–40, 50, 54, 58–59, 63-64, 66–72, 82–86.

II. LEGAL STANDARD

A reply "may not introduce new arguments except to respond to arguments made in the institution decision and certain intervening filings." *Apple Inc. v. MemoryWeb, LLC*, 2025 WL 3494991, at *5 (Fed. Cir. 2025). "[T]he initial petition [must] identify 'with particularity' the 'evidence that supports the grounds for the challenge to each claim.'" *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016); *see also* 35 U.S.C. § 312(a)(3). A reply advancing a "meaningfully distinct contention" from the Petition—rather than elaborating on prior arguments or responding to the POR—exceeds the proper scope of reply and should be struck. *Yita LLC v. MacNeil IP LLC*, 69 F.4th 1356, 1367 (Fed. Cir. 2023); *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1330–31 (Fed. Cir. 2019); *Rembrandt Diagnostics, LP v. Alere, Inc.*, 76 F.4th 1376, 1384–85 (Fed. Cir. 2023).

III. ARGUMENT

A. Dr. Deible's New Mitchell-Based Opinions Should be Struck

There is no dispute that Dr. Deible ***never reviewed Mitchell***—the only secondary reference he relies on for a POSITA's knowledge in Ground 2 (EX2011 at 47:12–48:3)—prior to the Petition's filing. *See* Paper 54 at 10 ("Dr. Deible had

not independently reviewed Mitchell before deposition[.]"); EX1046 ¶ 135; EX2011 at 118:3–9. Instead, Dr. Deible relied solely on the incomplete characterization of Mitchell in the '422 patent prosecution history. EX1046 ¶ 135. Yet, Dr. Deible now attempts to recast his prior opinions in light of his post-hoc review of Mitchell, an exercise that renders his reply opinions brand-new. EX1046 ¶ 135 ("***since then***, I have reviewed Mitchell … [and] [m]y opinions are unchanged."). There is no excuse for Dr. Deible's failure to review Mitchell—his initial opinions purport to ***rely*** on Mitchell and comment on its disclosures despite never actually reading those disclosures for himself. That is, even under a generous reading of Dr. Deible's initial declaration, intentionally misleading. The Board should strike Petitioner's attempt to recast this flawed opinion as a runaround of the PTO rules. *See Trilogy Commc'ns, Inc. v. Times Fiber Commc'ns., Inc.*, 109 F.3d 739, 744–45 (Fed. Cir. 1997) (striking late disclosed opinions where the report "contained new opinions and information and did not merely supplement"); *see* Paper 54 at 10–11; EX1046 ¶¶ 51, 52, 61, 81.

B. Petitioner's "Subjective" APR Arguments Should be Struck

"It is of the utmost importance that petitioners in the [PTAB] proceedings adhere to the requirement that the initial petition identify 'with particularity' the 'evidence that supports the grounds for [each claim's] challenge.'" *Intelligent Bio-Sys.*, 821 F.3d at 1369 (quoting 35 U.S.C. §312(a)(3)). "Fairly interpreted, the Petition proposed a single" (incorrect) indefiniteness theory: the'422 patent defined

"recyclable" in "disparate ways," "making it impossible for a POSITA to determine a definitive meaning." *Henny Penny*, 938 F.3d at 1331; Paper 2 at 53–54.

But now on Reply, Petitioner changes course by broadly arguing for the first time that the statements in the '422 patent specification and the APR guidelines (established by an independent board that Petitioner itself relies on for its prior art invalidity grounds, *see* EX2035) are themselves so inherently subjective that they are incomprehensible to a POSITA. Paper 54 at 18. According to the Reply, APR recognition "is a subjective determination made by a panel of three members" whose "respective backgrounds impact whether APR guidance recognition is provided." *Id*.; *see also id.* at 19, 21, 24. These arguments are new: "the petition says nothing about" subjectivity at all, let alone institutional APR subjectivity. *Henny Penny*, 938 F.3d at 1331. "Nor did [Petitioner] submit any expert testimony with its petition" disclosing those arguments. *Id.* Petitioner certainly could have included these new arguments, as the primary basis for this contention is the opinion of Petitioner's own former VP of R&D (and present declarant) and his alleged APR experience. However, taking such a position in the Petition might have precluded institution based on inconsistent positions—as Petitioner also directly relied upon the APR to establish that certain prior art *was* recyclable for purposes of its prior art arguments. Accordingly, Petitioner "chose which grounds…to assert in its petition and it chose not to assert th[ese]." *Intelligent Bio-Sys.*, 821 F.3d at 1369; EX1013, ¶¶ 67-86.

Petitioner's new argument is not responsive. *See Yita*, 69 F.4th at 1367; *Intelligent Bio-Sys.*, 821 F.3d at 1369–70. The Institution Decision addressed the "disparate standards" theory, but did not raise any issues around the independent alleged subjectivity of those standards. Paper 14 at 24 ("unclear at this stage…whether these standards are consistent"). Similarly, the POR rebutted each of the allegations of "disparate" statements by explaining how they are consistent. *See* Paper 34 at 78–96. PO's explanation that the APR's independent third-party testing parameters are consistent with other statements in the specification does not invite Petitioner to introduce a new theory that APR's institutional processes are inherently subjective, particularly where that new theory rests largely on evidence (Mr. Bushman's alleged personal panel experience) available at the time of the Petition. Moreover, Petitioner's new subjectivity theory is ***irreconcilable*** with its own Ground 1 ***reliance*** on APR recognition (of an unrelated label) to support its argument that the Gatorade label is recyclable. *See* Paper 2 at 31. Petitioner cannot credibly argue that APR guidance is so inherently biased and unworkable as to render its recognition meaningless, while simultaneously ***relying*** on APR recognition as its primary evidence of the alleged recyclability of the prior art.

Worse still, the Reply now challenges additional APR tests that were not discussed in the Petition or the '422 patent specification. *See* Paper 54 at 23–24. For example, the Reply raises for the first time that the wash water evaluation, clumping

tests, and RES-LBL-2 are subjective and unworkable. *Id*. at 18-20, 25. These also are not responsive to the POR, which states that APR guidance documents may be consulted, not that they must each be individually determinative. Paper 34 at 86 ("POSITA ***could*** follow [APR guidance]"). This theory goes well beyond contending that the '422 patent supplies multiple disparate definitions and criticizes the entire APR guidance framework as an unknowable array of tests. *Henny Penny*, 938 F.3d at 1331; *Intelligent Bio-Sys.*, 821 F.3d at 1369.

Requiring PO to address these belated arguments in sur-reply is unduly prejudicial. Petitioner's new, contradictory theories turn on technical questions about APR guidance and a POSITA's understanding of them but PO is not permitted to submit new declarations. Despite the technical nature of the newly raised issues, 37 C.F.R. § 42.23(b) restricts the new evidence on sur-reply to deposition transcripts of reply witnesses. *See Baker Hughes Oilfield Operations, LLC v. Hirshfeld*, 2021 WL 4227709, at *2 (Fed. Cir. 2021). Petitioner's failure to present these arguments in the first instance deprives PO of the evidentiary tools needed to sufficiently respond, and would require the Board to proceed on an undeveloped record.

IV. CONCLUSION

PO respectfully requests the Board strike the new Reply arguments and supporting declarations. Paper 54 at 17–26 (§§ VII.C-E); EX1046 ¶¶ 134–147; EX1047 ¶¶ 25–30, 33–40, 50, 54, 58–59, 63–64, 66–72, 82–86.

Dated: July 8, 2026

Respectfully submitted,

/s/ W. Todd Baker
W. Todd Baker
Reg. No. 45,265
todd.baker@kirkland.com
Steven Dirks
(admitted *pro hac vice*)
steven.dirks@kirkland.com
Tera Stone
(admitted *pro hac vice*)
tera.stone@kirkland.com
Kelly Tripathi
(admitted *pro hac vice*)
kelly.tripathi@kirkland.com
KIRKLAND & ELLIS LLP
1301 Pennsylvania Ave., N.W.
Washington, D.C. 20004
Telephone: (202) 389-5000
Facsimile: (202) 389-5200

Attorneys For Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Patent Owner's Motion to Strike was served on the 8th day of July, 2026, via electronic mail directed to counsel of record for the Petitioners:

Brett A. Schatz	bschatz@whe-law.com
Louis H. Sitler	lsitler@whe-law.com

/s/ W. Todd Baker
W. Todd Baker

CERTIFICATE OF COMPLIANCE

This Patent Owner's Motion to Strike complies with the type-volume limitations as mandated in 37 C.F.R. § 42.24. According to the word processing system used to prepare this document, the motion contains 7 pages (7 page limit).

/s/ W. Todd Baker
W. Todd Baker