

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MULTI-COLOR CORPORATION
Petitioner

v.

BROOK & WHITTLE LIMITED
PO

PGR2025-00025
Patent No. 11,961,422

PATENT OWNER'S REPLY TO PETITIONER'S RESPONSE TO
MOTION TO EXCLUDE EVIDENCE

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	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, Docket Report, generated May 13, 2025
2007	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, D.I. 16 (Docket Control Order)
2008	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 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	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, D.I. 51 (Order granting D.I. 50)
2010	Deposition Transcript of Dr. Craig Bushman, dated Nov. 18, 2025
2011	Deposition Transcript of Dr. Michael Deible, dated Dec. 2, 2025
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, <i>Winners of the Sustainability Awards 2024 Announced!</i> , (Nov. 14, 2024).
2020	PACKAGING EUROPE, <i>Sustainability Awards 2024 Finalist Interview: Brook+Whittle's Recyclable, Light-Blocking Shrink Sleeve</i> , (Sept. 24, 2024).
2021	<i>AWA Sleeve Label Awards 2024 - Winners</i> (October 28, 2024)
2022	US Plastics Pact 2023 LinkedIn Post
2023	US Plastics Pact 2024 LinkedIn Post
2024	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 2:24-cv-00735-JRG-RSP, Dkt. 1 (Complaint)
2025	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 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, <i>Food Sci. & Nut.</i>
2030	"The Amazing Shrink Inks," Packaging Impressions
2031	"Wrinkling-to-delamination Transition in Thin Polymer Films on Compliant Substrates," Nolte, Adam J., <i>Soft Matter</i> , 2017
2032	"Review Article: Stress in Thin Films and Coatings: Current Status, Challenges, and Prospects," Abadias, Gregory, <i>J. Vac. Sci. Technol.</i> 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	<i>Brook + Whittle LTD v. Nestle USA, Inc. et al.</i> , 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 <i>Pro Hac Vice</i>
2040	Declaration of Tera Stone in support of Admission <i>Pro Hac Vice</i>
2041	Declaration of Kelly Tripathi in support of Admission <i>Pro Hac Vice</i>
2042	Deposition Transcript of Dr. Michael Deible, dated July 16, 2026

EX	DESCRIPTION
2043	Deposition Transcript of Dr. Craig Bushman, dated July 20, 2026

Petitioner's opposition cannot cure its expert's most fundamental deception: Dr. Deible admitted under oath that he never reviewed Mitchell, the very reference he cites over thirty times in rendering his invalidity opinions. Paper 59, 2-3. This is not a question of merely balancing weight versus admissibility as Petitioner contends but rather implicates the fundamental gatekeeping issue of FRE 702 requiring that expert evidence be reliable. 37 CFR § 42.62(a); FRE 702. As this Board has found (regarding even a lie "not germane" to the expert's opinions), such admitted lies from the expert render him "not a reliable witness" and justify exclusion. *Mitchell v. Holt*, Pat. Interference No. 105,746, Paper 352, 21, 24 (BPAI Apr. 27, 2012).

A. Dr. Deible's Opinions Should Be Excluded (EX1014 and EX1046)

First, regarding the Mitchell reference, Petitioner attempts to distinguish *Mitchell v. Holt* by downplaying the seriousness of Dr. Deible's wrongdoing, calling it an "inconsistency" and "perceived tension." Paper 63, 6, 7. But these are not mere "inconsistenc[ies]"; they are factual assertions about materials Dr. Deible said under oath in his declaration to have reviewed as core components of his opinions, and then later admitted under oath in his deposition that he did not review them. "Telling a lie while under oath is a big deal, no matter what a witness is lying about." *Mitchell*, Paper 352, 21.

The question is not merely relevance, but under FRE 403 whether relevance is "substantially outweighed" by unfair prejudice, and under FRE 702 whether these

opinions are reliable. Petitioner's attempt to rehabilitate Dr. Deible with a *post-hoc* review only underscores the problem: that his opinions are "unchanged" reveals they were never derived from Mitchell in the first place.

Second, Petitioner argues "the substance of Dr. Bushman's declaration was conveyed to Dr. Deible by counsel." Paper 63, 1 (citing EX2011, 162:4-24). In his first deposition, Dr. Deible testified that, "for *every*¹ citation to Exhibit 1013 [Dr. Bushman's declaration] ..., that information was relayed to [him] through Counsel[.]" EX2011, 162:18-24. In his first declaration, Dr. Deible states his knowledge "that the Gatorade Label and the Febreze Label are heat shrink labels" was "[b]ased on *discussions* with Craig Bushman of Multi-Color." EX1014 ¶ 59. But, in his second deposition, Dr. Deible states he only spoke with Dr. Bushman "early on in the process," and *does not recall if he* reviewed Dr. Bushman's first declaration to date. EX2042, 11:24-12:9; *see also id.*, 7:23-8:1, 74:14-17.

And Petitioner's justification does not explain how Dr. Deible's declarations include *pin citations* to Dr. Bushman's declaration or how the *entirety* of Dr. Deible's indefiniteness opinion is *identical* to Dr. Bushman's, down to spacing. Paper 59, 4. Even if Petitioner's assertions were credible, providing Dr. Bushman's analysis directly to Dr. Deible to adopt wholesale, circumvents the expert

¹ Emphasis added unless stated otherwise.

requirements of FRE 702 and 703, as FRE 703 allows reliance on others' *facts*, not simply copying others' *finished opinions*. When counsel transplants a lay witness's complete analysis into an expert's declaration—an expert who never read the source, lacks the relevant expertise, and changed not a word—both rules are circumvented.

Third, Petitioner wrongly claims PO's POSITA argument is merely a disagreement about the definition. Paper 63, 8. Dr. Bushman admitted in his second deposition that a POSITA has more than five years' experience in the field of "[l]abels and recycling"—thereby agreeing that Dr. Deible does not meet *any* definition of POSITA. EX2043, 127:21-130:1; *see also Disney Media v. Digit. Media*, IPR2024-00736, Paper 40, 9-10 (excluding non-POSITA declarations).

Finally, Petitioner's waiver argument fails because § 42.64(b) does not require anticipating that a declarant will lie about materials reviewed. Petitioner concedes PO could not "object[]" because the "concern [] did not yet exist." Paper 63, 4-5. Regardless, Paper 16 § H preserved FRE 403 objections with regard to Mitchell and FRE 701-702 objections for Dr. Deible's copying of Mr. Bushman's opinions.

B. Opinions Contradicting Earlier Testimony Should Be Excluded

Petitioner's argument that PO was required to object to EX1013 *before* the inconsistency arose should be rejected. *See* Paper 63, 5. That argument is absurd, as under Petitioner's view, direct inconsistencies between declarations can never form the basis to exclude the inconsistent declarations unless the party lodged a grievance

about an inconsistency that had not yet occurred. The rules do not require clairvoyance.

Although Petitioner reframes its late-arising indefiniteness argument as attacking only the APR “*process*,” the argument targets the *APR guidelines* themselves. EX1047 ¶¶ 54, 66. Petitioner never previously raised this new “alternative legal theor[y]” and there is no dispute that the guidelines themselves are unchanged. Paper 63, 10. Moreover, both parties’ experts *applied* those guidelines in interpreting “recyclable” in Grounds 1–3, which under *Sonix Technology Co. v. Publications International, Ltd.* is evidence the term is not indefinite. 844 F.3d 1370, 1380 (Fed. Cir. 2017).

Petitioner asserts that “Dr. Deible’s testing was not intended to establish recyclability in the first instance[.]” Paper 63, 10-11. This attorney argument directly contradicts Dr. Deible’s first declaration and second deposition, opining that the caustic wash testing was performed “[t]o determine if a label is recyclable with a PET container.” EX1014 ¶ 71; EX2042, 56:3-19.

C. Dr. Bushman's Biased Opinions, Attributed Verbatim to Dr. Deible, Should Be Excluded

Petitioner’s contention of “no ‘role switching’” is betrayed by its gamesmanship. Petitioner never explains why Dr. Deible’s indefiniteness analysis is copied *verbatim* from Dr. Bushman’s, Paper 59, 11-12, or why Petitioner introduced “Mr.” Bushman with “personal[] experience,” as one would a fact witness. *Id.*, 9.

D. EX1016, EX1018, and EX1019 and Evidence of Articles as Prior Art Should be Excluded

There is no disagreement: authentication requires “evidence sufficient to support a finding that the item is *what the proponent claims it is.*” Paper 63, 13 (quoting FRE 901(a)). Yet, Petitioner does not merely proffer what EX1016 (a product description), EX1018 (correspondence), and EX1019 (data sheet) *are*, as its opposition suggests, Paper 63, 13, but also that these exhibits establish a property of the Gatorade Label itself, despite admitting that none even mention Gatorade. Paper 59, 12-13. And while FRE 703 permits experts to *rely* on otherwise inadmissible materials in forming opinions, it does not render those materials independently admissible as substantive evidence.

Petitioner similarly contends that the pictures “*are the alleged prior-art* articles themselves,” Paper 63, 15, yet also agrees “that the photographs do not themselves establish public availability before the priority date, that the containers are not shown to be PET, and that EX1003 depicts an Orange-flavored label”—not the Passion Fruit Maracuya or Glacier Freeze designs on which Grounds 1–3 actually rely. *Id.*, 14; *see also* EX1032, 11, 19. Thus Petitioner concedes it failed to show the items are “*what the proponent claims it is.*” Paper 63, 13 (quoting FRE 901(a)).

For the foregoing reasons, PO respectfully requests the Board grant the Motion to Exclude.

Dated: July 22, 2026

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Patent Owner's Reply to Petitioner's Response to Patent Owner's Motion to Exclude was served on the 22nd day of July, 2026, via electronic mail directed to counsel of record for the Petitioner:

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CERTIFICATE OF COMPLIANCE

Patent Owner's Reply to Petitioner's Response to Patent Owner's Motion to Exclude 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 5 pages (5 page limit).

/s/ W. Todd Baker

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