

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ARKEMA FRANCE,  
Petitioner,

v.

HONEYWELL INTERNATIONAL INC.,  
Patent Owner.

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Case IPR2015-00915  
IPR2015-00916  
IPR2015-00917<sup>1</sup>  
Patent 8,710,282 B2

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Before JO-ANNE M. KOKOSKI, JON B. TORNQUIST, and ROBERT A.  
POLLOCK, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
37 C.F.R. § 42.5

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<sup>1</sup> This Order addresses identical issues in each of three related cases. We exercise our discretion to issue one Order to be entered in each case. The parties are not authorized to use this style heading in their papers.

IPR2015-00915  
IPR2015-00916  
IPR2015-00917  
Patent 8,710,282 B2

At the request of Petitioner, a telephone conference was held on February 24, 2016, among respective counsel for Petitioner and Patent Owner, and Judges Kokoski, Tornquist, and Pollock. A court reporter was on the line, and Petitioner will file a copy of the transcript in each proceeding in due course. The matters discussed during the call will be reflected in the transcript, and need not be repeated herein. The purpose of the call was to address Petitioner's request for authorization to file (1) a motion for additional discovery regarding Patent Owner's argument that the inventors conceived of the invention, and reduced it to practice, before the dates of the asserted prior art references, and (2) a motion to compel Patent Owner to produce unredacted copies of Exhibits 2032 and 2033.

With respect to Petitioner's request for authorization to file a motion for additional discovery, after considering the parties' arguments (reflected in the reporter's transcript), we determined that briefing on the matter is warranted. Accordingly, we authorized Petitioner to file a motion for additional discovery, not to exceed 15 pages. Patent Owner is authorized to file an opposition to the motion, also not to exceed 15 pages. No reply is authorized at this time.

We further considered Petitioner's request for authorization to file a motion to compel production of unredacted copies of Exhibits 2032 and 2033. Patent Owner asserts that the redacted material is protected by the attorney-client privilege. Petitioner argues that Patent Owner waived the attorney-client privilege by producing the documents in this proceeding. After hearing from both parties, we took the matter under advisement.

IPR2015-00915  
IPR2015-00916  
IPR2015-00917  
Patent 8,710,282 B2

Upon consideration of the parties' arguments, we determine that briefing on a motion to compel is not warranted under the circumstances. We are not persuaded, knowing the content of the redacted material, that Patent Owner has waived attorney-client privilege with respect to that content by producing the document to Petitioner. Further, as reflected in the transcript of the call, Patent Owner represented that it is not relying on Exhibits 2032 and 2033 for their substance, but is relying on them to show the date certain activities were undertaken. We are also not persuaded that Petitioner has explained sufficiently how it could demonstrate that producing the unredacted materials would be "necessary in the interest of justice" to justify a motion to compel production. Petitioner's request for authorization to file a motion to compel Patent Owner to produce unredacted copies of Exhibits 2032 and 2033 is denied.

#### ORDER

In consideration of the foregoing, it is:

ORDERED that Petitioner's request for authorization to file a motion for additional discovery relating to Patent Owner's argument that the inventors conceived of the invention, and reduced it to practice, before the dates of the asserted prior art references is GRANTED. The motion is due one week from the date of this Order, and must not exceed 15 pages. Patent Owner is authorized to file an opposition to this motion. The opposition is due one week after the motion is filed, and must not exceed 15 pages; and

IPR2015-00915  
IPR2015-00916  
IPR2015-00917  
Patent 8,710,282 B2

FURTHER ORDERED that Petitioner's request for authorization to file a motion to compel production of unredacted copies of Exhibits 2032 and 2033 is DENIED.

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