UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARKEMA FRANCE,
Petitioner

v.

HONEYWELL INTERNATIONAL INC.
Patent Owner

Case IPR2015-00916
U.S. Patent No. 8,710,282

DECLARATION OF JOSEPH F. POSILLICO, ESQ.

Pursuant to 28 U.S.C. § 1746, I, Joseph F. Posillico, state of my personal knowledge as follows:

1. I make this declaration to attest to facts relating to the reasonable diligence in constructively reducing to practice the invention claimed in U.S. Patent No. 8,710,282 ("the '282 patent"), which claims the benefit of U.S. Provisional Patent Application No. 61/392,242 filed on October 12, 2010. The '282 patent is also a continuation-in-part of U.S. Pat. No. 8,242,316, filed Aug. 1, 2011, which is a continuation of U.S. Pat. No. 8,013,194, filed Mar. 11, 2009, which in turn claims priority benefit of U.S. Provisional Patent Application No. 61/036,526, filed Mar. 14, 2008. This declaration specifically focuses on the time period of August 19, 2010 to October 12, 2010 ("the relevant time period").

2. I am an equity partner at Fox Rothschild LLP ("Fox") in Philadelphia, Pennsylvania and have been since September 2008. For the eighteen (18) years prior to that, I was a partner at the law firm of Synnestvedt & Lechner in Philadelphia, Pennsylvania, specializing in intellectual property law. I was an associate in the intellectual property law firm of Woodcock, Washburn, Kurtz, Maceiwichz and Norris from about 1985 to about 1990. From about 1979 to 1985, I was a chemical engineer with ARCO Chemical Company in Philadelphia, Pennsylvania. Throughout my legal career, my practice has focused on all aspects

of intellectual property, including patent preparation and prosecution, patent and trademark litigation, and portfolio development and strategic development of intellectual property in a wide variety of technical areas including all aspects of chemistry and chemical engineering inventions.

3. During my career, including my time at Fox, I have represented many clients, including the Patent Owner Honeywell International Inc. ("Honeywell") or it predecessor since about 1992. Honeywell continues to engage Fox to prepare and prosecute patents in the field of chemistry and chemical engineering.

4. I generally receive invention reports and drafting orders promptly after a decision is made by Honeywell to file a patent application in connection with any particular development. In accordance with customary procedure, on August 19, 2010, I received an email from James DePasque, who at the time was one of Honeywell's patent prosecution paralegals, providing an invention record, supporting documentation, and a cover letter and guidelines for preparing a provisional patent application based on a new disclosure referred to as H0024680 (4511).

5. It is the regular practice of all Fox attorneys who work on prosecution client matters for which I am responsible to keep and maintain files, both physical and virtual, for each prosecution matter for a client. Each file contains copies of

correspondence with the client, documents filed with the Patent Office, and documents received from the Patent Office, all of which are kept and maintained in the ordinary course of its business. It is the regular practice for an attorney, paralegal, or an administrative assistant to maintain the physical file, which includes printing and including in the file copies of correspondence received from or sent to the client at or near the time of the correspondence, and the virtual file, which includes storing the documents in the appropriate locations in the virtual file in the document management system. In this particular case, Michele Greenberg, a paralegal at the time, maintained the prosecution file on my behalf and Michele, an administrative assistant, or an attorney working on the matter printed the email and its attachments, and placed them in the file, and saved them to the virtual file at or near the time of receipt. Attached as Exhibit 2031 is a true and accurate copy of the email and the cover letter, invention disclosure, and a detailed disclosure attached thereto that I received from James DePasque on August 19, 2010 and as kept and maintained in the prosecution file at Fox in the ordinary course of business.

6. The cover letter that was attached to the August 19, 2010 email likewise was dated August 19, 2010 and identifies H0024680 (4511) as being the invention entitled "Integrated Continuous Process for Dehydrofluorination of

236ea and 245eb." The cover letter identifies Selma Bektesevic as the technical contact.

7. Also attached to the August 19, 2010 email, was an invention disclosure form entitled "Integrated Continuous Process for Dehydrofluorination of 236ea and 245eb." I can confirm that the invention disclosure form that was received on August 19, 2010, was used in the drafting of the specification and claims of U.S. Provisional Patent Application No. 61/392,242.

8. In this particular case, I instructed Eric Sumner to review the invention record and I provided him with instructions regarding the budget for the matter and timing for preparation and filing. It is my recollection that I asked Eric to prioritize the drafting of this patent application consistent with his other tasks but with a target filing date of September 30, 2010. At the time, I would have expected that drafting an application to have taken approximately 8 weeks or more given my recollection of his workload and my workload at the time. This particular case was handled more quickly than a more normal turn-around of 8+ weeks given Honeywell's request for a September 30, 2010 filing date.

9. Based upon my review of the Fox time records that were made at the time of the events (and maintained by Fox in the ordinary course of business), the

time devoted to drafting and filing this application by Fox attorneys is summarized below:

i. 9/22/2010 – 0.9 hours

ii. 9/23/2010 – 5.5 hours

iii. 9/24/2010 – 4.5 hours

iv. 9/27/2010 – 4.3 hours

v. 9/29/2010 – 3.1 hours

vi. 10/12/2010 – 0.8 hours

10. My review of the time records for the relevant time period of August 19, 2010 to October 12, 2010 for Eric confirms that he was very engaged and had a full docket at that time period, averaging 8.7 billable hours per working day based on a five-day work week during that period.

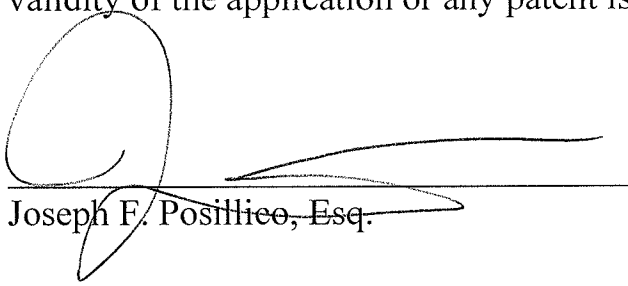
11. Eric completed the first draft of the application on September 29, 2010, and after I reviewed it, he sent it to the inventors for comment and proposed revision. A true and accurate copy of the September 29, 2010 email as kept and maintained in the prosecution file at Fox in the ordinary course of business, as explained above, is attached as Exhibit 2032. In that email, Eric requested that the inventors provide their input by October 6, 2010.

12. On October 1, 2010, we received an email from Selma Bektesevic asking for additional time to review the draft. A true and accurate copy of the October 1, 2010 email as kept and maintained in the prosecution file at Fox in the ordinary course of business, as explained above, is attached as Exhibit 2033. After Eric confirmed that an extension of time was permissible, we received an email from Selma Bektesevic on October 12, 2010 indicating that the inventors had discussed the draft and that it was "OK to file invention [sic] as is." A true and accurate copy of the October 12, 2010 email as kept and maintained in the prosecution file at Fox in the ordinary course of business, as explained above, is attached as Exhibit 2034. I instructed Eric to file the provisional that day, which he did. He confirmed the filing the same day by email to Honeywell. A true and accurate copy of the October 12, 2010 email as kept and maintained in the prosecution file at Fox in the ordinary course of business, as explained above, is attached as Exhibit 2035.

13. To the best of my recollection, the work done by Fox attorneys in connection with the preparation and filing of the provisional patent application during the relevant time period was expedited compared to usual practice for clients and matters for which I am responsible.

14. On September 9, 2011 we filed the non-provisional application that ultimately issued as the '282 patent. We did not make any major substantive changes to the non-provisional application prior to its filing.

Pursuant to 28 U.S.C. § 1746, I declare under penalty of perjury that the foregoing is true and correct and that all statements made herein of my own knowledge are true and that all opinions expressed herein are my own; and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.



Joseph F. Posillico, Esq.

1/22/16
Date