

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MULTI-COLOR CORPORATION,
Petitioner,

v.

BROOK & WHITTLE LIMITED,
Patent Owner.

Case PGR2025-00025
U.S. Patent No. 11,961,422

**PETITIONER'S OPPOSITION TO
PATENT OWNER'S MOTION TO STRIKE**

TABLE OF CONTENTS

I.	INTRODUCTION.....	1
II.	LEGAL STANDARD	1
III.	ARGUMENT	2
A.	Dr. Deible’s Confirmation That His Opinions Regarding Mitchell Are Unchanged Constitutes Proper Rebuttal	2
B.	The Reply’s Subjectivity Showing Directly Rebuts PO’s Contention That the APR Guidance Supplies an Objective Metric	4
C.	The Subjectivity Established by PO’s Own Experts Is Neither Inconsistent with the Petition Nor Prejudicial	6
IV.	CONCLUSION	7

LISTING OF EXHIBITS

<u>EXHIBIT</u>	<u>DESCRIPTION</u>
Exhibit 1001:	U.S. Patent No. 11,961,422
Exhibit 1002:	The Prosecution History of the '422 Patent
Exhibit 1003:	Petitioner's Gatorade Label
Exhibit 1004:	Petitioner's Febreze Label
Exhibit 1005:	PET-CG-02 – Critical Guidance protocol for clear PET articles with labels and closures
Exhibit 1006:	PET Standard Laboratory Processing Practices
Exhibit 1007:	PET-S-04 – PET Package Materials Balance Test
Exhibit 1008:	PET-S-01 – Labels for PET - Wash Water Test
Exhibit 1009:	Shrink Sleeve Labels on PET Containers APR Resource Document
Exhibit 1010:	Evaluation of the Near Infrared (NIR) Sorting Potential of a Whole Plastic Article (SORT-B-01)
Exhibit 1011:	Evaluation of Sorting Potential for Plastic Articles Utilizing Metal, Metalized or Metallic Printed Components (SORT-B-03)
Exhibit 1012:	RD-TM-210-4
Exhibit 1013:	Declaration of Mr. Craig Bushman
Exhibit 1014:	Declaration of Dr. Michael Deible
Exhibit 1015:	ASTM D2732
Exhibit 1016:	SKC inc. EL62 Product Description

Exhibit 1017:	Brook+Whittle webpage print, retrieved from https://brookandwhittle.com/recyclable-light-blocking-shrink-sleeves/
Exhibit 1018:	Association of Plastic Recyclers recognition correspondence
Exhibit 1019:	Watson Standard Technical Data Sheet
Exhibit 1020:	U.S. Patent Publication No. 2017/0223879 to Mitchell et al.
Exhibit 1021:	Second Declaration of Mr. Craig Bushman
Exhibit 1022:	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, D.I. 63 (Defendant’s Motion to Stay Pending Resolution of Related Declaratory Judgment Action)
Exhibit 1023:	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, D.I. 18 (Defendant Nestlé USA, Inc.’s Motion to Dismiss for Improper Venue)
Exhibit 1024:	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, D.I. 32 (Defendant Fuji Seal International, Inc.’s Motion to Dismiss for Lack of Personal Jurisdiction). Motion is sealed and not publicly available; see <i>American Fuji Seal, Inc. v. Brook + Whittle LTD</i> , 24-1215-MN, D.I. 23
Exhibit 1025:	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, D.I. 1 (Complaint)
Exhibit 1026:	U.S. Appln. No.: 18/667,677, “Recyclable heat shrink film for recyclable container,” (Prosecution History)
Exhibit 1027:	PET-CG-02, Critical Guidance protocol for clear PET articles with labels and closures, Revision Date 04.11.2019
Exhibit 1028:	PET-P-00, PET Standard Laboratory Processing Practices, Revision Date 09.17.2019
Exhibit 1029:	PET-S-04, PET Package Materials Balance Test, Revision Date 11.16.2018

Exhibit 1030:	PET-S-01, Labels for PET - Wash Water Test, Revision Date 11.16.2018
Exhibit 1031:	GEN-TM-7A-B, Caustic Evaluation PET SSL, Revision Date 12.21.2018
Exhibit 1032:	Supplemental Declaration of Dr. Michael Deible
Exhibit 1033:	3191115 images
Exhibit 1034:	3191157 images
Exhibit 1035:	3191167 images
Exhibit 1036:	3191176 images
Exhibit 1037:	Test Development Images
Exhibit 1038:	APR Summation Report for Critical Guidance Recognition 5-01-19
Exhibit 1039:	Privilege Log
Exhibit 1040:	Privilege Log and Identified Documents (Part 1)
Exhibit 1041:	Privilege Log and Identified Documents (Part 2)
Exhibit 1042:	Privilege Log and Identified Documents (Part 3)
Exhibit 1043:	Privilege Log and Identified Documents (Part 4)
Exhibit 1044:	APR caustic wash test data relating to the Gatorade label
Exhibit 1045:	Email and attached curriculum vitae of Dr. Michael Deible (Document No. 3 from Privilege Log, EX1039)
Exhibit 1046:	Second Declaration of Dr. Michael Deible
Exhibit 1047:	Declaration of Dr. Craig Bushman
Exhibit 1048:	Deposition Transcript of Dr. Phillips, May 21, 2026
Exhibit 1049:	Deposition Transcript of Dr. Reitman, May 28, 2026

Exhibit 1050:	S.P. Morell & Co., <i>Metallic Pigments – The Science of Optics</i> (retrieved from https://www.spmorell.com/newsletters/metallic_pigments/metallic_pigments.html (last visited June 17, 2026))
Exhibit 1051:	Schlenk Metallic Pigments GmbH, <i>World of Metallics Pigments: Pigments for Printing Inks</i> (Mar. 2011) (retrieved from https://www.schlenk.com/fileadmin/editorsCMS/Medien/04_Aktuelles_und_Highlights/Mediacenter/Catalogue_Pigments_for_Printing_Inks.pdf (last visited June 17, 2026))
Exhibit 1052:	US Patent Application No. 18/667,677 June 11, 2026, Non-Final Rejection

I. INTRODUCTION

Patent Owner's ("PO") Motion ("Mot.") does not present the rare circumstance warranting the "exceptional remedy" of striking a party's brief and evidence. Each of the challenged portions of Petitioner's Reply ("Reply," Paper 54) and its supporting declarations responds directly to positions advanced in PO's Response ("POR," Paper 34), to admissions made by PO's own experts, or to the Institution Decision (Paper 14), which is precisely the function a reply is intended to serve. 37 C.F.R. § 42.23(b).

With respect to Mitchell, PO seeks relief substantially broader than the premise of its asserted concern. Specifically, on the basis of a single paragraph in which Dr. Deible confirms that his review of Mitchell itself left his opinions "unchanged" (EX1046 ¶ 135), PO asks the Board to strike fourteen paragraphs of testimony and the Reply sections citing them. With respect to indefiniteness, the Reply presents no new theory. Rather, the Reply rebuts, largely through the admissions of PO's own experts, PO's contention that the '422 patent's several characterizations of "recyclable" supply reasonable certainty. PO's Motion should be denied.

II. LEGAL STANDARD

"[S]triking the entirety or a portion of a party's brief is an exceptional remedy that the Board expects will be granted rarely." PTAB Consolidated Trial

Practice Guide. That is because the Board “is capable of identifying new issues or belatedly presented evidence when weighing the evidence at the close of trial, and disregarding any new issues or belatedly presented evidence that exceeds the proper scope of reply or sur-reply.” *Id.*

“[T]he introduction of new evidence in the course of the trial is to be expected . . . and permissible, as long as the opposing party is given notice of the evidence and an opportunity to respond to it, the introduction of such evidence is perfectly permissible.” *Rembrandt Diagnostics, LP v. Alere, Inc.*, 76 F.4th 1376, 1384 (Fed. Cir. 2023) (citation omitted). Reply evidence is a “legitimate reply” where it is offered to “explain, repel, counteract, or disprove” PO’s evidence and arguments, and a petitioner permissibly “expands on previously raised arguments” or “elaborat[es] on [its] arguments on issues previously raised.” *Id.* (citations omitted). Indeed, the Board should not parse a reply “with too fine of a filter.” *Ericsson Inc. v. Intellectual Ventures I LLC*, 901 F.3d 1374, 1380 (Fed. Cir. 2018).

III. ARGUMENT

A. Dr. Deible’s Confirmation That His Opinions Regarding Mitchell Are Unchanged Constitutes Proper Rebuttal

Ground 2 of the Petition, and Dr. Deible’s supporting declaration (EX1014), relied on Mitchell as it was applied by the Examiner during prosecution of the ’422 patent. EX1046 ¶ 135. At deposition, PO elicited that Dr. Deible had not

independently reviewed Mitchell itself, EX2011, 118:3–9, then argued in the POR that Dr. Deible’s Ground 2 opinions were unsupported. Dr. Deible’s second declaration (EX1046) responds directly to that critique. Indeed, Dr. Deible reviewed Mitchell and confirmed that his opinions are “unchanged.” EX1046 ¶ 135. That is the definition of rebuttal, being testimony offered to “explain, repel, counteract, or disprove” PO’s assertion in the POR. Dr. Deible’s second declaration identifies no new prior art, no new combination, and no new rationale. Rather, Dr. Deible addresses the same reference, applied to the same claims, for the same reasons set forth in the Petition. *See Rembrandt Diagnostics, LP v. Alere, Inc.*, 76 F.4th 1376, 1385 (Fed. Cir. 2023) (“reply argument [that] involves the same ‘legal ground’ based on ‘the same prior art reference[s]’ and the ‘same legal argument’” are “responsive reply arguments”).

PO’s sole authority is inapposite. In *Trilogy*, the district court struck a supplemental expert report served after the discovery deadline because it “contained new opinions and information and did not merely supplement the original report.” *Trilogy Commc’ns, Inc. v. Times Fiber Commc’ns, Inc.*, 109 F.3d 739, 744 (Fed. Cir. 1997). Here, PO concedes the opposite. Dr. Deible’s opinions are “unchanged.” Moreover, the relief requested far outruns the premise. PO asks the Board to strike fourteen paragraphs (EX1046 ¶¶ 134–147) wholesale, sweeping in testimony that responds to the POR’s substantive arguments regarding Mitchell.

Whether Dr. Deible's initial reliance on the Examiner's characterization of Mitchell affects the weight of his testimony is a merits argument for the record, not a basis to strike testimony from the record. *See* PTAB Consolidated Trial Practice Guide.

**B. The Reply's Subjectivity Showing Directly Rebuts PO's
Contention That the APR Guidance Supplies an Objective Metric**

The Petition asserted that "recyclable" is indefinite because the '422 patent characterizes that limitation in disparate ways, making it impossible for a POSITA to ascertain a definitive meaning and scope. Paper 2, §VII.E. The POR answered that the '422 patent's several statements regarding recyclability are "entirely consistent with one another," Paper 34 at 75-76, and, critically, that the APR guidance documents referenced in the specification (PET-CG-02, SORT-B-01, and SORT-B-03) are "complementary," are "entirely consistent with other statements in the specification," and "provide an objective metric that a POSITA could follow to confirm whether a particular label is recyclable with a container." Paper 34 at 85-86. PO, not Petitioner, thereby placed the workability and objectivity of those guidelines at the center of the indefiniteness dispute, affirmatively representing that the APR guidance supplies the very objective metric a POSITA would follow.

The Reply meets that defense head-on, principally through the admissions of PO's own experts on cross-examination. Dr. Phillips admitted that there is no objective test for whether a label is "recyclable." EX1048, 92:17-93:9. By way of

example, and despite the fact that the '422 patent states that a label that “meet[s] certain industry standards, including...PET-CG-02...can be considered as certifying that the film is fully recyclable” (EX1001, 11:32-38), Dr. Phillips testified that meeting PET-CG-02 does not mean that the label is recyclable as that term is used in the claims of the '422 patent (EX1048, 16:8-18:21). Rather, according to Dr. Phillips, numerous other tests have to be considered and whether a label is recyclable as that term is used in the claims of the '422 patent is “really dependent...The answer is that it will depend on the results of each test...”. EX1048, 19:14-21:10. As to the characterization calling for an evaluation of “good results” and “poor results,” Dr. Phillips admitted that a POSITA does not know what “good results” or “poor results” are. EX1048, 166:17–168:12. As to the characterization directed to material recovered in a recycling process, Dr. Phillips could identify no amount of material loss that separates a “recyclable” label from a non-recyclable one, stating that “[t]here’s no number on that. That’s not something I can answer.” EX1048, 133:20-134:3. And when asked whether all of the tests must be passed for a label to be “recyclable,” Dr. Phillips answered that “it will depend on the results of each test.” EX1048, 19:11–20:5.

Demonstrating that the very characterizations PO relies upon call for subjective judgment is not a new theory of indefiniteness. It is the same theory presented in the Petition, that the '422 patent’s characterizations of “recyclable”

fail to inform a POSITA of claim scope with reasonable certainty, now elaborated in response to the POR and established through PO's own witnesses. *Rembrandt*, 76 F.4th at 1384–85. Nor does the Reply rest on new evidence. The APR guidance documents discussed in the Reply, including the Critical Guidance protocol, the wash water test, and the materials balance test, were made of record with the Petition, EX1005–EX1012. The remainder is cross-examination testimony of PO's own declarants, which is quintessential rebuttal evidence.

The Reply is also responsive to the Institution Decision, which observed that it was “unclear at this stage . . . whether these standards are consistent with each other, which casts sufficient ambiguity regarding the precise meaning of the claimed phrase.” Paper 14 at 24. PO's own authority confirms that a reply may “respond to arguments made in the institution decision.” *Apple Inc. v. MemoryWeb, LLC*, 2025 WL 3494991, at *5 (Fed. Cir. 2025); 37 C.F.R. § 42.23(b). The Reply answers the precise question the Board flagged, because the standards cannot be applied consistently where their application turns on subjective judgment.

C. The Subjectivity Established by PO's Own Experts Is Neither Inconsistent with the Petition Nor Prejudicial

PO contends the Reply is “irreconcilable” with the Petition's reliance on APR recognition in Grounds 1–3. Mot. at 6. That contention conflates two distinct questions. Grounds 1–3 rely on APR recognition as evidence that particular prior-

art labels were in fact recyclable, that is, that those labels satisfy the “recyclable” limitation under the ’422 patent’s own characterizations. Ground 4 presents the distinct legal question whether “recyclable” informs a POSITA of the scope of the claims with reasonable certainty. The ability to assess whether the prior art satisfies a disputed claim term does not resolve the separate question of whether the ’422 patent informs a POSITA, with reasonable certainty, of the scope of that term. *See Sonix Tech. Co. v. Publ'ns Int'l, Ltd.*, 844 F.3d 1370, 1380-81 (Fed. Cir. 2017).

Nor can PO claim unfair prejudice. The challenged arguments rest on the POR’s own positions and on the admissions of PO’s own experts. PO has had a full opportunity to address those arguments in its sur-reply and may rely on cross-examination of Petitioner’s reply declarants. *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1081 (Fed. Cir. 2015) (identifying the procedural mechanisms available to a patent owner to respond to reply evidence). Finally, that Mr. Bushman’s APR experience predates the Petition is beside the point. Petitioner was not required to preemptively rebut, in the Petition, a defense PO had not yet raised. The need to respond arose only when PO represented in its POR that the APR guidance supplies an objective metric. Paper 34 at 85; *Rembrandt*, 76 F.4th at 1384–85.

IV. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that the Board deny PO’s Motion to Strike in its entirety.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing document has been served via electronic mail upon the following on July 15, 2026:

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