

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Arkema France

Petitioner

v.

Honeywell International Inc.

Patent Owner

Trial No.: IPR2015-00916

U.S. Patent No. 8,710,282

PETITIONER'S MOTION FOR ADDITIONAL DISCOVERY

Petitioner Arkema France (“Petitioner”) moves for an order requiring Honeywell International Inc. (“Patent Owner”) to produce, within three days of the Board’s decision on this motion the documents and things requested herein. Petitioner’s requested discovery should be produced in the interests of justice.

A. Additional Discovery Sought by Petitioner

1. Deposition of non-declarant Selma Bektesevic.
2. The April 2009 “Forward Engineering Request Form” referenced in the Morris declaration (Ex. 2036, ¶ 5).
3. The September 2009 “whitepaper to brief Honeywell top executives regarding 1234yf” referenced in Morris declaration (Ex. 2036, ¶ 9).
4. Formal minutes relating to the subject matter of the ’282 patent (including without limitation Invention Disclosure No. H0024680) from Patent Committee meetings held on January 11, 2010; April 5, 2010; and April 13, 2010.
5. Lab notebooks for experiments performed pursuant to lab instructions dated July 16, 2008 (Ex. 2011), July 28-29, 2008 (Ex. 2012), and September 15, 2008 (Ex. 2015).
6. Documents sufficient to show the date when Patent Owner first became aware of the applications published as FR 2940968, WO2010/081988, and/or US 2012/0022301.
7. Draft patent application sent to Selma Bektesevic on September 29,

2010 as attachment to Ex. 2032.

B. Production of the Requested Additional Discovery Would be in the Interests of Justice

The requested discovery should be produced “in the interests of justice.” *See* 37 C.F.R. § 42.51(b)(2)(i). Patent Owner is seeking to antedate two of Petitioner’s main references. To do so, Patent Owner must show conception “by corroborating evidence which shows that the inventor disclosed to others his completed thought expressed in such clear terms as to enable those skilled in the art to make the invention.” *Microsoft Corp. v. Surfcaster, Inc.*, IPR2013-000292, Paper 93, p. 15 (P.T.A.B. Oct. 14, 2014). Patent Owner must also “connect the conception with its reduction to practice by reasonable diligence on his part, so that they are substantially one continuous act.” *Id.*

However, Patent Owner has only given Petitioner and the Board small snapshots of the alleged antedating story, inhibiting Petitioner’s ability to adequately probe Patent Owner’s factual assertions. For example, Patent Owner relies heavily on documents authored by the lead inventor, Selma Bektsevic, but does not offer her direct testimony even though she is the only person with first-hand information on the same. Further, Daniel Merkel testified that Honeywell retains and maintains inventor notebooks (Ex. 2038, ¶ 5), but Patent Owner only produced a summary of a notebook written well over a year after the alleged conception took place rather than contemporaneous lab notebooks.

As another example, the Declaration of Thomas Morris (Ex. 2036) relies on two documents to allegedly show activity towards diligence, but Patent Owner did not produce the documents to allow Petitioner to probe Mr. Morris' assertions. Furthermore, Honeywell only produced minutes from one of the four Patent Committee meetings held between August 2009, when Dr. Bektesevic submitted an Invention Disclosure form to counsel, and October 2010, when the inventors finally authorized the filing of the resulting patent application. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Petitioner requests as additional discovery specific documents and information that will provide a more complete picture of the antedating story. The five *Garmin* factors each favor Petitioner with respect to each item of additional discovery requested. IPR2012-00001, Paper 26, pp. 6-7 (P.T.A.B. Mar. 5, 2013).

1. Deposition of Non-Declarant Selma Bektesevic

a. Factor #1: More than a possibility and mere allegation

A deposition of Dr. Bektesevic will provide useful information that has substantive value to Petitioner's reply. Selma Bektesevic, the first-named inventor

of the '282 patent, authored most of the documents upon which Patent Owner relies to show conception, diligence, and reduction to practice. [REDACTED]

[REDACTED] Patent Owner argued during the February 24, 2016 conference call that declarant Dr. Harry Tung, who is another named inventor and was allegedly Dr. Bektesevic's boss, "has as much information as Selma." Patent Owner's own exhibits, however, confirm that only Dr. Bektesevic has first-hand knowledge of the facts upon which Patent Owner relies. For example, the Invention Disclosure form Patent Owner sent to its outside attorneys [REDACTED]

[REDACTED] Further, in the instruction email sent from Patent Owner to outside counsel requesting a draft patent application, [REDACTED]

Dr. Tung's own declaration confirms the holes in his first-hand knowledge:

... although *I do not recall the specific date*, I do recall observing *some* of the caustic dehydrofluorination experiments in operation in the laboratory.

Ex. 2006, ¶ 20 (emphasis added). Dr. Tung observed only "some" of the experiments, and he does not recall the dates of the experiments he did observe.

These experiments, including the dates they occurred, are relevant to Patent

Owner's antedating positions. Dr. Bektesevic's deposition will yield first-hand information that Dr. Tung cannot provide. [REDACTED]

[REDACTED] Patent Owner and Dr. Lousenberg set forth a date of conception of March 26, 2008, as evidenced by an email from Haluk Kopkalli (another named inventor who is not being made available as a declarant), provided as Exhibit 2007. *See* Patent Owner Response, p. 37 and Ex. 2002, ¶145. [REDACTED]

[REDACTED] It is in the interest of justice for Petitioner to question Dr. Bektesevic about the discrepancy.

Petitioner is not "fishing;" Patent Owner's own documents indicate beyond speculation that Dr. Bektesevic's deposition will yield first-hand information relevant to Patent Owner's antedating positions.

b. Factor #2: Litigation positions and underlying basis

Petitioner has not asked for Patent Owner's litigation positions or the underlying basis for those positions. Patent Owner has put documents authored by Dr. Bektesevic into evidence, and relied on them in support of its prior invention story. Now is the "proper time and place" for her deposition. *See Garmin*, IPR2012-00001, Paper 26, p. 6.

c. Factor #3: Ability to generate equivalent information by other means

As explained above in discussing the first *Garmin* factor, Petitioner cannot generate equivalent information by cross-examining Dr. Tung. Patent Owner's own document (Ex. 2029) [REDACTED]

[REDACTED]. Dr. Tung's own testimony demonstrates that he was not present at and cannot testify to all of the relevant experiments performed by Dr. Bektesevic during the time Patent Owner attempts to show diligence. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Patent Owner's own documents demonstrate beyond mere speculation that Dr. Bektesevic's deposition will yield information that Dr. Tung cannot provide.

Additionally, even if Dr. Tung is able to testify about some of the facts from his declaration, it would be inefficient to require Petitioner to first depose Dr. Tung and then come back to the Board with a request to depose Dr. Bektesevic. Petitioner is willing to forego deposing Dr. Tung and depose Dr. Bektesevic in his stead; except for questions (if any) that Dr. Bektesevic is unable to answer.

d. Factor #4: Easily understandable instructions

Petitioner's request is straightforward. Petitioner simply requests a

deposition of Dr. Bektesevic.

e. Factor #5: Requests not overly burdensome to answer

Dr. Bektesevic is still employed by Patent Owner and producing her for deposition would not be overly burdensome.

2. April 2009 “Forward Engineering Request Form” and September 2009 Whitepaper referenced in the Morris declaration

a. Factor #1: More than a possibility and mere allegation

Both Patent Owner’s Response and the Morris Declaration specifically reference an April 2009 “Forward Engineering Request Form” and September 2009 “Whitepaper to brief Honeywell top executives” to show diligence leading to reduction to practice. *See* Paper 21, pp. 43-33; Ex. 2036, ¶¶ 5, 9. Patent Owner and Morris’s reliance on these documents to allegedly show diligence demonstrates beyond mere speculation that production of the documents will yield useful information. *See, e.g., Corning Inc. v. DSM IP Assets B.V.*, IPR2013-00043, Paper 27, pp. 3-4 (P.T.A.B. Jun. 21, 2013). Patent Owner argued during the February 24, 2016 telephone conference that these documents were relied upon “simply to show that activity was taking place at those times,” and that Mr. Morris “doesn’t cite to the substance of those documents and anything in them to support the argument that activity was taking place.” Ex. 1020, 29:23-30:3. However, the fact that “activity was taking place” only supports Patent Owner’s diligence positions if such activity relates to the subject matter claimed in the ’282 patent.

Furthermore, Patent Owner has not stated that the Louisiana plant referenced in Mr. Morris's declaration uses the process claimed in the '282 patent, and the plant could instead use the process described in Honeywell's U.S. Publication No. 2012/0184785 which utilizes TCP instead of HFP. (Ex. 1021, U.S. Pub. No. 2012/0184785). Therefore, there is more than a possibility and mere allegation that the two documents cited by Mr. Morris do not support diligence and will provide useful information that has substantive value to Petitioner's reply.

b. Factor #2: Litigation positions and underlying basis

Petitioner has not asked for litigation positions or the underlying basis.

c. Factor #3: Ability to generate equivalent information by other means

The Forward Engineering and Whitepaper documents are Patent Owner's internal documents and Petitioner cannot generate equivalent information by any other means. Furthermore, Petitioner and the Board cannot adequately determine whether they corroborate Morris's testimony (such as during cross-examination of Mr. Morris) without the documents themselves.

d. Factor #4: Easily understandable instructions

Petitioner's request is straightforward and easily understandable.

e. Factor #5: Requests not overly burdensome to answer

The Forward Engineering and Whitepaper documents are Patent Owner's own internal documents; and thus, not overly burdensome to produce.

3. Formal minutes from Patent Committee meetings held on January 11, 2010; April 5, 2010; and April 13, 2010

a. Factor #1: More than a possibility and mere allegation

Bruce Bradford, Patent Owner's in-house counsel, testified that Patent Committee meetings were held January 11, 2010; April 5, 2010; April 13, 2010; and July 12, 2010. Ex. 2041, ¶¶ 10-12. Mr. Bradford also testified that it "was the regular practice of Honeywell for minutes of the PC meeting to be recorded and kept in the ordinary course of business at or near the time of the meeting." *Id.* at ¶ 12. Indeed, Patent Owner produced a redacted version of such meeting minutes for the July 12, 2010 meeting. (Ex. 2042). Accordingly, there is more than a possibility and mere allegation that minutes for the other three meetings also exist.

There is also more than a possibility and mere allegation that production of the requested meeting minutes will yield useful information. The July 12, 2010 Patent Committee Meeting minutes indicate that [REDACTED]

[REDACTED] It is more than mere speculation to suggest that the January 11, 2010; April 5, 2010; and April 13, 2010 meeting minutes will also indicate [REDACTED]

[REDACTED]

Additionally, regarding confidentiality and privilege, Petitioner seeks only the portions of these meeting minutes pertaining to the purported invention and does not object to redaction of other information, similar to Exhibit 2042.

b. Factor #2: Litigation positions and underlying basis

Petitioner has not asked for litigation positions or the underlying basis.

c. Factor #3: Ability to generate equivalent information by other means

Petitioner cannot generate equivalent information by any other means. For example, Petitioner cannot cross-examine Mr. Bradford on the [REDACTED] of the purported invention without the meeting minutes themselves.

d. Factor #4: Easily understandable instructions

Petitioner's request is straightforward. Petitioner requests documents corresponding to Ex. 2042 for the three remaining meetings. Ex. 2041, ¶¶ 10-12.

e. Factor #5: Requests not overly burdensome to answer

The minutes from the three meetings are Patent Owner's own documents; and thus, not overly burdensome to produce.

4. Lab notebooks for experiments performed pursuant to lab instructions dated July 16, 2008 (Ex. 2011), July 28-29, 2008 (Ex. 2012), and September 15, 2008 (Ex. 2015)

a. Factor #1: More than a possibility and mere allegation

Daniel Merkel testified that "it is Honeywell's policy that the inventors maintain an invention notebook as part of their work for Honeywell and that it is Honeywell's policy to retain and maintain inventor notebooks as part of a regularly conducted business activity." Ex. 2038, ¶ 5. If it is standard practice to maintain an invention notebook as Mr. Merkel suggests, then there is more than a possibility

and mere allegation that the inventors maintained one or more notebooks discussing the experiments identified in the lab instructions at Exhibits 2011, 2012, and 2015. Patent Owner relies on these lab instructions to corroborate its antedating story, more specifically to show alleged reduction to practice. The lab notebooks for the experiments corresponding to the instructions will include information showing whether Patent Owner had indeed reduced the purported invention to practice.

a. Factor #2: Litigation positions and underlying basis

Petitioner has not asked for litigation positions or the underlying basis.

b. Factor #3: Ability to generate equivalent information by other means

Petitioner cannot generate equivalent information by any other means.

Patent Owner has indicated that the information sought is already included in the appendices of the monthly technology reports provided by Patent Owner. *See* Ex. 1020, 26:13-27:2. However, the portion of Dr. Bektesevic's summary of a notebook provided by Patent Owner (Ex. 2039) suggests otherwise because [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

c. Factor #4: Easily understandable instructions

Petitioner's request is straightforward. Petitioner merely requests the lab

notebooks for experiments performed pursuant to lab instructions dated July 16, 2008 (Ex. 2011), July 28-29, 2008 (Ex. 2012), and September 15, 2008 (Ex. 2015).

d. Factor #5: Requests not overly burdensome to answer

The requested lab notebooks are Patent Owner's own internal documents; and thus, not overly burdensome to produce.

5. Documents sufficient to show the date when Patent Owner first became aware of the applications published as FR 2940968, WO2010/081988, and/or US 2012/0022301

a. Factor #1: More than a possibility and mere allegation

The timeline of events demonstrates that there is more than a possibility and mere allegation that documents exist showing the date when Patent Owner first became aware of the above-referenced applications. Dr. Bektasevic submitted the invention disclosure (Ex. 2029) on August 21, 2009 and the Patent Committee then held four meetings in the next year with no activity on the purported invention. Sedat was published on July 16, 2010, and then Patent Owner distributed formal minutes of the Patent Committee meeting on [REDACTED] and requested outside counsel to prepare a patent application on August 19, 2010 with [REDACTED]

[REDACTED] Further, Joseph Posillico testified that rather than the expected 8 weeks or more for drafting a patent application, this application was "handled more quickly" given Patent Owner's insistence of a filing date. (Ex.

2043, ¶8). Patent Owner would have Petitioner and the Board believe that the invention disclosure sat around for a year with Patent Owner taking no steps to file an application, and then, suddenly, for no reason, there was a rush to prepare an application and get it filed no later than September 30, 2010. These facts demonstrate more than a possibility and mere allegation that documents exist showing that Patent Owner became aware of the Sedat publication shortly before Patent Owner sent instructions to outside counsel to prepare a patent application. Accordingly, the date when Patent Owner first became aware of the Sedat publication is relevant to the issue of diligence and to whether Patent Owner was spurred by Petitioner's publication to file its own application.

To the extent Patent Owner argues portions of responsive documents are privileged, Petitioner only seeks documents sufficient to show the date on which Patent Owner became aware of the publication; privileged information could be redacted.

b. Factor #2: Litigation positions and underlying basis

Petitioner has not asked for litigation positions or the underlying basis.

c. Factor #3: Ability to generate equivalent information by other means

Petitioner cannot generate equivalent information by any other means. For example, cross-examination of Mr. Bradford would not show the date on which others at Patent Owner became aware of the publications.

d. Factor #4: Easily understandable instructions

Petitioner's request is straightforward; documents sufficient to show the date when Patent Owner became aware of the Sedat publication.

e. Factor #5: Requests not overly burdensome to answer

The requested documents are Patent Owner's own internal documents; and thus, not overly burdensome to produce.

6. Draft patent application sent to Selma Bektesevic on September 29, 2010 as attachment to Ex. 2032

a. Factor #1: More than a possibility and mere allegation

There is no dispute that Patent Owner's counsel sent a draft patent application on September 29, 2010 to the inventors. See Ex. 2032. [REDACTED]

[REDACTED] One of the factors in determining whether or not a patent attorney and inventors were reasonably diligent in preparing an application for filing is the extent of the work done to prepare the application and the extent of the revisions and comments provided by the inventors. *See, e.g., Oracle Corp. et al. v. Click-To-Call Techs. LP*, IPR2013-00312, Paper 52, pp. 18-20 (P.T.A.B. Oct. 28, 2014) (Patent Owner failed to establish diligence leading up to constructive reduction to practice without "sufficient evidence to corroborate the work actually performed on the draft patent application" by the inventor and patent attorney). The content that that drafting attorney added over other related patents [REDACTED]

█ speaks directly to these issues. See *Olympus America Inc. v. Perfect Surgical Techniques, Inc.*, IPR 2014-00233, Paper 56, pp. 21-22 (P.T.A.B. June 8, 2015). █

█. Accordingly, there is more than a possibility and mere allegation that the production of the draft patent application attached to the email shown in Ex. 2032 will yield useful results.

Furthermore, to the extent Patent Owner argues that the draft patent application is privileged; Petitioner only seeks the text of the draft application itself and does not object to redacting questions or notes to the inventors in the draft.

b. Factor #2: Litigation positions and underlying basis

Petitioner has not asked for litigation positions or the underlying basis.

c. Factor #3: Ability to generate equivalent information by other means

Petitioner cannot generate equivalent information by any other means.

d. Factor #4: Easily understandable instructions

Petitioner's request is straightforward. Petitioner merely requests the draft patent application attached to the email shown at Exhibit 2032.

e. Factor #5: Requests not overly burdensome to answer

The requested document is Patent Owner's own internal document; and thus, not overly burdensome to produce.

Dated: March 3, 2016

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing PETITIONER'S MOTION FOR ADDITIONAL DISCOVERY has been served in its entirety this 3rd day of March, 2016 by electronic mail on:

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