

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

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**PATENT OWNER'S OPPOSITION TO  
PETITIONER'S MOTION FOR ADDITIONAL DISCOVERY**

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## **I. INTRODUCTION**

Arkema France (“Petitioner”) has failed to carry its heavy burden of proving that its requests for additional discovery are “necessary in the interest of justice.” 35 U.S.C. § 316(a)(5). As illustrated below, Petitioner seeks to circumvent established discovery rules by requesting an overbroad, unbounded, and unnecessary deposition of non-declarant Dr. Selma Bektesevic. This is after Honeywell International Inc. (“Patent Owner”) properly filed declarations by—and thus made available for deposition—co-inventor Dr. Tung and numerous corroborating declarants. Petitioner also served irrelevant, overbroad, and unnecessary document requests that seek information Petitioner likely can obtain by deposing Patent Owner’s declarants.

Petitioner fails to satisfy the *Garmin* factors in its motion (Papers 30 and 31, hereinafter “Paper 31”). That is, Petitioner has failed to demonstrate that it is already “in possession of a *threshold amount of evidence* or reasoning tending to show beyond speculation that something useful will be uncovered.” *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26, at 7 (PTAB, Mar. 5, 2013) (emphasis added) (factor 1). Instead, Petitioner speculates that useful information can be found. Petitioner further fails to demonstrate that it cannot obtain the information by other means. *See id.* at 6 (*Garmin* factor 3).

Finally, Petitioner overlooks the extensive burden on Patent Owner resulting from an unbounded deposition of the non-declarant and production of the requested

documents, given the confidential, commercially sensitive, and potentially privileged nature of the documents requested, as well as the vague, ambiguous and overbroad nature of the requests. *See id.* at 7 (*Garmin* factor 5). Accordingly, Petitioner’s request for additional discovery must fail.

## **II. ARGUMENT**

### **A. Patent Owner has Provided Volumes of Evidence to Swear Behind**

Petitioner alleges that Patent Owner has provided only “small snapshots of the alleged antedating story.” Paper 31, at 2. That is untrue. Patent Owner has provided the declaration of co-inventor Dr. Hsueh Sung Tung, who testified to the activities and interactions between the inventors during the relevant time period, demonstrating the conception a reduction to practice and an understanding of the utility of the invention. *See, e.g.*, Ex. 2006, at 5–9. Dr. Tung likewise identifies documentary evidence that provides “independent” corroboration, and such documentary evidence stands on its own. Relying on a single inventor’s declaration is proper and reasonable in an IPR. *See Corning Inc. v. DSM IP Assets B.V.*, IPR2013-00053, Paper 66, at 7 (PTAB, May 1, 2014).

Patent Owner also filed the corroborating declarations of non-inventors Daniel Merkel (Ex. 2038) and Angela Goodie (Ex. 2037). Mr. Merkel confirms that he witnessed the performance of the caustic dehydrofluorination experiments utilizing KOH, whereby the KOH was withdrawn and recovered. Ex. 2038, ¶ 4.

Mrs. Goodie testifies that she performed the experiments during the relevant time period. Ex. 2037, ¶¶ 4–6.

Patent Owner likewise submitted documentary evidence of conception, reduction to practice, and ongoing diligence, *see* Exs. 2007–2035, 2039, 2042, supported by multiple declarations. Thomas Morris outlines Patent Owner’s representative activities in furtherance of development of a commercial plant. Ex. 2036, ¶¶ 5–9. In-house counsel Bruce Bradford testified as to the invention disclosure process and the outcome of each patent committee meeting. Ex. 2041, ¶¶ 7–14. After approving the case for filing on July 12, 2010, Mr. Bradford further testified to his diligent activities in sending the drafting order to outside counsel. Ex. 2041, ¶¶ 12–15; *see also* Ex. 2042. Finally, outside counsel Joe Posillico testified that he and his firm diligently prepared and filed the application in accordance with their responsibilities. Ex. 2043, ¶¶ 4–12.

In short, Patent Owner has provided overwhelming evidence in support of its antedating case. It is Petitioner’s prerogative to depose Patent Owner’s declarants and examine Patent Owner’s documentary evidence. Yet, to date, Petitioner has not done that. Accordingly, the Board should not be swayed by Petitioner’s plea to “probe Patent Owner’s factual assertions,” but instead should require Petitioner to proceed within the Board rules. Paper 31, at 2.

**B. Petitioner has Failed to Establish That Additional Discovery Would Be In The Interests of Justice**

Petitioner has allowed over half of its period for Reply to pass without taking a single deposition of Patent Owner's declarants.<sup>1</sup> Instead of pursuing routine discovery under 37 CFR 42.51(b)(1), Petitioner has focused its efforts on various time-consuming and expensive discovery requests, many of which it has now abandoned. Petitioner now wastes further resources by approaching the Board with speculative additional discovery requests and a short time table that is Petitioner's own making. The Board should decline Petitioner's request.

Petitioner's requests do not demonstrate a need for the Board to alter its normal practice, namely that "discovery shall be limited to—(A) the deposition of witnesses submitting affidavits or declarations; and (B) what is otherwise necessary in the interest of justice." 35 U.S.C. § 316(a)(5); 37 C.F.R. § 42.51(b). To meet that high standard, a party seeking additional discovery must satisfy the five-prong test set forth in *Garmin*. *Garmin*, IPR2012-00001, Paper 26, at 6–7. Petitioner fails to do so.

*First*, Petitioner has failed to demonstrate that it is already "in possession of evidence tending to show beyond speculation that in fact something *useful* will be uncovered." *Id.* at 6. *Second*, the Petitioner has failed to demonstrate that taking its

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<sup>1</sup> Petitioner sent its first correspondence regarding deposition dates for Selma Bektesevic, Thomas Morris and Robert Lousenberg on March 3, 2016.

permissible depositions would not generate the requested information. *Third*, Petitioner has failed to demonstrate that its requests are not overly burdensome. For at least these reasons, the additional discovery requests must fail.

### **1. Deposition of Dr. Selma Bektesevic**

Petitioner asserts that a “deposition of Dr. Bektesevic will provide useful information that has substantive value to Petitioner’s reply.” Paper 31, at 3. Yet Petitioner never demonstrates that it is already “in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered.” *Garmin*, IPR2012-00001, Paper 26, at 6. The standard is *not* whether the Petitioner can identify something “merely ‘relevant’ and/or ‘admissible’”; it is whether something *useful* will be uncovered,” where “useful” means “favorable in substantive value to a contention of the party moving for discovery.” *Id.* at 7 (emphasis added). Petitioner has not satisfied this burden.

*First*, Petitioner asserts that Dr. Bektesevic has first-hand knowledge of the facts upon which Patent Owner relies. That is, Petitioner asserts that Dr. Bektesevic is solely capable of testifying to the facts and circumstances related to conception and reduction to practice. Paper 31, at 4. Dr. Tung, also a named inventor and Dr. Bektesevic’s supervisor, also has first-hand knowledge and is more than qualified to testify on these grounds. There is no requirement that both inventors be made available. *Corning*, IPR2013-00053, Paper 66, at 7. Indeed, Petitioner has not

provided any evidence that Dr. Bektesevic's knowledge, as compared to Dr. Tung, will result in testimony that adds substantive value beyond that of Dr. Tung.

*Second*, Petitioner argues that Dr. Tung's declaration is, and thus his deposition would be, deficient because he does not recall the particular dates of the experiments he observed. Paper 31, at 4–5. But while Dr. Tung testifies that he has no specific recollection of the exact date that he observed the experiments, he provides a detailed account of the experiments performed, his involvement with the process, and a summary of his reports, each of which properly establishes the time frame in which the experiments were conducted. Ex. 2006, ¶¶ 20–41. Through the testimony of Dr. Tung, Angela Goodie and Daniel Merkel, Patent Owner establishes the relevant experiment dates. *Id.*; *see also* Ex. 2038, ¶ 4, Ex. 2037, ¶¶ 4–6. What's more, Dr. Bektesevic did not perform the experiments but rather she supervised them, so it is unclear and unexplained why her testimony on this point would be helpful. Accordingly, Patent Owner's existing declarants provide Petitioner with ample opportunity to examine the date of conception, and Petitioner fails to provide a substantive reason as to why any alleged discrepancy would be useful in this proceeding.<sup>2</sup> Thus, Petitioner fails to meet the threshold requirement of *Garmin's*

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<sup>2</sup> Petitioner asserted that it is preserving the right to an interference pending the outcome of this proceeding. Mandatory Notice dated June 3, 2015, Paper 6.

first factor.

*Third*, in an attempt to discount the fact that it has not deposed Dr. Tung, Petitioner appears to assert it is entitled to testimony regarding the notebook of Dr. Bektesevic (Ex. 2039), the facts surrounding the notebook, and/or the handwriting in the notebook. Paper 31, at 6. Petitioner states, “Dr. Bektesevic’s deposition will yield information that Dr. Tung cannot provide.” *Id.* But Petitioner *never* identifies *what* information that might be. *See id.* Paired with the deposition availability of both Dr. Tung, a co-inventor, and Mr. Merkel, the engineer who signed and corroborated the technical description in the invention notebook, Ex. 2038, ¶ 5, this speculation weighs *Garmin*’s third factor against a deposition of Dr. Bektesevic.

*Fourth*, Petitioner argues that “[n]ow is the ‘proper time and place’ for [Dr. Bektesevic’s] deposition.” Paper 31, at 5 (citing *Garmin*, IPR2012-00001, Paper 26, at 6). Petitioner cites to a section in *Garmin* where the Board instructs that “[a] party may not attempt to alter the Board’s trial procedures under the pretext of discovery.” The citation further suggests that parties should follow the established rules for discovery, specifically reciting that parties should take an opportunity to cross-examine a declarant with regard to the basis of the declarant’s testimony. *Id.* at 6, 13. Patent Owner agrees that now is the proper time and place for Petitioner to cross-examine the *declarants* in this case, but the holding of *Garmin* simply does not extend to speculative testimony and unbounded examination of non-declarants.



Finally, Petitioner summarily addresses *Garmin* factors 4 and 5. Paper 31, at 6–7. Petitioner has not provided any details regarding the scope of Dr. Bektesevic’s deposition, which *alone* renders the Petitioner’s request overly burdensome and is ultimately fatal to Petitioner’s request. See *Cardiocom, LLC v. Robert Bosch Healthcare Sys., Inc.*, IPR2013-00431, Paper 43, at 3 (PTAB May 12, 2014) (“Petitioner’s request is overly broad and burdensome because, instead of providing a list of specific, narrow topics to be discussed during the requested depositions, Petitioner provides a non-limiting list of broad topics . . . to potentially discuss and does not specifically exclude any specific topic for discussion.”). Unlike even the failed attempt in *Cardiocom*, Petitioner fails to even provide a non-limiting list of broad topics, leaving the Board without a discovery request it can grant.

Patent owner notes that Petitioner’s offer with regard to foregoing a deposition of Dr. Tung is likewise unhelpful as it comes with a caveat, Paper 31, at 6, which does not alleviate the additional burden of preparing a non-declarant for an unlimited deposition. Patent Owner still bears the burden of preparing both witnesses. *Id.*

## **2. Document Requests**

Each of the document requests suffers from the same or similar shortcomings. In particular, Petitioner again seems to confuse the district court concept of relevance or admissibility with the threshold evidence requirement outlined in *Garmin*’s first factor. *Garmin*, IPR2012-00001, Paper 26, at 7. Petitioner chose to proceed in the

PTAB but fails to provide such evidence. Petitioner does not explain why the requested information cannot be obtained via deposition—no doubt because Petitioner has not yet taken a single deposition. *See Intri-Plex Techs., Inc. v. Saint-Gobain Performance Plastics Rencol Ltd.*, IPR2014-00309, Paper 40, at 9 (PTAB, Sept. 4, 2014) (denying additional discovery in part because requestor had “the ability to generate equivalent information through [a] scheduled deposition”). Finally, Petitioner fails to provide sufficient specificity within its district-court-style requests, placing an unfair burden on Patent owner, and making compliance with each of the overly burdensome requests difficult, especially within the three business days contemplated by Petitioner. Paper 31, at 1.

**(a) April 2009 “Forward Engineering Request Form” and September 2009 Whitepaper**

Petitioner submits that “Patent Owner and Morris’s reliance on [the “Forward Engineering Request Form” and the September 2009 Whitepaper] to allegedly show diligence demonstrates beyond mere speculation that production of the documents will yield useful information.” Paper 31, at 7. But Petitioner never explains what the supposed “useful information” is or how it will be substantively favorable. *See id.*; *Garmin*, IPR2012-00001, Paper 26, at 6.

Petitioner further fails to account for its ability, under the third *Garmin* factor, to obtain the requested information by way of a deposition of Mr. Morris. Mr. Morris already testifies to the significant activity with regard to 1234yf during the

relevant time period. Ex. 2036, ¶¶ 5–9. To demonstrate this activity, Mr. Morris does not rely on the content of the “Forward Engineering Request Form” or the September 2009 Whitepaper, but simply cites to their existence. *Id.* Petitioner can cross-examine Mr. Morris about these documents.

Petitioner cites to *Corning* for the proposition that if a party relies on a document, there is more than a mere speculation that production of the documents will yield useful information. Paper 31, at 7 (citing *Corning Inc. v. DSM IP Assets B.V.*, IPR2013-00043, Paper 27, at 3–4 (PTAB, Jun. 21, 2013)). In *Corning*, however, an expert tested prior art compositions to determine if they possessed properties claimed in the patent-at-issue. Corning sought additional discovery of the expert’s lab notebooks. *Id.* at 2. This is unlike the current situation, where no such tests or underlying data are necessary to examine Mr. Morris because he offers no expert opinion. Petitioner is entitled to cross-examine Mr. Morris and then argue to the Board the weight that should be given his testimony.

Petitioner’s request is also overly burdensome to the extent the documents include highly confidential, commercially sensitive business information unrelated to the issues in this case, and would need to be redacted. Given the potential for disagreement over the scope of redaction, Patent Owner submits that the additional resources required and the likelihood of another discovery dispute render these requests overly burdensome. *See TRW Automotive U.S. LLC, v. Magna Electronics*

*Inc.*, IPR2015-00950, Paper 10, at 6 (PTAB, Nov. 19, 2015).

**(b) Formal minutes from Patent Committee meetings held on January 11, 2010; April 5, 2010; and April 13, 2010**

Petitioner requests the Patent Committee meeting documents because they “will also indicate the status for the invention disclosure at those times.” Paper 31, at 9. But Petitioner articulates no basis for this assertion, and what the requested documents may eventually “indicate” does not satisfy the first *Garmin* factor’s “usefulness” requirement. *Garmin*, IPR2012-00001, Paper 26, at 7.

Petitioner’s request is also undercut by Mr. Bradford’s testimony, which provides the very patent committee meeting decisions that Petitioner is requesting. Ex. 2041, ¶¶ 10–12. Specifically, Mr. Bradford confirms that:

During [the January 11, 2010] PC meeting, the PC requested that Selma Bektesevic draft a detailed disclosure . . . . During [the April 5 and 13, 2010] PC meeting, the PC requested that I review the invention disclosure form and the detailed disclosure . . . with an eye to filing.

*Id.* at ¶¶ 10–11. Until the approval of the application for sending to outside counsel, *see* Ex. 2042 and Ex. 2041, ¶ 12, the Patent Committee was continually evaluating the disclosure. Ex. 2041, ¶ 11. Petitioner therefore has the information it seeks, rendering it improbable that additional, “useful” information would be discovered.

Petitioner has the opportunity to cross-examine Mr. Bradford should it require additional information, rendering the request for these documents improper under at least the third *Garmin* factor. Petitioner has not yet sought to depose Mr. Bradford.

**(c) 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)**

Petitioner's request is inconsistent as it initially requests "lab notebooks for experiments performed pursuant to lab instructions," and then later refers to "invention notebooks." Paper 31, at 10. As such, it is not clear what documents Petitioner is seeking. In any event, Patent Owner has confirmed that the information sought by Petitioner relating to the results of the experiments is included in the appendices of the monthly technology reports. *See* Ex. 1020, at 26:13–27:2.

Should additional details be necessary with regard to any lab instructions, Patent Owner has submitted the declaration of Angela Goodie, the lab technician who performed the experiments. Ex. 2037, ¶¶ 4–6. Petitioner can depose Ms. Goodie if Petitioner requires information related to the experiments and reduction to practice. Given the availability of the requested information through other means of routine discovery, Petitioner's request fails under the third *Garmin* factor.

Petitioner's request also fails under the fourth *Garmin* factor as it does not provide a clear explanation as to what Petitioner is attempting to obtain. Requests must "be easily understandable" and permit the responsive party to "answer efficiently, accurately, and confidently." *Garmin*, IPR2012-00001, Paper 26, at 6–7. Petitioner does not identify the requested documents, the author of the documents, or the topics of the documents with sufficient clarity to allow for Patent Owner to

comply. Thus, the Board should deny the request.

**(d) Documents sufficient to show the date when Patent Owner first became aware of the applications published as FR 2940968, WO 2010/081988, and/or US 2012/0022301**

Petitioner, without any timing restrictions or instructions, employs yet another district-court-style discovery request to generally seek documents relating to the applications published as FR 2940968 (“Sedat”), WO 2010/081988, and/or US 2012/0022301. Similar to previous requests, Petitioner provides no threshold evidence that tends to show that Patent Owner was aware of these documents or that there is more than mere speculation that responsive documents exist.

The stated purpose for this discovery is equally problematic. Petitioner highlights that the Sedat application was published on July 16, 2010 but fails to mention that the Patent Committee Meeting, where Patent Owner approved the relevant disclosure for filing, occurred several days *earlier* on July 12, 2010. *See* Ex. 2041, ¶ 12; *see also* Paper 31, at 12. Said differently, it was not possible for Patent Owner to be aware of Sedat at the time it approved the disclosure for filing because Sedat had not yet published. Furthermore, Exhibit 2042 corroborates Patent Owner’s timeline. Mr. Bradford was instructed to send the disclosure to outside counsel for drafting prior to the first date Patent Owner could have learned of the Sedat reference. Ex. 2041, at 6. Given that Petitioner has pointed to neither evidence nor timeline problems that suggest anything “useful”—*i.e.*, of substantive value—is

likely to be found, Petitioner's request is inappropriate under the first *Garmin* factor.

Finally, Petitioner's request is overly burdensome. Petitioner does not limit this request to any particular persons, media (email, documents, search history, etc.), or time period. Given the size of Patent Owner's business, such an unbounded request is highly burdensome—especially within three business days. Especially because Petitioner provides no “evidence” that anything “favorable in substantive value” will be discovered, Petitioner's burdensome request must be denied. *Garmin*, IPR2012-00001, Paper 26, at 7.

**(e) Draft patent application sent to Selma Bektesevic on September 29, 2010 as an attachment to Ex. 2032**

Petitioner requests a copy of the draft patent application sent days before filing of the provisional application. This speculative request aims to demonstrate that outside counsel did insufficient work to justify the time it took to finalize the draft application.

To support its request, Petitioner cites to *Oracle*. Paper 31, at 14 (citing *Oracle Corp. v. Click-To-Call Techs. LP*, IPR2013-00312, Paper 52, at 18–20 (PTAB, Oct. 28 2014)). In *Oracle*, the facts suggest that the Patent Attorney and Inventor exchanged a number of drafts over a period of time. In contrast to Petitioner's assertion, the Board in *Oracle* stated that a declaration failed to satisfy the burden to show diligence because (1) no details were provided with regard to the work that was done; and (2) Patent Owner's counsel admitted that the actions by the

inventor and attorney would be insufficient to establish diligence. *Id.* at 19–20. Unlike *Oracle*, here details of work performed are identified in the Posillico declaration (Ex. 2043, ¶¶ 8–11) and the provisional application.

Petitioner also cites *Olympus*. Paper 31, at 15 (citing *Olympus America Inc. v. Perfect Surgical Techniques, Inc.*, IPR2014-00233, Paper 56, at 21–22 (PTAB, June 8, 2015)). However, *Olympus* explicitly rejects the proposition that documents exchanged between inventor and patent attorney are absolutely necessary to establish diligence. *See id.* at 40–41. Petitioner therefore has not provided any threshold evidence that the application draft would be useful in establishing lack of diligence.

Finally, Patent Owner submitted declaratory testimony with regard to the drafting of the application. Accordingly, Petitioner is able to obtain the requested information by deposing Mr. Posillico.

### **III. CONCLUSION**

Petitioner has failed to participate in routine discovery in a timely fashion and has failed to carry its high burden. Accordingly, Petitioner’s motion must be denied.

Dated: March 10, 2016

Respectfully submitted,

By: /Bruce J. Rose/  
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**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that, on March 10, 2016, a true copy of the foregoing **Patent Owner's Opposition to Petitioner's Motion for Additional Discovery** and its respective exhibits, was served by electronic mail on:

Jon Beaupré  
Allen R. Baum  
Allyn B. Elliott  
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